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No. 07-

Supreme Court, U.S.
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THE SUPREME COURT OF THE UNITED STATES

MOTIONLESS KEYBOARD COMPANY,
Petitioner,

v.

MICROSOFT CORPORATION,
Respondent,

and

NOKIA INC.,
Respondent,

and

SAITEK INDUSTRIES LTD.,
Respondent.

On Petition for Writ of *Certiorari* to The United States Court of Appeals for the Federal Circuit

PETITION FOR WRIT OF *CERTIORARI*

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October 26, 2007

Questions Presented for Review

1. Did the Court of Appeals abuse its discretion in denying without any explanation Petitioner's request for thirty additional days to petition for rehearing, where Petitioner was an impecunious inventor who had just suffered a fire that destroyed Petitioner's property, no other party objected to such extension of time, and through the denial Petitioner was prevented from bringing serious errors of fact and law to the attention of the Court of Appeals?

2. Did the Court of Appeals err in reversing the burden of proof and establishing a heightened evidentiary standard to avoid summary judgment dismissing claims of infringement premised on application of the doctrine of equivalents, by holding, as a matter of law that respondents Microsoft Corporation, Nokia Corporation, and Saitek did not infringe U.S. Patent No. 5,323,322 (hereafter, the '322 patent)?

Corporate Disclosure Statement

Motionless Keyboard Company has no parent corporations or publicly-held companies owning 10% or more of its stock.

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The opinion of the Court of Appeals of which review is sought is reported as *Motionless Keyboard Co. v. Microsoft Corp.*, 486 F.3d 1376, 82 U.S.P.Q.2d 1801 (2007).

Statement Concerning Jurisdiction

Judgment was entered by the Court of Appeals on May 29, 2007. The Court of Appeals denied Petitioner's request for a thirty-day extension of time in which to petition for rehearing on June 14, 2007 (A20-21). On August 28, 2007, this Court granted an extension of time to and including October 26, 2007 to petition for a writ of *certiorari*. This Court has jurisdiction pursuant to 28 U.S.C. § 1254.

Pertinent Statutes and Rules

The pertinent statute is 35 U.S.C. § 271(a), which provides:

> "Except as otherwise provided in this title, whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent."

The pertinent rule is Rule 40(a) of the Federal Rules of Appellate Procedure:

> "Unless the time is shortened or extended by order or local rule, a petition for panel rehearing may be filed within 14 days of entry of judgment. But in a civil case, if the United States or its officer or agency is a party, the time within which any party may seek rehearing is 45 days after entry of judgment, unless an order shortens or extends the time."

Concise Statement of the Case

As the Court of Appeals explained, the inventor here

> ". . . invented the novel ergonomic keyboard technology on a part-time basis while also working in other jobs such as graphic artist and dishwasher. In fact, Mr. Gambaro developed some of the ergonomic keyboard technology while he lived in a friend's attic. As an independent inventor, Mr. Gambaro developed his technology

> advances without the benefit of a well funded laboratory and then traversed the patent system on a limited budget." (A2-3.)

He has also been required to "traverse the legal system" on an extremely limited budget. (*See generally* Motion to Extend the Time for Filing a Petition for Writ of Certiorari, Aug. 21, 2007, at 2-3.)

Notwithstanding such significant practical handicaps, Petitioner sought and obtained the '322 patent, which disclosed a novel invention through which operators of handheld devices could actuate the keyboards of electronic devices using not only the tips of their thumbs, but also the thumb joints.

The patent is simple and not highly technical in nature. The first claim, and only independent claim, discloses:

> "A hand-held device for entering information into an electronic system via a keyboard, the device comprising:
>
> - "a housing having a grippable portion which permits the device to be held in one hand with the thumb free to move at least temporarily to a predetermined key-actuation position while the device is held,
>
> - "a concavity in said housing at said key-actuation position, and
>
> - "a thumb-associable cluster of keys forming a keyboard within said concavity, each of the plurality of keys in said cluster being selectively

actuable via mixed lateral, and slight endo, translation of a thumb within said concavity, whereby information is entered into an electronic system." (A48-49.)

The specifications disclosed a variety of embodiments of the invention (A28-29, 32), two of which are reproduced below next to:

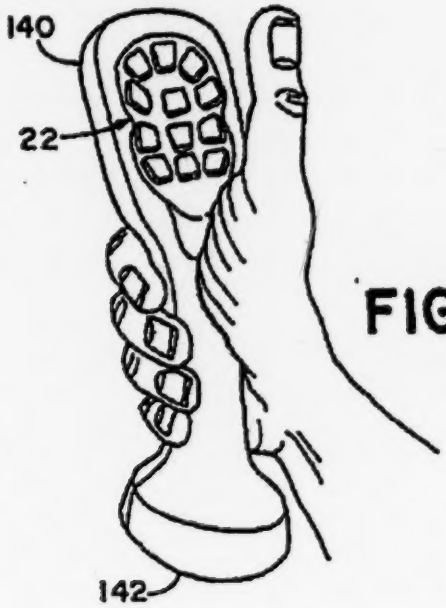


FIG.7

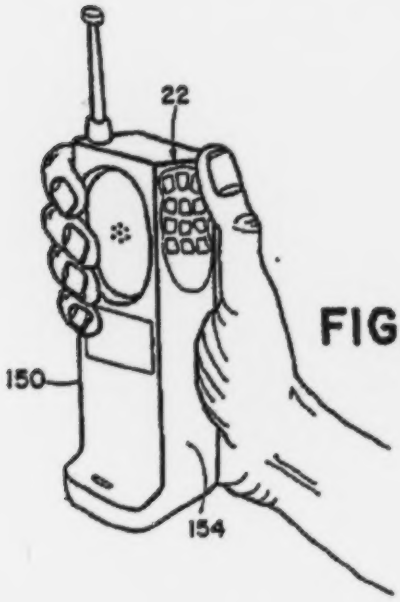
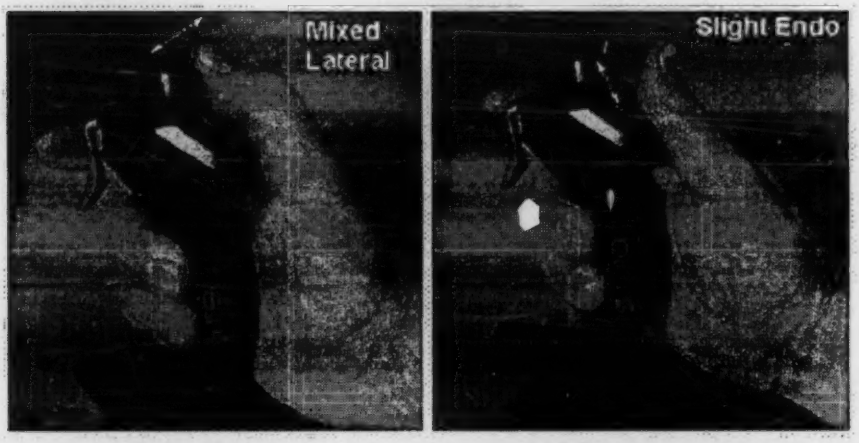
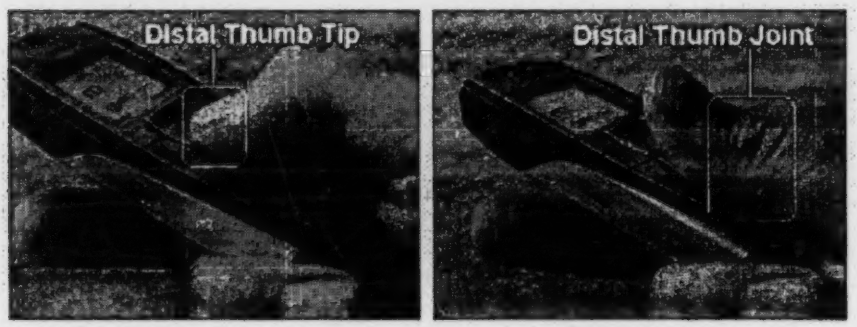


FIG.8

Petitioner claimed that two sets of hand-held electronic devices infringed the '322 patent: certain computer joysticks (produced by defendants Microsoft Corp. and Saitek Industries) and certain cellular phones (produced by defendant Nokia Inc.), all of which constitute devices quite similar in appearance and use to the claimed invention:



(From page 919 of the Court of Appeals Appendix, showing a "mixed lateral . . . translation of a thumb within said concavity" (A49) formed by the expanded key surfaces of a Saitek joystick.)



(From page 864 of the Court of Appeals Appendix, showing dialing with the thumb joint within the concavity of a Nokia phone.)

Before the Court of Appeals, the controversy focused on whether the accused products contained a "concavity" in the housing, with a "keyboard within said concavity".

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With respect to the joystick products, the Court of Appeals denied literal infringement on the basis that the accused products show "a lack of a concavity and a lack of keys sunk completely within the concavity and below the housing". (*See* A9.) With respect to the Nokia products, the Court characterized them as containing "keys protruding through an opening in the housing" rather than being "within said concavity". (A10.)

When Petitioner and two other parties sought additional time to present a petition for rehearing, or rehearing *en banc*, the Court of Appeals denied the motions without explanation. (A20-21.) The Court of Appeals had jurisdiction over Petitioner's appeal from the final judgment of the District Court pursuant to 28 U.S.C. § 1291.

Argument

I. BY DENYING PETITIONER'S MOTION FOR ADDITIONAL TIME TO PETITION FOR REHEARING, THE COURT OF APPEALS DEPARTED FROM THE ACCEPTED AND USUAL COURSE OF JUDICIAL PROCEEDINGS SO AS TO CALL FOR AN EXERCISE OF THIS COURT'S SUPERVISORY POWER.

Rule 40 of the Federal Rules of Appellate Procedure provides that a petition for rehearing must be filed within 14 days after entry of judgment. Where any federal agency or official is a party, the deadline is extended to 45 days. Inasmuch as the Court of Appeals mails out its opinions and

judgments, those on the West Coast may have as little as a week to petition for rehearing to the extent they cannot afford constantly to monitor developments in their case.

Upon receipt of the opinion, Petitioner immediately moved on June 12, 2007 for a thirty-day extension of time to seek rehearing. Petitioner offered two grounds for the motion. First, Petitioner explained that the inventor "was involved in an apartment fire in May that has caused him to suffer eviction proceedings; he has had to move to new lodgings; and as a result has not been able adequately to consider the options of [Petitioner] in the wake of the panel opinion". (A23.) Second, Petitioner noted that it "has also received proposals from certain defendants concerning possible settlement" and "requires additional time to make informed choices concerning these patents and the infringement claims". (*Id.*)

Two of the defendants, Nokia Inc. and Saitek Industries, also moved for the same extension of time (*see* A21); none of the parties to the appeal opposed Petitioner's motion. Nonetheless, on June 14, 2007, the Court of Appeals denied both motions without explanation. (*Id.*) In the accepted and usual course of judicial proceedings, discretionary rulings are to be accompanied with findings explaining the exercise

of discretion.[1]

In assessing whether or not the Court of Appeals has so departed from the accepted and usual course of judicial proceedings so as to call for an exercise of this Court's supervisory power, the Court should consider carefully the balance of interests involved. Two fundamental policies counseled in favor of granting of the motion, with no countervailing policy considerations of substance. First, it is axiomatic that the federal judiciary will, in the absence of countervailing considerations, seek to promote settlement of disputes. The moving parties all averred that additional time was required in order to conclude settlement negotiations, and no party objected. (*See* A23-24.) Yet the Court of Appeals offered no reason for denying the motion and thereby short-circuiting the settlement process.

Second, the Rule embodies a policy of affording litigants sufficient time to analyze and respond to decisions from the courts of appeals, going so far as to afford a categorical extension to 45 days for a class of litigants subject to cumbersome decision-making processes: federal agencies and officials. (*See* Fed.

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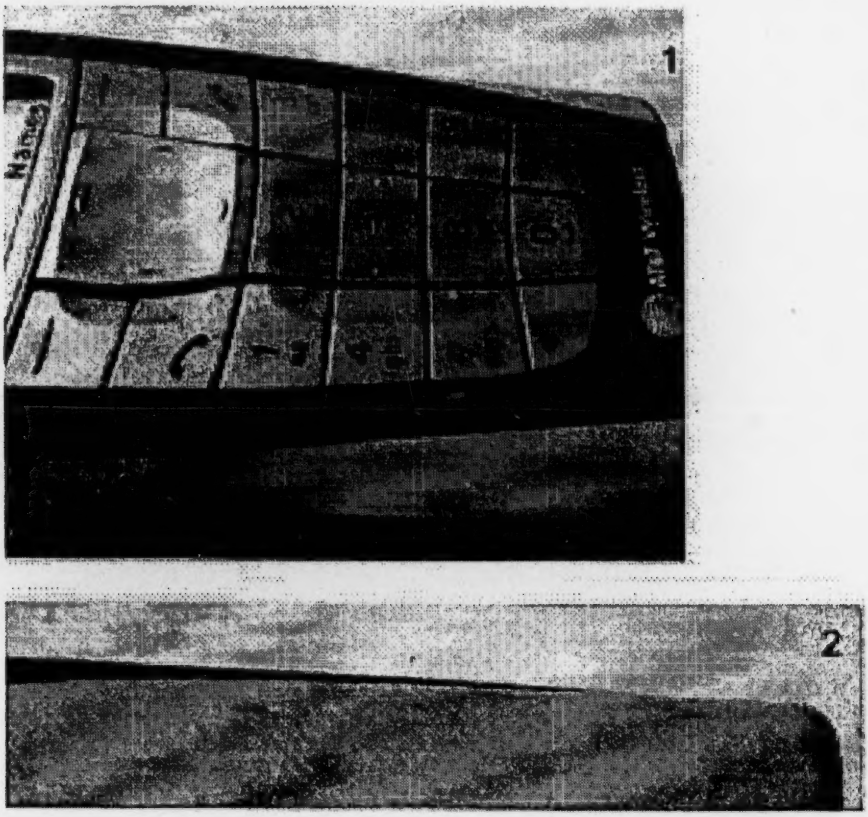
[1] *Cf., e.g., Belizan v. Hershon*, 495 F.3d 686, 694 (D.C. Cir. 2007) (remanding dismissal of amended complaint because it was "not sufficient for the district court simply to wave away plaintiffs' attempt to cure the deficiencies"); *Jones v. UNUM Life Ins. Co. of America*, 223 F.3d 130, 138 (2d Cir. 2000) (remanding attorney fee award for findings because "reviewable for 'abuse of discretion' is not the equivalent of 'unreviewable'); *Schwarz v. Folloder*, 767 F.2d 125, 133 (5th Cir. 1984) (remanding fee award because "[a] statement of reasons is one of the handmaidens of judging").

R. App. P. 40 Advisory Committee Notes (1994 Amendment).) If courts of appeals are given free reign to deny private citizens the same consideration—even after an evidentiary showing that they require such consideration—serious questions as to the equal protections of the laws would be raised.

Most importantly to Petitioner, in this case, denial of additional time to seek leave for rehearing was especially destructive of Petitioner's rights because Petitioner lost the opportunity to explain to the panel how it had made several critical factual and legal errors with respect to its resolution of the claims for infringement and other issues. As noted above, the focal point of dispute was whether the accused devices contained a "concavity" in their "housing", and a "keyboard within said concavity". With respect to the Nokia phones, the Court of Appeals finding that "keys protrude through an opening in the housing" (A10), rather than being "within said concavity", was simply wrong with respect to some of the accused products. The Court appears to have simply pointed to demonstrative evidence prepared by Nokia making this claim rather than examining the photographs of the phones (*e.g.*, the Nokia Model 6200):



(From pg. 168 of the Court of Appeals Appendix.)

In insisting that each and every key on the accused products lie within a "concavity", the Court of Appeals also overlooked a long-standing rule of claim construction: an accused device does not escape a claim of infringement merely because it contains additional features (such as additional keys that extend beyond the concavity). *See, e.g., Vulcan Engineering Co. v. Fata Aluminum, Inc.*, 278 F.2d 1366, 1376 (Fed. Cir. 2002). And as set forth in Point II, the panel invented new and improper hurdles for Petitioner to find no infringement as a matter of law under the doctrine of equivalents.

The only apparent policy *against* granting the motion for additional time is that set forth in the Advisory Committee Notes, which report that Rule 40 was adopted "to save time and expense to the party victorious on appeal". Fed. R. App. P. 40 Advisory Committee Notes (1967 adoption). But that policy manifestly has no weight where, as here, the victorious parties do not oppose the motion for more time.

Acceptance of the Petition, particularly if accompanied by summary disposition on the merits pursuant to Rule 16.1, would require rehearing in the Court of Appeals, and thereby provide important guidance to the courts of appeals that uncontested motions for extension of time to petition for rehearing should not be denied without explanation. It would serve to encourage the courts of appeal to consider in the first instance errors identified by the litigants, potentially reducing the burden upon this Court.

II. WHETHER THE ORDINARY BURDEN OF PROOF SHOULD BE REVERSED AND HEIGHTENED SUMMARILY TO DESTROY CLAIMS FOR INFRINGEMENT UNDER THE DOCTRINE OF EQUIVALENTS IS AN IMPORTANT QUESTION OF FEDERAL LAW THAT HAS NOT BEEN, BUT SHOULD BE, SETTLED BY THIS COURT.

Under Rule 56, in order to avoid summary judgment for non-infringement, Petitioner was merely required to show that there was a "genuine issue of material fact", Fed. R. Civ. P. 56(c). More

specifically, it was the duty of the Court of Appeals to "ascertain what material facts exist without substantial controversy and what material facts are actually and in good faith controverted", Fed. R. Civ. P. 56(d).

Instead, the Court of Appeals has created, is enforcing generally, and enforced in this case a novel rule requiring special, heightened proof to avoid summary judgment in doctrine of equivalents cases. Specifically, the Court of Appeals enforced an additional requirement of "particularized evidence and linking argument as to the 'insubstantiality of the differences' between the claimed invention and the accused device". (A11 (quoting *PC Connector Solutions LLC v. SmartDisk Corp.*, 406 F.3d 1359, 1364 (Fed. Cir. 2005)).

The Court of Appeals explicitly made it Petitioner's "burden to present [such] particularized evidence" in order to avoid summary judgment (A12), thereby reversing the normal burden of proof. It is true that since *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986), nonmoving parties may not simply rest on their pleadings when a motion for summary judgment is filed against them, but summary judgment is not to be entered absent a "complete failure of proof concerning an essential element of the nonmoving party's case". *See id.* at 323; *see also United States v. Diebold, Inc.*, 369 U.S. 654, 655, 82 S. Ct. 993, 994 (1962) ("On summary judgment the inferences to be drawn from the underlying facts contained in evidentiary materials must be viewed in the light most favorable to the party opposing the motion"). Here there was no "complete failure of

proof", but a failure to meet some novel, higher standard it was not properly plaintiff's burden to meet.

The requirement of "particularized evidence" is somewhat opaque, but it is clear in the context of the comparatively simple facts of this case that it amounts to something more than showing a genuine issue of material fact. As noted above, Petitioner claimed that two sets of hand-held electronic devices infringed the '322 patent: joysticks and cellular phones.

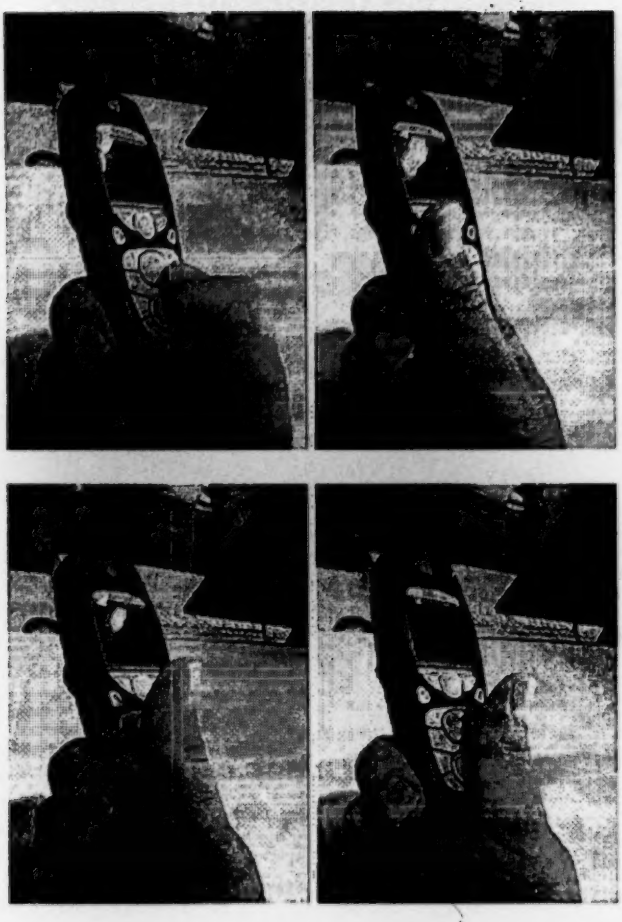
Petitioner offered detailed product-by-product claim charts, prepared by its patent attorney, with assistance from the inventor, which compared the elements of the claimed invention with the accused products. There is no dispute that in each case, with respect to the disputed elements, the charts explained that the element was present "structurally or equivalently", and identified the corresponding elements in the accused product. *See also* A12 (Court appears to acknowledge that claim charts show "substantial similarities of form, function and result").

The particular "equivalents" dispute concerned whether or not a concavity formed by the top surface of the keys themselves was the functional equivalent of a concavity in the housing. Petitioner took the position that using larger, keys arrayed in concave form that perform some of the function of the housing (*i.e.*, covering the innards), rather than small, flat keys located within a depression in the housing itself was an insubstantial change. This has

long been the law established by this Court. *See, e.g., Union Paper-Bag Machine Co. v. Murphy*, 97 U.S. 120, 125 (1877) ("if two devices do the same work in substantially the same way, and accomplish substantially the same result, they are the same, even though they differ in name, form or shape").

Specific testimony was offered by the inventor that "a concavity formed by the top surfaces of a cluster of keys is the functional equivalent of a concavity in the housing". (His sworn declaration to this effect appeared at pg. 1002 of the Court of Appeals Appendix.) He also stated: "I think it would be obvious to one reasonably skilled in the art of ergonometric keyboard design, such as myself, that the two are interchangeable". (*Id.*)

Nevertheless, the Court of Appeals affirmed without further explanation the District Court's suggestion that Petitioner had offered "no evidence" that the joysticks "perform 'substantially the same function in substantially the same way to obtain the same result'". (A12 (quoting District Court).) Yet the claim charts had contained detailed photographic evidence showing that the tip and joint actuation method taught in the patent was employed, achieving the same function (actuating switches) in the substantially the same way (with the tips and joints) to obtain the same result (actuating the same switches that might have been oriented within a concavity in the housing):



(From pg. 872 of the Court of Appeals Appendix; *see also, e.g., supra* p. 6 (same sort of photographic evidence for joysticks).)

In holding that Petitioner "did not offer any *particularized* testimony to *specifically* show that the keys work in the same way" (A13; emphasis added), the Court of Appeals manifestly established a standard requiring Petitioner to do more than merely demonstrate that the issue was genuinely contested. In so doing, the Court of Appeals removed from the jury the opportunity to consider whether the accused products were "the same in kind, and effected by the

employment of [the patentee's] mode of operation in substance". *Winans v. Denmead*, 56 U.S. 330, 344, 14 L.Ed. 717 (1853).

Triers of fact would have been unlikely to conclude, as did the Court of Appeals, that "[w]hile the patentee's invention points to actuation of the keys by a thumb movement within the concavity, a user would actuate the Nokia keys by pressing them downward". (A13). In so holding, the Court of Appeals missed the entire point of the invention, which addressed design such that more than one part of the thumb could be pressed downward into the keys through "slight gestural movements" (A44).

In particular, it was obvious from the '322 specifications that a user of the invention, just like the user of the accused products, would tend to hold them with the thumb positioned above the concavity, and activate the keys with a downward motion. Specifically, Figure 4 showed the thumb in just such a position:

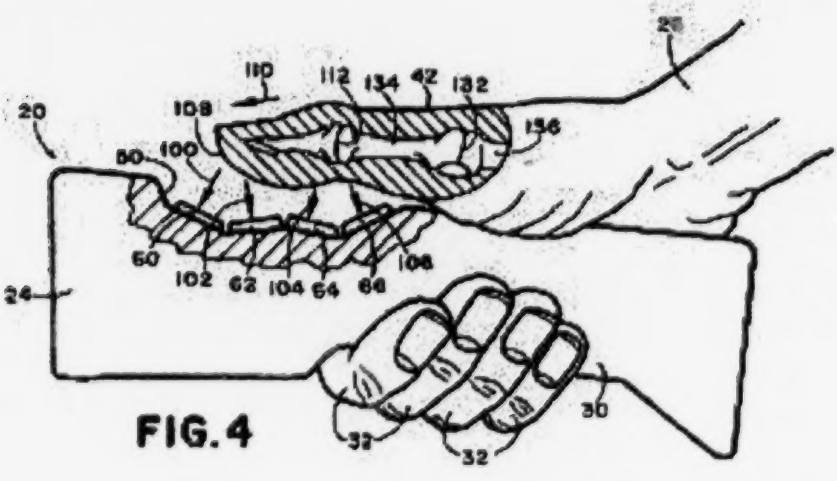


FIG. 4

The ordinary positioning—but not ordinary dialing motion—of the thumb is also set forth in Dependent Claim 5, which refers to a "device as in Claim 1" where "the user's thumb is selectively movable into said concavity without the user losing a grip on the device" (A50). The ergonomic innovation of the patent is that after the thumb is "rotated downwardly onto the keyboard" (and thus "within said concavity", whether formed by the key surfaces or depression in the housing), "each key in the keyboard can be actuated by slight gestural movements of the thumb" (A44). Those movements exert downward force in the directions identified above in Figure 4. (*Id.*)[2]

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[2] Also before the Court of Appeals (at pg. 827 of the Court of Appeals Appendix) was testimony from the patent attorney to this effect:

> "There has been continuing controversy in this case concerning the meaning of the phrase "mixed lateral, and slight endo, translation of a thumb within said concavity". There is a unique key actuation method taught in the '322 patent, most precisely in its specifications (Col. 6:30-42 [A44-45]), and this phrase represents my attempt to describe the method. I employed the term 'endo' in an attempt to capture the difference between this key actuation method and the more conventional means that involves simply moving the tip of the finger or thumb over a key and depressing it. In my opinion, a physical demonstration of this dialing method would benefit the Court and aid in its construction of the patent."

As this Court has explained in discussing the doctrine of equivalents, "the nature of language makes it impossible to

The District Court, which did not reverse the burden of proof and heighten it, properly concluded that "whether the Nokia phones support the slight endo translation of the thumb as described in the '322 patent is ultimately a question of fact", *Motionless Keyboard Co.,* 2005 WL 1113818, at *25—a ruling which was not appealed. The District Court had expressly rejected Petitioner's attempt, pursuant to Rule 43(e) of the Federal Rules of Civil Procedure, to supplement the photographic evidence by presenting live testimony to demonstrate the use of the accused products, and thereby to show equivalence. (District Court Transcript, Feb. 18, 2005, at 4-5 ("I'm inclined not to need anything demonstrated"). The trier of fact will, of course, have the benefit of such demonstrations.

Ultimately, Petitioner is constrained to regard invention and application of a special, heightened proof rule for equivalents cases as part and parcel of a general hostility to the doctrine of equivalents which has long been noted by this Court in reversing the Court of Appeals.[3] This Court's decision in

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capture the essence of a thing in a patent application", giving rise the very need for the doctrine of equivalents to avoid having the value of patents "greatly diminished". *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 535 U.S. 722, 731 (2002).

[3] This Court noted in *Warner-Jenkinson* that the doctrine of equivalents had been subject to "significant disagreement within the Court of Appeals for the Federal Circuit". *Warner-Jenkinson*, 520 U.S. at 21. This Court again noted the history of hostility toward the doctrine in *Festo*, 535 U.S. at 732 (2002).

Warner-Jenkinson Co. v. Hilton Davis Chemical Co., 520 U.S. 17 (1997), notes ongoing dispute concerning whether judges or juries should rule on questions of infringement under the doctrine of equivalents, but did not resolve the question. *See id.* at 38-39. The Court should not permit the same result to arise through peculiar procedural requirements.

Indeed, this Court has repeatedly rejected the notion that important Constitutional rights of trial by jury may be abridged by erecting heightened evidentiary barriers to be surmounted in the context of summary judgment proceedings. For example, in the context of litigation concerning official immunity under 42 U.S.C. § 1983, this Court rejected a heightened proof standard, noting that it had "consistently declined similar invitations to revise established rules". *Crawford-El v. Britton*, 523 U.S. 574, 595 (1998).

It is for Congress, not the Court of Appeals, to establish heightened proof requirements and special procedural rules to discourage particular classes of claims. *Cf. Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 535 U.S. 722, 733 (2002) (reiterating role of Congress in resolving policy disputes concerning the doctrine of equivalents). This Court should grant the Petition in order to establish that claims for infringement based upon the doctrine of equivalents are subject to the same pleading and proof rules as any other infringement claims, and that no special rules of proof or procedure may be applied to discourage such claims.

Conclusion

For the foregoing reasons, this Court should grant the Petition and either (1) summarily dispose of the case on the first question presented, remanding for rehearing before the Court of Appeals, or (2) set the case for briefing and oral argument on the second question presented.

Respectfully submitted,

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October 26, 2007.

United States Court of Appeals for the Federal Circuit

No. 2005-1497

MOTIONLESS KEYBOARD COMPANY,
Plaintiff-Appellant,
v.
MICROSOFT CORPORATION,
Defendant-Appellee,
and
Nokia Inc.,
Defendant-Appellee,
and
Saitek Industries Ltd.,
Defendant-Appellee.

Decided: May 29, 2007.

Before RADER, DYK, and MOORE, Circuit Judges.

RADER, Circuit Judge.

On summary judgment, the U.S. District Court for the District of Oregon determined that Microsoft Corporation ("Microsoft"); Nokia, Inc. ("Nokia"); and Saitek Industries, Ltd. ("Saitek") did not infringe, literally or under the doctrine of equivalents, Motionless Keyboard Company's ("MKC's") U.S. Patent Nos. 5,178,477 (the '477 patent) and 5,332,322 (the '322 patent). Motionless Keyboard Co. v. Microsoft Corp., No. Civ. 04-180-AA, 2005 WL 1113818 (D. Or. May 6, 2005). Also on summary judgment, the district court determined

that the '477 and '322 patents were invalid based on public use under 35 U.S.C. § 102(b). The district court also found the '322 patent invalid based on obviousness due to the patentee's terminal disclaimer in light of the '477 patent. Because the district court correctly construed the claim limitation "a concavity in said housing at said key actuation position, and a thumb-associable cluster of keys forming a keyboard within said concavity," this court affirms the ruling of no infringement. Because the trial court misapplied the concept of public use and incorrectly found obviousness due to a terminal disclaimer, this court reverses its invalidity rulings.

I

MKC owns the '477 and '322 patents. The '477 patent, entitled "Ergonomic Keyboard Input Device," claims an ergonomic keyboard designed to accommodate the architecture of the human hand. According to the invention, the keyboard requires only slight finger gestures to actuate the keys. '477 Patent Abstract. The '322 patent, entitled "Ergonomic Thumb-Actuable Keyboard for Hand-Grippable Device," issued as a continuation-in-part of the ' 477 patent. This patent claims a hand-held device that frees the thumb to actuate the keys in multiple and differentiated ways. '322 Patent Abstract.

Thomas L. Gambaro is the sole inventor of both the '477 and the '322 patents. Mr. Gambaro invented the novel ergonomic keyboard technology on a part-time basis while also working in other jobs

such as graphic artist and dishwasher. In fact, Mr. Gambaro developed some of the ergonomic keyboard technology while he lived in a friend's attic. As an independent inventor, Mr. Gambaro developed his technology advances without the benefit of a well-funded laboratory and then traversed the patent system on a limited budget.

During his inventive work, Mr. Gambaro developed different prototype models of his keyboard technology. Eventually, on February 22, 1987, Mr. Gambaro developed the Cherry Model 5. Motionless Keyboard, 2005 WL 1113818, at *26. Shortly after developing the Cherry Model 5, Mr. Gambaro entered into a business partnership with Mr. Keith Coulter. Thereafter, Mr. Gambaro and Mr. Coulter set out to gain financial support to further develop and patent the keyboard technology.

Thus, Mr. Gambaro began to demonstrate the Cherry Model 5 to potential investors. He also demonstrated the device to a friend, Ms. Kathie Roberts. While the potential investors signed two-year non-disclosure agreements (NDAs), Ms. Roberts did not. Mr. Gambaro entered into some of the NDAs with potential investors in 1987, meaning those agreements expired in 1989. Id. at *26-27. Additionally, Mr. Gambaro disclosed the Cherry Model 5 to Ms. Sheila Lanier on June 25, 1990 to conduct typing tests. While Mr. Gambaro showed the Cherry Model 5 to his business partner, numerous potential investors, a friend and a typing tester, according to the record, only Ms. Lanier used the

device to transmit data to a computer. In due course, Mr. Gambaro assigned both patents to MKC.

MKC sued Microsoft, Nokia, and Saitek for infringement of the '477 and ' 322 patents in the U.S. District Court for the District of Oregon. Specifically, MKC alleged that Microsoft's "Strategic Commander" game controller infringed claims 1, 2, 5, 6, and 8 of the '477 patent. MKC also alleged that Microsoft's "Sidewinder Precision 2," "Sidewinder Force Feedback 2," and various Saitek game joysticks infringed claims 1, 2, 3 and 5 of the ' 322 patent. MKC alleged that Nokia phone models 3560, 3595, 6200, and 6820 infringed claims 1, 2, 3, and 4 of the '322 patent.

The parties filed cross-motions for summary judgment. MKC moved for summary judgment of infringement against all three defendants. The defendants collectively moved for summary judgment of invalidity of both patents based on public use under 35 U.S.C § 102(b). The District Court entered summary judgment construing the claims of the '477 and '322 patents. Based on its reading of the patents, the trial court found no infringement as a matter of law. In addition, the District Court invalidated the '477 and '322 patents based on public use under 35 U.S.C. § 102(b). The trial court also declared the '322 patent invalid for obviousness in light of a terminal disclaimer.

MKC appeals the invalidity ruling on the '477 patent, but does not appeal the court's claim construction for the '477 patent. MKC appeals the

District Court's claim construction and infringement ruling on the '322 patent. MKC also appeals the court's invalidity rulings on the '322 patent. This court has jurisdiction under 28 U.S.C. § 1291(a)(1).

II

This court reviews a district court's grant of summary judgment without deference drawing all justifiable inferences in favor of the nonmovant. Genentech, Inc. v. Amgen, Inc., 289 F.3d 761, 767 (Fed.Cir.2002). Claim construction is a matter of law that this court reviews without deference. Cybor Corp. v. FAS Techs., Inc., 138 F.3d 1448, 1456 (Fed.Cir.1998) (en banc); Markman v. Westview Instruments, Inc., 52 F.3d 967, 979 (Fed.Cir.1995), aff'd, 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996). The meaning of the statutory terms "on sale" or "public use" within section 35 U.S.C. § 102(b) is a question of law that this court reviews without deference. Envirotech Corp. v. Westech Eng'g Inc., 904 F.2d 1571, 1574 (Fed.Cir.1990); Moleculon Research Corp. v. CBS, Inc., 793 F.2d 1261, 1266 (Fed.Cir.1986). In reviewing summary judgment rulings on infringement and invalidity, this court "need[s] to determine de novo whether the evidence in the record raises *1380 any genuine disputes about material facts. An evidentiary dispute is genuine if a jury could decide the issue either way, and its verdict would survive a motion for judgment as a matter of law." General Elec. Co. v. Nintendo Co., Ltd., 179 F.3d 1350, 1353 (Fed.Cir.1999).

III

The district court's determination of no infringement of the '322 patent rested on claim construction. Claim 1 of the '322 patent is the only independent claim and all the asserted claims contain the limitations of claim 1. Claim 1 of the '322 patent shows the pertinent limitation in the context of the entire claim:

> 1. A hand-held device for entering information into an electronic system via a keyboard, the device comprising:
>
> a housing having a grippable portion which permits the device to be held in one hand with the thumb free to move at least temporarily to a predetermined key-actuation position while the device is held,
>
> a concavity in said housing at said key-actuation position, and
>
> a thumb-associable cluster of keys forming a keyboard within said concavity, each of the plurality of keys in said cluster being selectively actuable via mixed lateral and slight endo, translation of a thumb within said concavity, whereby information is entered into an electronic system.

'322 Patent col.8 ll.16-31 (emphases added). The district court construed "a concavity in said housing at said key-actuation position, and a thumb-associable cluster of keys forming a keyboard within said concavity" to mean "that the concavity must be

formed by a depression in the housing of the device, and that all keys comprising the keyboard must be contained entirely within the concave area and sunk below the surface of the housing, so that the thumb movement occurs within the concave area." Motionless Keyboard, 2005 WL 1113818, at *19.

On appeal, MKC argues that "a concavity in said housing at said key-actuation position, and a thumb-associable cluster of keys forming a keyboard within said concavity" means that the tops of the keys themselves can form the concavity. Thus, under MKC's proposed construction of the claims, the keys or portions thereof themselves can form a concavity within the housing. MKC wants a broad construction of the concavity. Appellees, to the contrary, agree with the district court's narrower construction.

The claim language "a concavity in said housing at said key-actuation position, and a thumb-associable cluster of keys forming a keyboard within said concavity " defines well the limitation. '322 Patent col.8 ll.21-23 (emphases added). By using the terms "concavity in said housing" and "keyboard within said concavity," the patentee defined a depression within the housing of the device and set the keyboard entirely within that depression. The district court correctly grasped and conveyed this meaning.

The specification underscores the correctness of the trial court's construction: a "keyboard is positioned in a concavity or depression in the housing." '322 Patent col.4 ll.58-59 (emphasis added).

To confirm this reading, all keyboard renderings in Figures 1, 3-5, 7, and 8 in the '322 patent show a concavity in the housing of the device with the keyboard totally within the concavity. '322 Patent Fig. 1, 3-5, 7, and 8. Figure 4, for instance, shows the concavity:

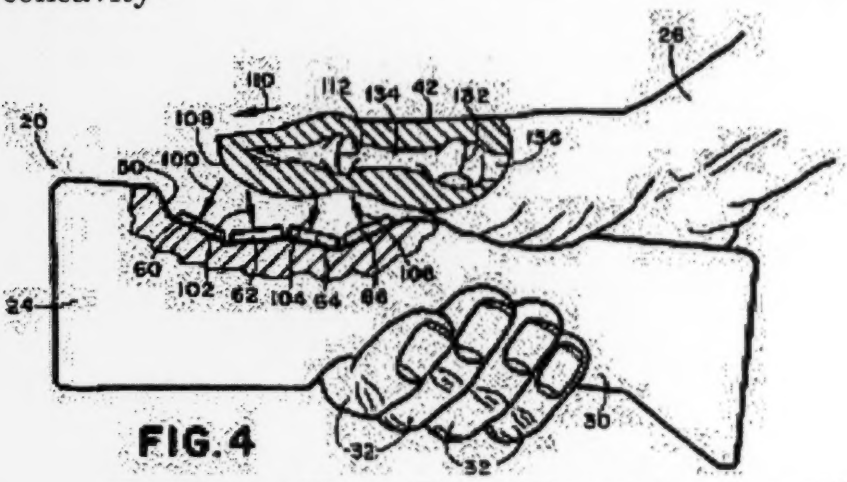

FIG. 4

'322 Patent Fig. 4. Thus, this court agrees with the district court's claim construction of this limitation.

With respect to the infringement analysis, the accused Microsoft Sidewinder joysticks, the Saitek joysticks, and the Nokia cellular phones do not literally infringe the '322 patent because the joysticks and cellular phones lack a concavity in the housing and a keyboard within the cavity. The Microsoft joysticks do not contain a concavity in a housing as shown by the side view of the top portion of a Sidewinder joystick. The Microsoft joysticks do not contain a concavity as construed as a depression in the housing. Furthermore and in addition to the lack of a concavity, the keys of the Microsoft joysticks extend beyond the limits of the devices (see figure

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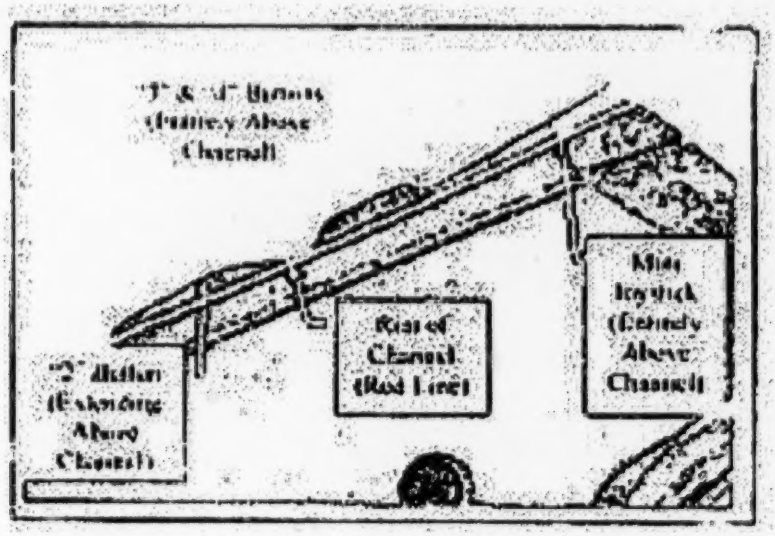
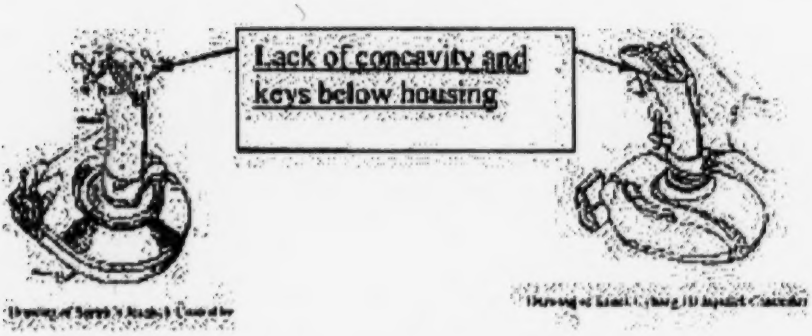
below) and therefore the keys are not contained entirely within a concave area and thereby sunk below the surface of the housing.



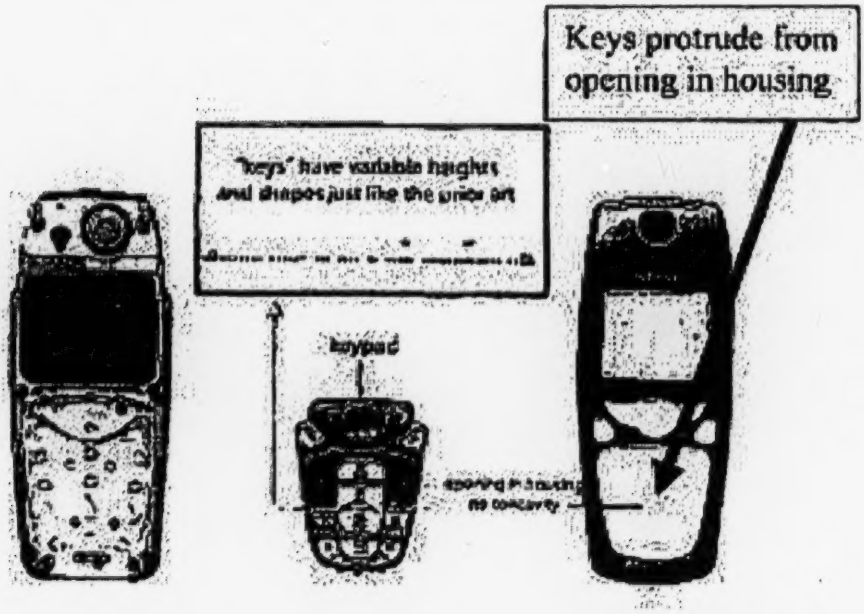
Therefore, the district court properly found summary judgment of no literal infringement.

Similar to the Microsoft joysticks, the Saitek joysticks contain neither a concavity in a housing nor keys contained entirely within a concave area and thereby sunk below the surface of the housing. An example of two Saitek joysticks shows a lack of a concavity and a lack of keys sunk completely within the concavity and below the housing.



Therefore, as with the Microsoft joysticks, the district court properly found summary judgment of no literal infringement.

The accused Nokia phones have keys that are placed onto a flat surface with the keys protruding through an opening in the housing of each phone. While some of the phones contain keys with slight depressions, these keys do not constitute a concavity in the housing according to the '322 patent. The following picture of an accused phone shows no concavity within the housing. In fact, the keys protrude through an opening in the housing.



Thus, because there were no genuine issues of material fact as to any of the Microsoft, Saitek or Nokia products, the district court properly found summary judgment of no literal infringement.

As for infringement under the doctrine of equivalents, MKC only presented the district court with conclusory statements about equivalents. Motionless Keyboard, 2005 WL 1113818, at *13, *24. To avoid a grant of summary judgment of non-infringement by equivalents, the patentee must present "particularized evidence and linking argument as to the 'insubstantiality of the differences' between the claimed invention and the accused device, or with respect to the 'function, way, result' test." *1383 PC Connector Solutions LLC v. SmartDisk Corp., 406 F.3d 1359, 1364 (Fed.Cir.2005) (citing Texas Instruments Inc. v. Cypress

Semiconductor Corp., 90 F.3d 1558, 1567 (Fed.Cir.1996)). Thus, the patentee has the burden to present particularized evidence that links the accused products to the patent on a limitation by limitation basis. General Elec. v. Nintendo Co., 179 F.3d 1350, 1359 n. 5 (Fed.Cir.1999).

With respect to the accused joysticks, MKC contends that the patents, the joysticks, and the claim charts show substantial similarities of form, function, and result. Based on only the information in the claim charts, MKC contends that inputting data with the hand-held controller with the thumb translates to infringement under the doctrine of equivalents. However, as the district court properly noted, "[MKC] presents no evidence that the differences between the joysticks and the claimed elements are insubstantial, or that the joysticks perform 'substantially the same function in substantially the same way to obtain the same result.' " Motionless Keyboard, 2005 WL 1113818, at *21 (citing Warner-Jenkinson Co. v. Hilton Davis Chem. Co., 520 U.S. 17, 39, 117 S.Ct. 1040, 137 L.Ed.2d 146 (1997)). Because MKC did not provide any particularized testimony to show infringement under the doctrine of equivalents, this court does not need determine the applicability of the limitations on the doctrine of equivalents.

Similarly with the Nokia cellular phones, MKC does not provide any evidence that the accused phones perform substantially the same function in substantially the same way to obtain the same result. The keys on the Nokia phones do not permit

thumb movement to actuate the keys within the concavity. While the patentee's invention points to actuation of the keys by thumb movement within the concavity, a user would actuate the Nokia keys by pressing them downward. In other words, the invention and the Nokia phone actuate the keys in different ways. As MKC did not provide any particularized testimony to specifically show that the keys work in the same way, the trial court properly granted summary judgment of non-infringement under the doctrine of equivalents.

IV

MKC appeals the district court grant of summary judgment that the '477 and ' 322 patents are invalid for public use under 35 U.S.C. § 102(b):

> A person shall be entitled to a patent unless-
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.

35 U.S.C. § 102(b) (emphasis added). Because the applicant filed the ' 477 patent on June 6, 1991, the critical date for the invalidity analysis is June 6, 1990. The critical date for the '322 patent is January 11, 1992. To sustain the invalidity determination, the record must show that an embodiment of the patented invention was in public use as defined by the statute before the critical date.

The district court found that MKC admitted that the Cherry Model 5 embodied the '477 patent and the '322 patent as of February 22, 1987. Even assuming that MKC admitted that the Cherry Model 5 embodied each claim of the '477 and '322 patents-a question this court need not decide-this court concludes that there was no "public use" under 35 U.S.C. § 102(b). Therefore, the district court's grant of summary judgment of invalidity for public use was improper.

The record shows that the inventor disclosed the Cherry Model 5 to his business partner, potential investors, a friend, and a typing tester before the critical date. While the potential investors signed NDAs, some of the NDAs expired in 1989-again prior to the critical dates for each patent. Thus, this court must examine, in the context of the district court's summary judgment ruling of invalidity, whether these disclosures and demonstrations were public uses within the meaning of the statutory bar.

Public use includes "any [public] use of [the claimed] invention by a person other than the inventor who is under no limitation, restriction or obligation of secrecy to the inventor." In re Smith, 714 F.2d 1127, 1134 (Fed.Cir.1983) (citing Egbert v. Lippmann, 104 U.S. 333, 336, 26 L.Ed. 755 (1881)). In Pfaff v. Wells Elecs., Inc., the Supreme Court noted that both the "on sale" and "public use" bars were based on the same policy considerations. Pfaff v. Wells Elecs., Inc., 525 U.S. 55, 64, 119 S.Ct. 304, 142 L.Ed.2d 261 (1998). Specifically, "[t]he [Supreme]

Court noted that both the on sale and public use bars of § 102(b) stem from the same 'reluctance to allow an inventor to remove existing knowledge from public use.' " Invitrogen Corp. v. Biocrest Mfg., L.P., 424 F.3d 1374, 1379 (Fed.Cir.2005) (internal quote from Pfaff, 525 U.S. at 64, 119 S.Ct. 304).

The district court found that Mr. Gambaro had disclosed the Cherry Model 5 to potential investors in order to obtain capital. As such, the district court reasoned that these disclosures showed the invention entered the public domain prior to the critical date because Mr. Gambaro's business partner was under no obligation to keep the Cherry Model 5 secret. Motionless Keyboard, 2005 WL 1113818, at *28. Further, the disclosures to potential investors showed that Mr. Gambaro attempted to obtain capital to develop his invention. Id. The district court found the NDAs inconsequential because "a confidentiality agreement will not preclude application of the public use doctrine, if the device was disclosed for commercial purposes." Id. (citing Kinzenbaw v. Deere & Co., 741 F.2d 383, 390 (Fed.Cir.1984)). MKC admits to a series of limited disclosures to potential investors to raise capital to develop the invention and prosecute the patent application. However, MKC further contends that the disclosures did not involve the Cherry Model 5 or its use as claimed in the '477 or '322 patents.

"The classical standard for assessing the public nature of a use was established in [Egbert v. Lippman, 104 U.S. 333, 26 L.Ed. 755 (1881)]. In Egbert, the inventor of a corset spring gave two

samples of the invention to a lady friend, who used them for more than two years before the inventor applied for a patent." Invitrogen, 424 F.3d at 1382. Although the inventor in Egbert did not obtain any commercial advantage, the Court determined that the invention had been used for its intended purpose for over a decade without limitation or confidentiality requirements. Thus, even though not in public view, the invention was in public use. Id. In Electric Storage Battery Co. v. Shimadzu, 307 U.S. 5, 59 S.Ct. 675, 83 L.Ed. 1071 (1939), the Court found "the ordinary use of a machine or the practice of a process in a factory in the usual course of producing articles for commercial purposes is a public use." Id. at 20, 59 S.Ct. 675. On the other hand, in TP Laboratories, Inc. v. Professional Positioners, Inc., 724 F.2d 965 (Fed.Cir.1984), this court found that premature installation of an inventive orthodontic appliance in several patients without a written confidentiality agreement was not a public use due to the expectation of confidentiality inherent in the dentist-patient relationship. This case again presents the question of the meaning of public use under 35 U.S.C. § 102(b).

In this case, Mr. Gambaro disclosed his Cherry Model 5 to his business partner, a friend, potential investors, and a typing tester (Ms. Lanier). In all these disclosures, except in the case of Ms. Lanier, however, the Cherry Model 5 was not connected to a computer or any other device. In the case of Ms. Lanier, the Cherry Model 5 was used to conduct typing tests on July 25, 1990, and thereby connected to a computer for its intended purpose. With respect

to the '477 patent, the typing test occurred after the critical date of June 6, 1990. With respect to the '322 patent, Ms. Lanier appears to have performed a one-time typing test to assess typing speed. The typing test by Ms. Lanier was allegedly performed on July 25, 1990 and, according to a synopsis of NDAs in the record, Ms. Lanier signed an NDA on the same day. The critical date for the '322 patent is January 11, 1992. In this case, the one time typing test coupled with a signed NDA and no record of continued use of the Cherry Model 5 by Ms. Lanier after July 25, 1990 did not elevate to the level of public use. Thus, the Cherry Model 5 was never in public use. All disclosures, except for the one-time typing test, only provided a visual view of the new keyboard design without any disclosure of the Cherry Model 5's ability to translate finger movements into actuation of keys to transmit data. In essence, these disclosures visually displayed the keyboard design without putting it into use. In short, the Cherry Model 5 was not in public use as the term is used in section 102(b) because the device, although visually disclosed and only tested one time with a NDA signed by the typing tester, was never connected to be used in the normal course of business to enter data into a system.

Unlike the situations in Egbert and Electric Storage Battery, where the inventions were used for their intended purpose, neither the inventor nor anyone else ever used the Cherry Model 5 to transmit data in the normal course of business. The entry of data did not ever occur outside of testing and the tester signed an NDA. The Cherry Model 5 was

not used in public, for its intended purpose, nor was the Cherry Model 5 ever given to anyone for such public use. Thus, the disclosures in this record do not rise to the level of public use.

On another issue, the district court determined that Mr. Gambaro had admitted that the '322 patent was invalid for obviousness by filing a terminal disclaimer to make the '322 coterminous with the '477 patent. The district court reasoned that this filing conceded that the '322 patent was obvious in light of the '477 patent. Motionless Keyboard, 2005 WL 1113818, at *29. A terminal disclaimer simply is not an admission that a later-filed invention is obvious. Quad Envtl. Tech. Corp. v. Union Sanitary Dist., 946 F.2d 870, 874 (Fed.Cir.1991). Thus, the trial court erred on this point and the '322 patent is not invalid due to obviousness.

V

This court affirms the district court's claim construction and the summary judgment of no infringement. However, this court reverses the district court's summary judgment ruling of invalidity of the '477 and '322 patents. This court also reverses the district court's finding that the '322 patent is invalid for obviousness due to patentee's terminal disclaimer.

COSTS

Each party shall bear its own costs.

AFFIRMED-IN-PART and REVERSED-IN-PART.

NOTE: This order is nonprecedential.

United States Court of Appeals for the Federal Circuit

2005-1497

MOTIONLESS KEYBOARD COMPANY,

Plaintiff-Appellant,

MICROSOFT CORPORATION,

Defendant-Appellee,

and

NOKIA INC.,

Defendant-Appellee,

and

SAITEK INDUSTRIES LTD.,

Defendant-Appellee.

ON MOTION

Before RADAR, DYK, and MOORE, Circuit Judges.

PER CURIAM

ORDER

Nokia, Inc. and Saitek Industries move for a 30 day extension of time to seek panel rehearing or rehearing en banc. Motionless Keyboard Company moves for a 30 day extension of time to file a petition for panel rehearing.

Upon consideration thereof,

IT IS ORDERED THAT:

The motions are denied.

FOR THE COURT

June 14, 2007
Date

Jan Horbaly
Clerk

Cc: James L. Buchal, Esq.
J. Christopher Carraway, Esq.
Lawrence D. Rosenberg, Esq.
Joseph W. Price, Esq.

No. 05-1497

United States Court of Appeals
for the Federal Circuit

MOTIONLESS KEYBOARD COMPANY,
Plaintiff-Appellant,

v.

MICROSOFT CORPORATION,
Defendant-Appellee,

and

NOKIA INC.,
Defendant-Appellee,

and

SAITEK INDUSTRIES LTD.,
Defendant-Appellee.

Appeal from the United States District Court
for the District of Oregon in Case No. 04-CV-180,
Judge Ann L. Aiken

DECLARATION OF JAMES L. BUCHAL IN SUPPORT OF MOTION FOR EXTENSION OF TIME

James L. Buchal
Murphy & Buchal LLP
2000 SW First Ave., Ste. 320
Portland, OR 97201
Phone: 503-227-1011

James L. Buchal, being duly sworn, deposes and says:

1. I am counsel to plaintiff in this action. I make this declaration in support of Motionless Keyboard Company's (hereafter "MKC") motion for an extension of time in which to file its petition for rehearing of the panel opinion issued May 29, 2007.

2. Good cause exists for this motion because the inventor and principal client contact for MKC, Mr. Gambaro, was involved in an apartment fire in May that has caused him to suffer eviction proceedings; he has had to move to new lodgings; and as a result has not been able adequately to consider the options of Motionless in the wake of the panel opinion.

3. In addition to considering a petition for rehearing, Motionless has also received proposals from certain defendants concerning possible

settlement. Motionless requires additional time to make informed choices concerning these patents and the infringement claims.

I certify under penalty of perjury that the foregoing is true and correct.

Executed on June 12, 2007.

MURPHY & BUCHAL LLP

_____

James L. Buchal, OSB #92161

United States Patent **Patent Number: 5,332,322**
Gambaro **Date of Patent: Jul. 26, 1994**

ERGONOMIC THUMB-ACTUABLE KEYBOARD FOR A HAND-GRIPPABLE DEVICE

Inventor: Thomas L. Gambaro, 3231 SE. 36th Ave., Portland, Oreg. 97202

Notice: The protion of the term of this patent subsequent to Jan. 12, 2010 has been disclaimed.

Appl. No.: 3,118

Filed: Jan. 11, 1993

Related U.S. Application Data

Continuation-in-part of Ser. No. 711,760, filed Jun. 6, 1991, Pat. No. 5,178,477.

Int. Cl.[5].....B41J 5/14; H04M 7/00
U.S. Cl......400/489; 379/433
Field of Search.....400/489,88; 364/709.15, 709.16, 705.05; 379/433, 368, 434, 440

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Primary Examiner: Edgar S. Burr
Assistant Examiner: Anthony H. Nguyen
Attorney, Agent or Firm: Kolisch Hartwell Dickinson McCormack & Heuser

Abstract

A hand-held thumb-actuated ergonomic keyboard input device for use with a coupled electronic system

such as a selector on a portable telephone. The device includes a housing which incorporates a hand-grippable portion that permits the device to be held in one hand with the thumb free to move at least temporarily to a predetermined key-actuation position. In other words, the grippable portion allows the device to be securely held with the fingers and with the thumb-free. A keyboard cluster is provided on the device in a concavity in the housing. The keyboard is located at the predetermined thumb-accessible key-actuation position and includes a key arrangement which allows the thumb to selectively actuate individual keys. Only slight gestural movements of the thumb are required to actuate individual keys on the keyboard. The gestural movements include mixed lateral and endo translation of the thumb within the keyboard concavity. The keyboard is particularly useful on devices such as portable telephones where two-hand actuation is sometimes difficult.

5 Claims, 6 Drawing Sheets

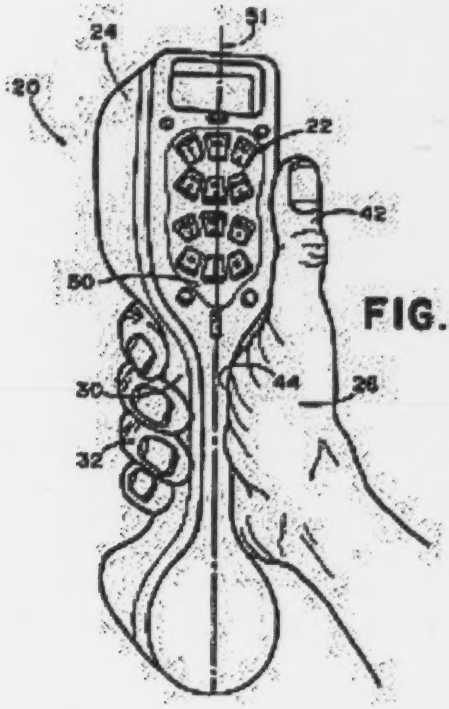

FIG. 1

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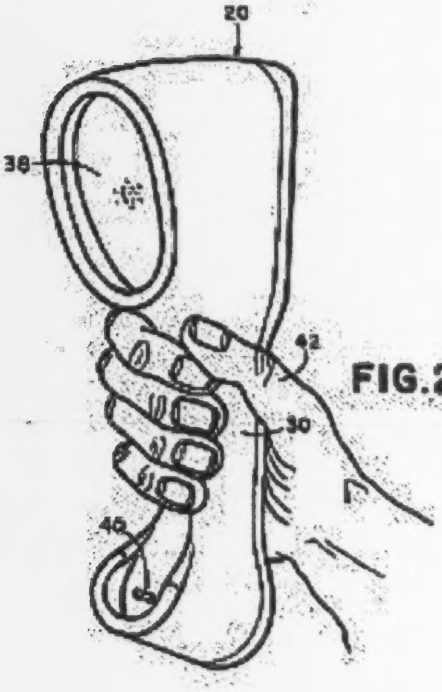

FIG.2

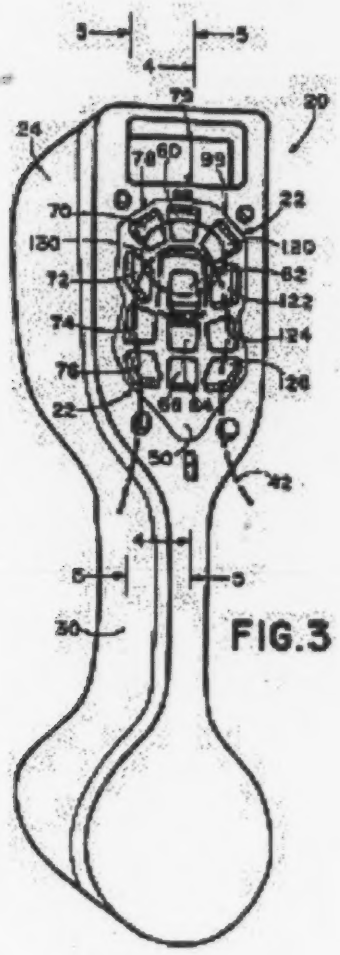
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FIG.3

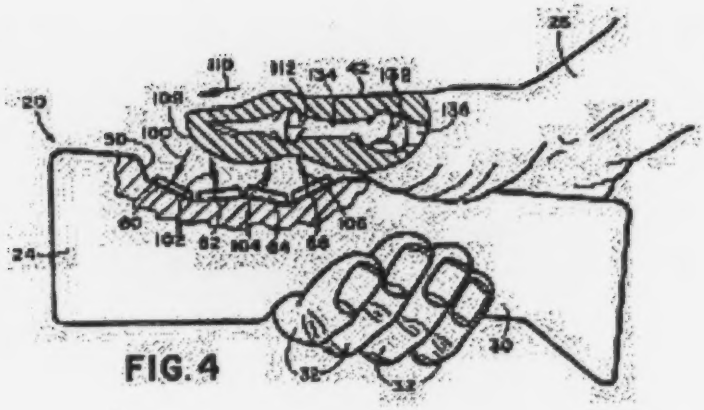

FIG. 4

U.S. Patent

U.S. Patent

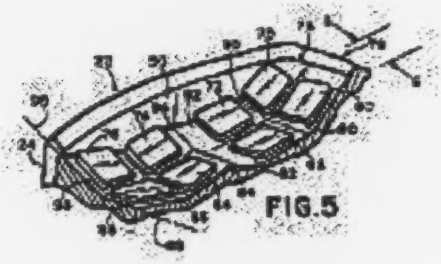

FIG. 5

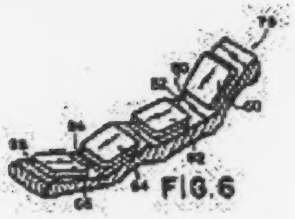

FIG. 6

FIG.7

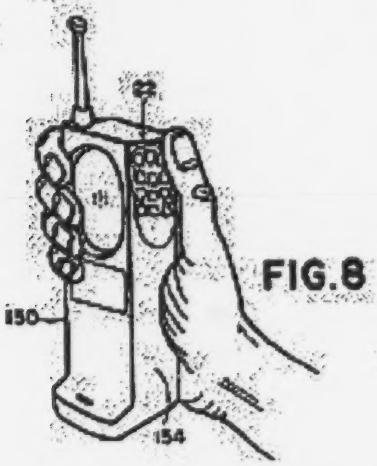

FIG.8

ERGONOMIC THUMB-ACTUABLE KEYBOARD FOR A HAND-GRIPPABLE DEVICE

CROSS REFERENCE TO RELATED APPLICATION

This is a continuation in part of application Ser.No. 07/711,760, filed Jun. 6, 1991, entitled ERGONOMIC KEYBOARD INPUT DEVICE."

Which will issue as United States Letters Patent No. 5,178,477 on Jan. 12, 1993.

BACKGROUND AND SUMMARY OF THE INVENTION

The present invention relates to a keyboard input device for transmitting information to a suitably coupled electronic system, such as a telephonic switching system or a digital computer. More particularly, it relates to such a device wherein the keyboard is specially ergonomically designed with reference to the architecture of the human hand in such fashion that, at least with respect to the thumb on the hand, only slight gestural motion is required for effective, multiple, differentiated key actuation.

Electronic devices continue to be developed which incorporate keyboards or keypads for information entry into an electronic system. Hand-held devices, particularly devices designed to be gripped and held in one hand, are made for a variety of tasks. A portable telephone, such as a cellular telephone, is an example of a hand-held device designed to be gripped and held in one hand and which includes a keyboard information entry system. Because portable telephones are sometimes used by a person engaged in an activity which requires more or less continuous use of the hand which is not holding the telephone, such as driving a car, the ability to both grip a portable telephone and operate its keyboard with a single hand would be useful. Since the user's fingers are customarily employed in

gripping the telephone, it would be particularly helpful if a keyboard could be provided which is operable by the user's thumb.

Recent advancements in the development of finger-associable key clusters have helped achieve a better understanding of how keys can be arranged to confront, in an advantageous way, the skeletal architecture of the hand. In the parent application of which this application is a continuation-in-part, namely, applicant Ser. No. 07/771,760, filed Jun. 6, 1991, entitled ERGONOMIC KEYBOARD INPUT DEVICE, which will issue as U.S. Pat. No. 5,178,477, the specification of which is incorporated herein by reference, I have described my new ergonomic keyboard input device which incorporates finger-associable key clusters. The problem addressed by my invention has lead to the development of a new generation of ergonomic keyboard input devices, of which the present invention is one example.

In recent past years, there has been a dynamic and explosive growth in the use of keyboard devices. This growth, as many know, has been driven largely by the proliferation and ready availability of computer systems for substantially all arenas of society, ranging from business to individual settings. Accompanying this explosion, unhappily for those who spend many hours using such devices, are various annoying and debilitating muscular syndromes that result from repetitive, fatiguing hand, wrist and finger motions that are required in the use of the ubiquitous, conventional typewriter-like keyboards. These syndromes translate not only

into pain and discomfort for the affected users, but also into significant loss of productivity--clearly two problems to which corrective attention should be given.

Attention to this problem, generally, is not new in the art, as is evidenced by many serious attempts to alleviate keyboard-use "injuries" through innovative keyboard layouts and architectural designs. Two very good illustrations of approaches taken in the prior art are illustrated in U.S. Pat. Nos. 4,332,493 to Einbinder, and 4,849,732 to Dolenc.

The Einbinder patent discloses a typewriter keyboard in which, not only are keys laid out in a fashion relating to what might be though of as the "footprint" of the human hand, but also the proposed keys are designed with topographically height- and angle-differentiated actuation pads that tend to minimize, somewhat, overall hand and finger motion during use. However, the Einbinder system still focuses significant attention on the importance of having so-called "home positions" for the finger and thumb tips, from which positions the fingers (and therefore the hands) must travel appreciably in order to perform the usual kinds of typing operations. Thus, the Einbinder approach steps toward, but closes only a portion of the gap in, solving the motion difficulties encountered with conventional keyboards. Put another way, Einbinder does not substantially eliminate these difficulties.

The Dolenc patent illustrates and describes a one-hand key shell which includes fan-like arrays of plural keys distributed in elongate rows and organized for specific actuation by the thumb and four fingers of a hand. Angular and topographical distinctions for individual keys, such as those shown in the Einbinder patent, are not present in the Dolenc system. Dolenc also, apparently, does not establish a "home position" for the tips of the fingers and thumb. Dolenc is concerned with minimizing hand motion, but not particularly finger motion. In fact, Dolenc speaks in terms of organizing keys in the arrays in such a fashion that they take into account the "motion and range of the respective fingers of the hand." Thus, Dolenc clearly contemplates fingertip actuation of each key, and reinforces this concept by teaching that a full equivalent of the push-button keys which he illustrates could take the form of a series of flat-panel touch pads. Accordingly, while Dolenc seriously addresses the issue of minimizing hand motion, his system does not appreciably contribute to minimizing finger motion (and hence related wrist motion).

There are other patents of which I am aware that address, to different degrees, modified keyboard arrangements. These include U.S. Pat. Nos. 2,369,807 to Solon, 4,244,659 to Malt, 4,579,470 to Casey, 4,597,681 to Hodges, and 4,824,268 to Diernisse H.V. None of these latter-mentioned five patents appears to address, at least as pointedly as Einbinder and Dolenc, the issues of keyboard motion "injuries."

In addressing the problems associated with repetitive finger motion I have also developed an ergonomic keyboard configuration which addresses the problem of providing a thumb-actuable keyboard on a hand-grippable device such as a portable telephone. Since there is a need for thumb-actuable keyboards on electronic instruments such as telephones, it is an object of the present invention to provide such a keyboard input device which allows a user to input numbers or other information into the device using only the thumb, thereby allowing the rest of the digits on the user's hand to be employed in gripping the device.

Another object of the invention is to provide a thumb-actuable key cluster on a keyboard which minimizes the motion required of the thumb to input information via actuation of the keys.

Still another object of the invention is to provide a thumb-actuable key cluster which is readily usable, by temporary movement of the thumb, to a key-actuation position on the device without having to release the user's grip on the device.

Accordingly, a hand-held device is provided for entering information into an electronic system via a keyboard. The device comprises a housing having a grippable portion which permits the device to be held in one hand with the thumb free to move at least temporarily to a predetermined key-actuation position while the device is held. The unique architecture of the device includes a concavity

formed in the housing at the aforementioned key-actuation position. A thumb-associable cluster of keys forms a keyboard within the concavity. The keys are selectably actuable via mixed lateral, and slight endo, translation of a thumb within the concavity, whereby information is entered into the electronic system.

In its preferred form, the concavity on the housing of the device contains a plurality of keys which are located within a cone of motion of the user's thumb whose apex resides adjacent the base of the thumb. Individual keys in the cluster of keys are oriented in planes which are angularly offset from one another to permit selective actuation by minimal movement of a thumb positioned in the concavity.

These and other objects attained, and advantages offered, by the present invention will become more fully apparent as the description that now follows is read in conjunction with the accompanying drawings.

DESCRIPTION OF THE DRAWINGS

FIG. 1 is a perspective view of a hand-held portable telephone in accordance with the present invention with the thumb of the user's hand moved to a position adjacent the keyboard of the device.

FIG. 2 is a perspective view of the portable telephone of FIG. 1, rotated in orientation, showing the device when it is gripped by the user with the thumb moved away from the keyboard of the device.

FIG. 3 is an enlarged perspective view of the portable telephone of FIGS. 1 and 2 illustrating (in phantom) the approximate location of the user's thumb when in its key-actuation position.

FIG. 4 is a side view of the portable telephone and hand shown in FIGS. 1 and 2, in partial cross section taken along lines 4--4 of FIG. 3, illustrating the position of the user's thumb when just above the key-actuation position.

FIG. 5 is a partial, schematic, partially cross-sectional perspective view of a portion of the keyboard on the telephone of FIGS. 1-4 taken approximately between lines 5--5 of FIG. 3.

FIG. 6 is a partial perspective partially cross-sectional view taken between lines 6--6 of FIG. 5 showing the central column of keys in the cluster of keys and illustrating the angular offset between the support planes of individual keys.

FIG. 7 is a perspective view as in FIG. 1 showing an alternative embodiment of a hand-held device incorporating the present invention.

FIG. 8 is another alternative embodiment of the portable telephone of FIG. 1.

DETAILED DESCRIPTION AND BEST MODE FOR CARRYING OUT THE INVENTION

Turning attention now to the drawings and referring first to FIG. 1, there is indicated generally at 20 a hand-held device, namely, a portable

telephone, which incorporates my invention. The device 20 includes a keyboard 22 for transmitting information supplied by a human operator (user) to a suitable electronic system (not shown) such as the internal components within device 20, which are in turn coupled via a broadcast or wire connection to external devices (not shown). The coupling arrangement between keyboard 22 and a suitable electronic system is very well know to those skilled in the art and forms no part of the present invention. Hence, it is omitted from the drawings and from any further discussion.

The portable telephonic device 20 has an exterior housing 24 which is shaped or contoured to include at least a portion which is easily and securely held in the hand 26 of a user. In particular, the housing 24 includes a grippable portion 30 which is a part of the housing and is capable of being held in one hand with the user's fingers 32 partially wrapped around the grippable portion.

Keyboard 22 is provided on what may be thought of as the back side of the telephone, i.e., the side opposite to that which is held adjacent the user's mouth and ear when the telephone is used for conversational communication. FIG. 2 illustrates in perspective the front side of portable telephone 20 and shows the user's hand gripping the grippable portion 30 in a manner typically used when speaking into the telephone. The telephone includes an earpiece 38 for holding adjacent the user's ear and a mouthpiece 40 for holding adjacent the mouth when the phone is in use, as is very well known.

Grippable portion 30 of the housing 24 is preferably sized to allow the user's fingers to partially encircle the grippable portion and press it into the palm of hand 26. In particular, the size and shape of the grippable portion of the telephone should permit the user to grip and hold the device in the palm of the hand without use of the thumb 42. Instead, the fingers will press the grippable portion between the fingers and the "ball" of the thumb 44 (the "ball" being otherwise known as the thenar eminence). When device 20 is held in that manner, the thumb is free to move, at least temporarily, to a predetermined key-actuation position overlying keyboard 22 without losing an effective hold on the device. In other words, the user's thumb 42 can be moved freely between the position shown in FIGS. 1 and 2, or to an intermediate position for actuating the keyboard, while the user maintains a firm grip on the device.

Turning next to FIG. 3, wherein the backside of the portable telephone device 20 is illustrated on an enlarged scale, keyboard 22 is positioned in a concavity or depression 50 in housing 24. The concavity 50 is located for convenient key-actuation by the user's thumb, which is shown in phantom at 42. The position of thumb 42 in FIG. 3 is referred to as the predetermined key-actuation position in which the thumb is in operational contact with the keyboard 22.

Keyboard 22 within concavity 50 is a thumb-associable cluster of depressible keys. Each of the

keys is selectively actuable via movement along an axis of motion generally perpendicular to the support plane of the key. In other words, each key is actuated by depressing the key. The illustration of the keys in FIG. 3 is somewhat schematic with respect to the support planes of the keys. The individual keys in keyboard 22 are oriented in planes which are angularly offset from one another in a unique arrangement which allows for selective actuation by the thumb with a minimum of motion, referred to in the parent application as "gestural" motion, as will be described below.

Turning next to FIG. 4, which is a partially cross-sectional view of telephone 20 taken generally down the center longitudinal axis 51 of the telephone (see FIG. 1), the user's hand and thumb are illustrated with thumb positioned just above its key-actuation position. The concavity 50 in which the keys are positioned is illustrated in FIG. 4 with the central column of keys 60, 62, 64, 66 (which extend along axis 51) also illustrated. As noted above, the keys are oriented in planes which are angularly offset from one another.

Turning attention now to FIG. 5, two columns of keys on the keyboard 22 are illustrated with all but the immediately adjacent parts of the housing cut away. Housing 50 is preferably formed of a suitable lightweight molded plastic material. Each of the keys herein is conventional in construction and takes the form of a momentary push button. Electrical connections to the keys have been omitted because they are conventional and form no part of

the present invention. What is of importance is the angular orientation and placement of the individual keys in concavity 50, which will now be described. The leftmost longitudinal column of keys (as illustrated in FIG. 3) 70, 72, 74, 76, and the previously-identified central longitudinal column 79 of keys 60, 62, 64, 66 are depicted in FIG. 5 within a partial cross-sectional slice of concavity 50.

Keys 60, 62, 64, 66, 70, 72, 74, 76 each lie on planar surfaces which are formed in concavity 50. Four of the planar surfaces support the central column 79 of keys 60, 62, 64, 66, the surfaces being shown separately at 80, 82, 84, 86, respectively, in FIG. 6. These planes intersect one another in a mixed pattern of obtuse and reflex angles according to the invention, and in this respect, planes 80, 82 intersect one another at an obtuse angle of about 105-degrees, planes 82, 84 at a reflex angle of about 210-degrees, and planes 84, 86 at an obtuse angle of about 150-degrees. As can be seen, there is a slight step which is formed between planes 82, 84. A similar relationship exists between the support planes 90, 92, 94, 96 for keys 70, 72, 74, 76, respectively (see FIG. 5). Namely, planes 90, 92 intersect one another at an obtuse angle of about 105-degrees, planes 92, 94 at a reflex angle of about 210-degrees, and planes 94, 96 at an obtuse angle of about 150-degrees. There is a slight step which is formed between planes 92, 94.

The entire left column of keys 70, 72, 74, 76 is angled downwardly into concavity 50, toward the central keys 60, 62, 64, 66. The angular offset

between the rows of keys can in part be visualized and described by noting the angle of the plane 96 of key 76 with respect to a horizontal reference line 88, which represents the angle of the plane 86 of key 66. Line 98 and plane 96 meet line 88 and plane 86 at an obtuse angle of about 120-degrees.

The angular dispositions just described between the support planar surfaces for the keys in columns 78 and 79 have been selected herein, as will be explained, to take advantage of the underside architecture of the skin and bone structure in a user's thumb. Keyboard 22 also includes a third column of keys, i.e., the rightmost column generally parallel with columns 78 and 79. Rightmost column 99 is omitted from FIG. 5 for clarity but is a mirror image of leftmost column 78. In particular, the individual keys in rightmost column 99 are oriented in planes which are angularly offset from one another in the same manner as are the keys in leftmost column 78. The only difference between the orientations of the keys in columns 78 and 99 is that in column 78 the keys angle upwardly from right-to-left and the keys in column 99 the keys angle upwardly from left-to-right.

The advantage of having the keys in the cluster arrangement of keyboard 22 oriented in planes is that the angularly offset support planes for the keys allows the keys to be selectively actuated by mixed lateral, and slight endo, translation of a thumb positioned in concavity 50. Turning particularly to FIGS. 3, 4 and 5, the user moves his or her thumb 42 to a position overlying the central

row of keys 79 whenever the user elects to actuate individual keys. FIG. 4 illustrates the thumb in partial cross section with the bones of the thumb visible. The thumb is depicted as hovering directly over the middle row 79 of keys 60, 62, 64, 66. Small arrows 100, 102, 104 and 106 indicate generally the direction in which actuating force must be applied to keys 60, 62, 64, 66, respectively, in order to actuate the individual keys.

When the user intends to actuate the keys, the thumb 42 is rotated downwardly onto the keyboard. In that position, each key in the keyboard can be actuated by slight gestural movements of the thumb. For example, the tip of the thumb 108 can exert a force in the direction of arrow 100 on key 60 by a slight endo movement of the thumb in the direction of arrow 110. A slight downward movement of tip 108 exerts an actuating movement in direction of arrow 102 on key 62. A slight flexure of the thumb in the region of the interphalangeal joint 112, flexing the joint downwardly together with a slight endo movement of the thumb, exerts a force in the direction of arrow 104 on key 64. Finally, a downward flexion of interphalangeal joint 112 with a slight retracting movement of the thumb, in the direction opposite to arrow 110, exerts a actuating force in the direction of arrow 106 on key 66.

Referring again to FIG. 3, the keys 70, 72, 74, 76 in the left column 78 of keys are actuated in a manner similar to that just described for the central column 79. If thumb 42 is rotated or moved slightly laterally to the left (as viewed in FIG. 3) and the

gestural motions described in the last paragraph for actuating keys 60, 62, 64, 66 are repeated, keys 70, 72, 74, 76 are selectively actuated. In other words, a slight left lateral shift in the orientation of the forces exerted on the keyboard allows the user to selectively actuate the keys in left column 78. The keys in right column 99, namely, keys 120, 122, 124, 126 are similarly actuated by a slight right lateral movement of thumb 42, coupled with the gestural motions described in the preceding paragraph.

The thumb-actuated keyboard of the present invention requires only a small amount of movement of the user's thumb to selectively actuate any of the keys of the keyboard. The thumb need only be moved within a small cone of motion illustrated generally with dashed lines at 130 in FIG. 3 in order to actuate any individual key. The operative cone of motion 130 of the user's thumb has an apex adjacent the base of the thumb at 132, in the region of the joint between the first phalanx 134 and the first metacarpal bone 136. The user can move the thumb to any position within the cone of motion in order to operate the keys on keyboard 22. Or the thumb can be moved to a rest position away from keyboard 22 and outside the cone of motion whenever the user is not engaging the keyboard or entering information into the device via the keyboard.

Another way of describing the positions of the keys 52 in cavity 50 is to identify the keys in relationship to the thumb of the user when it is positioned in concavity 50. All the keys are supported on wall surfaces of concavity 50 in orientations which

are angularly offset from one another, as described above. Referring to FIGS. 3, 4 and 5, the top row of keys 60, 70 and 120 are arrayed generally radially about the tip or distal end 110 of thumb 42 (see FIG. 4). Keys 60, 70 and 120 are positioned on a distal wall of concavity 50 which angles downwardly into the concavity and includes support plane 80 for key 60, support plane 90 for key 70, and a support plane which is a mirror image of support plane 90 for key 120.

The bottom row of keys on keyboard 22 include keys 66, 76 and 126. Those keys are closest to the proximal end of the user's thumb and are supported on a proximal wall of concavity 50 which angles downwardly into the concavity and supports keys 66, 76 and 126. The bottom row of keys are arrayed generally radially about the first phalanx 134 (see FIG. 4) of thumb 42 when the thumb is positioned in the concavity. The proximal wall of the concavity includes key support planes 86, 96 and a mirror image of plane 96 supporting key 126.

The medial keys of the keyboard 22 include keys 62, 64, 72, 74, 122 and 124. The medial keys are supported on medial wall surfaces of concavity 50 in orientations which array the keys generally radially about the first phalanx 134 (see FIG. 4) of thumb 42 when the thumb is positioned in the concavity. The medial key support planes include planes 82, 84 supporting keys 62, 64, respectively; planes 92, 94 supporting keys 72, 74, respectively; and support planes which are mirror images of planes 92, 94 supporting keys 122, 124, respectively.

The arrangement of the keys in the thumb-actuable key cluster 22 provides a means for entering information into an electronic system via a keyboard utilizing only thumb actuation. Moreover, only limited gestural key-actuation motion of the thumb is required in order to operate the keyboard.

The present invention can also be incorporated into other types of devices. FIGS. 7 and 8 illustrate alternative embodiments of the present invention. In FIG. 7, a thumb-actuable keyboard 22 identical to the keyboard described above is incorporated into a hand-held device 140, which is a generic representation of a device for performing any desired task. Device 140 can be, for example, a control stick on a substantially larger piece of machinery. It can also be a hand-held device for scanning objects which pass beneath its base 142. It can be a hand-held calculator or another type of computational device. Or it can be an inventory control or other simple data entry device. FIG. 8 shows an alternative embodiment of a portable telephone 150 incorporating a keyboard 22 identical with the keyboard of the first embodiment. In this portable telephone 150, the keyboard is positioned on the side 154 of the telephone instead of on the back. Other potential applications for hand-held devices which include the thumb-associable keyboard of the present invention include video game controllers, robotics controllers, hand-held remote controller units for television sets, or model toy and airplane controllers. To further enhance the viability and usefulness of the overall system it may be ideal to modify the

electronic system to which the keyboard is attached to include preprogrammed speaker-transmitted voice responses to the individual keystrokes actuated by the user.

While the preferred embodiment of the invention has been described herein, it is appreciated that variations and modifications will become apparent to those skilled in the art and may be made without departing from the spirit of the invention.

What is claimed is:

1. A hand-held device for entering information into an electronic system via a keyboard, the device comprising:

a housing having a grippable portion which permits the device to be held in one hand with the thumb free to move at least temporarily to a predetermined key-actuation position while the device is held,

a concavity in said housing at said key-actuation position, and

a thumb-associable cluster of keys forming a keyboard within said concavity, each of the plurality of keys in said cluster being selectively actuable via mixed lateral, and slight endo, translation of a thumb within said concavity, whereby information is entered into an electronic system.

2. A device as in claim 1 in which said keys are located in said concavity within a cone of motion of a user's thumb, when the thumb is positioned in said concavity, whose apex resides adjacent the base of the thumb.

3. A device as in claim 1 wherein said cluster of keys includes individual keys oriented in planes which are angularly offset from one another to permit selective actuation by said mixed lateral, and slight endo, translation of a thumb positioned in said concavity.

4. A device as in claim 1 in which said concavity in said housing includes wall surfaces for supporting individual keys in said cluster in orientations which are angularly offset from one another, including a distal wall which angles downwardly into said concavity and supports a plurality of distal keys arrayed generally radially about the tip of a thumb when positioned in said concavity, a proximal wall which angles downwardly into said concavity and supports a plurality of proximal keys arrayed generally radially about the first phalanx of a thumb when positioned in said concavity, and a plurality of medial wall surfaces supporting a plurality of medial keys in orientations which partially surround the interphalangeal joint of a thumb when positioned in said concavity.

5. A device as in claim 1 in which said grippable portion is a handle which can be gripped between the fingers and thenar eminence of a user's hand, whereby when the device is gripped thus, the user's

thumb is selectively movable into said concavity without the user losing a grip on the device.

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(2)

No. 07-574

IN THE

Supreme Court of the United States

MOTIONLESS KEYBOARD COMPANY,

Petitioner,

v.

MICROSOFT CORPORATION, ET AL.,

Respondents.

On Petition for a Writ of Certiorari
to the United States Court of Appeals
for the Federal Circuit

OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI

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QUESTIONS PRESENTED

1. Whether this Court should exercise its supervisory powers to review the Federal Circuit's routine exercise of its discretion to deny Petitioner's request for additional time to seek panel rehearing.

2. Whether this Court should review the Federal Circuit's fact-bound ruling that Petitioner's claims for infringement under the doctrine of equivalents were correctly rejected by the district court on summary judgment, where (a) Petitioner had adduced insufficient evidence to support those claims, (b) acceptance of those claims would entirely vitiate at least one of the relevant patent claim elements, and (c) those claims would ensnare prior art.

CORPORATE DISCLOSURE STATEMENT

Respondent Nokia, Inc.'s parent corporation is Nokia Holding, Inc. Nokia Holding, Inc.'s parent corporation is Nokia Corporation. Nokia Corporation is the only publicly traded Nokia entity, and no publicly held company owns more than 10% of Nokia Corporation's stock.

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BRIEF IN OPPOSITION FOR RESPONDENT NOKIA, INC.

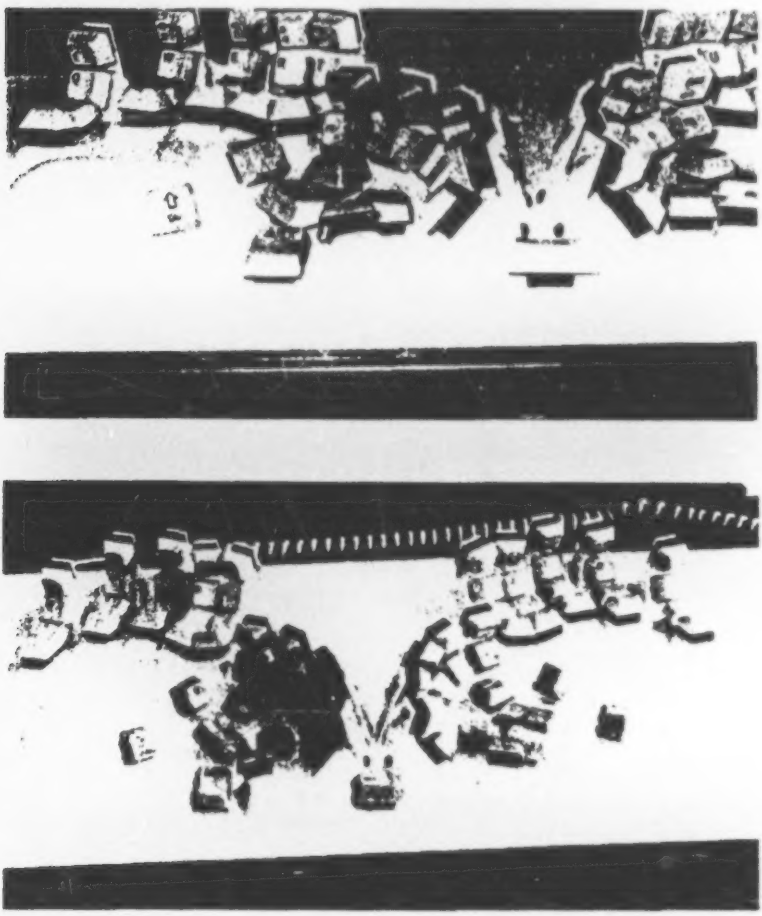
STATEMENT

1. U.S. Patent No. 5,332,322 (the "'322 patent"), is the remaining patent at issue in this case. U.S. Patent No. 5,178,477 (the "'477 patent"), had originally been asserted, but Petitioner did not appeal the district court's ruling of non-infringement as to that patent. The '322 patent is entitled "Ergonomic Thumb-Actuable Keyboard for a Hand-Grippable Device" and refers to a keyboard input device for transmitting information to an electronic system, such as a telephone switching system or a computer. Pet. App. A25-27. More particularly, the patent "relates to such a device wherein the keyboard is specially ergonomically designed with reference to the architecture of the human hand in such fashion that, at least with respect to the thumb on the hand, only slight gestural motion is required for effective, multiple, differentiated key actuation." *Id.* A33.

The device claimed by the '322 patent consists of three distinct elements: a "housing" with "a grippable portion which permits the device to be held in one hand with the thumb free to move at least temporarily"; a "concavity in said housing"; and "a thumb-associable cluster of keys forming a keyboard within said concavity." *Id.* A49. The '322 patent does not claim a concavity in the keypad or in any of the keys of the device. Further, the patent requires a keyboard having keys that can be actuated through slight gestural motion of the thumb "within" the "concavity" in the housing. *Id.* A48-49. This keyboard is designed to be dialed using side-to-side

and forward translations of the thumb within the housing's concavity, as opposed to the conventional actuation using an inward bending and downward motion of the thumb tip. *Id.* A27.

The following are pictures of a keyboard that is an admitted embodiment of the '322 patent:

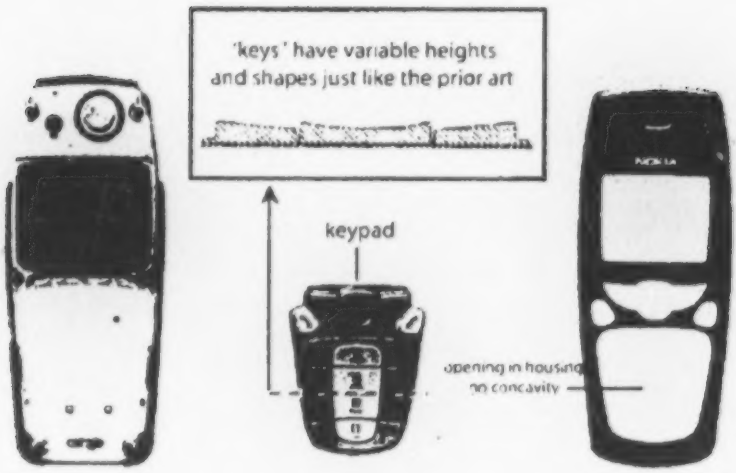


S.A. 67sa-68sa.

2. Petitioner Motionless Keyboard Company ("MKC") owns the '322 patent. On February 9, 2004, at the direction of Thom Gambaro, the company's controlling director and the named inventor of the '322 patent, MKC filed suit against Respondents Microsoft Corporation (Microsoft), Nokia, Inc. (Nokia), and Saitek Industries (Saitek) (collectively, "Respondents") in the United States District Court for the District of Oregon. MKC alleged infringement by all Respondents of the '322 patent, and by Respondents Microsoft and Saitek of the '477 patent, but as noted, MKC did not appeal the district court's ruling of non-infringement of the '477 patent, so only the '322 patent remains at issue. Pet. App. A4.

Specifically, MKC alleged that Respondents' devices–video game joysticks manufactured by Microsoft and Saitek and cellular telephones manufactured by Nokia–infringed the '322 patent by incorporating thumb actuation of keys within a concavity in the housing of the device. *Id.* According to MKC, the accused devices infringed both literally and under the doctrine of equivalents. *Id.*

Each of the accused Nokia phones has a keypad and a display. The accused phones do *not* contain a concavity in the housing at a key-actuation position into which a user can place a thumb. The figures of the accused phones demonstrate that the keys are part of a keypad that is placed onto a flat surface in each phone, with the keys protruding through an opening in the housing of each phone, rather than residing "within" any concavity.



Id. A11.

Some of the accused phones employ keypads that are not completely flat. To the extent that the slight depressions in some of the keys could be characterized as a "concavity," such a concavity is in the keypad itself, not in the housing of the phone, and the keys are activated by the conventional downward motion, not by "a slight gestural motion" of the thumb within the concavity.

3. On May 6, 2005, after the close of discovery, the district court granted Respondents summary judgment of non-infringement of the '322 patent. S.A. 1sa-50sa. The district court also granted Respondents' joint motion that the '322 patent is invalid, based upon the inventor's prior public use of the invention. *Id.* 50sa-66sa.

a. The district court construed the terms of the '322 patent "concavity in said housing" and "keyboard within said concavity" to mean that "the concavity must be formed by a depression in the housing of the

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device, and that all keys comprising the keyboard must be contained entirely within the concave area and sunk below the surface of the housing, so that the thumb movement occurs within the concave area." S.A. 38sa. Based upon the plain language of the claim, the patent specification, and the prosecution history, the district court rejected MKC's argument that the '322 patent encompasses either a "concavity" formed by the tops of the keys or an opening in the housing for the keyboard. *Id.* 33sa-38sa. The court recognized that the plain language of the patent claims requires that the keyboard be "within" the concavity, and that the keyboard cannot be "within" the concavity if it is the tops of the keys or the keyboard that forms the concave surface: "[I]f the court construed 'concavity' to include a depression formed by the tops of the keys or the keyboard, the claim limitations that require the concavity to be 'in' the housing and the keyboard to be 'within' the concavity would have no meaning." *Id.* 35sa.

The court further noted that the patent specification also describes keys positioned "in a concavity or depression" in the housing and illustrates the concavity as a bowl-like depression in the housing of the device. *Id.* The court recognized that the specification makes no reference to a concavity formed by the keys of the keyboard, and no specification drawing suggests that the keys or keyboard form the claimed concavity. *Id.* 35sa-36sa.

The district court thus expressly rejected MKC's proposed construction that the keys *themselves* can form the "concavity in the housing" called for by the '322 patent. *Id.* 33sa-38sa.

The district court rested this rejection not only on the patent's plain language, but also on the prosecution history–relying on prosecution estoppel resulting from a prior patent interference proceeding where the Administrative Patent Judge conclusively stated that the '322 patent did *not* cover a concavity formed by a keypad:

> Gambaro's claim 1 recites "a concavity in said housing . . . and a cluster of keys forming a keyboard in said concavity." Gambaro's claim does not recite a "concave keypad surface." . . . That the keyboard is positioned in the concavity does not mean that the keyboard itself conforms to the concavity."

Id. 36sa-37sa.

b. Based upon this construction, the district court held that the accused devices do not infringe the '322 patent. With specific respect to Nokia, the court held that there was no infringement because the cellular phones do not contain the claimed "concavity" in their housings or keypads "within" that concavity. S.A. 47sa-49sa.

First, the district court held that the accused Nokia phones did not literally infringe the '322 patent:

> I do not find that an opening in the cover of the Nokia phones meets the claimed limitation of "concavity" as construed by the court. An opening in a phone cover is not a "depression" sunk down below the surface of the housing. Likewise, I find that none of the phones contain a concavity by virtue of the slight depression formed by the keys or keypad surfaces, because the concavity must

> be in the "housing" of the device and the keypad must be located "within" the concavity to accommodate thumb actuation of the keys. If the keypad forms the concavity, the keys are not "within" the concavity, and the keypad cannot be activated by moving the thumb within the concavity.

Id. 48sa-49sa.

Second, the district court held that Nokia does not infringe the '322 patent under the doctrine of equivalents. The court noted that MKC had presented no evidence "that the accused [Nokia] phones perform substantially the same function in substantially the same way to obtain substantially the same result" as the claimed invention. *Id.* 49sa. Further, the district court held that the fact that MKC's equivalents theory "would vitiate the[] claimed elements" of the '322 patent requiring the keyboard to be "within the concavity of the housing" was an independently sufficient ground for rejecting that theory. *Id.* 35sa, 49sa. Finally, the court recognized that MKC is estopped from relying on the doctrine of equivalents to cover the sloped surface of the keypad because MKC's claim would "ensnare the prior art Einbinder patent." *Id.* 49sa.

c. In addition to holding that the Respondents do not infringe the '322 patent, the district court held that the patent is invalid because the invention had been in public use more than one year before the filing of the patent applications. S.A. 52sa-58sa. The district court rooted this public use holding in Gambaro's disclosure of his Cherry Model 5 keyboard—an admitted embodiment of the patent—

to investors for commercial purposes four years before the filing of the patent. *Id.*

4. On May 29, 2007, the Federal Circuit issued a decision affirming the district court's grant of summary judgment of non-infringement in Respondents' favor. The Federal Circuit upheld both the district court's construction of the '322 patent and its holding of non-infringement. Pet. App. A6-13. The Federal Circuit agreed with the district court that "[b]y using the terms 'concavity in said housing' and 'keyboard within said concavity,' the patentee defined a depression within the housing of the device and set the keyboard entirely within that depression." *Id.* A7. Accordingly, the Nokia cellular phones "do not literally infringe the '322 patent because [they] lack a concavity in the housing and a keyboard within the cavity." *Id.* A8.

The Federal Circuit also affirmed the district court's holding that the accused devices do not infringe the '322 patent under the doctrine of equivalents. *Id.* A11. As the Federal Circuit pointed out, "MKC only presented the district court with conclusory statements about equivalents." *Id.* This failure to put forward "particularized evidence and linking argument as to the insubstantiality of the differences between the claimed invention and the accused device" meant that MKC had not offered sufficient proof for a reasonable jury to find equivalence between the patented technology and the accused devices. *Id.* (internal quotations omitted).

MKC's evidentiary deficiency was particularly significant with respect to the infringement claims against Nokia. The court noted that MKC offered no

evidence "that the accused [Nokia] phones perform substantially the same function in substantially the same way to obtain [substantially] the same result" as the device covered by the '322 patent. *Id.* A12. Moreover, the court explained that while the '322 patent "points to actuation of the keys by thumb movement within the concavity, a user would actuate the Nokia keys by pressing them downward." *Id.* A13. Accordingly, the court held that "[a]s MKC did not provide any particularized testimony to specifically show that the keys work in the same way, the trial court properly granted summary judgment of non-infringement under the doctrine of equivalents." *Id.*

The Federal Circuit reversed the district court's ruling on invalidity and concluded that the '322 patent is valid, reasoning that the demonstrations noted by the district court did not involve sufficient actual uses of the patented technology to constitute invalidating prior uses. *Id.* A13-A18.

MKC never sought rehearing of the Federal Circuit's decision on the infringement claim. Instead, on June 12, 2007–the last day on which the parties could seek a panel rehearing–MKC filed a motion for extension of time in which to seek panel rehearing, citing a fire that Mr. Gambaro had caused in his apartment building and that there had been certain settlement communications between the parties. *Id.* A22-24; S.A. 87sa-94sa. Respondents also filed a motion for a corresponding extension of time in order to preserve their right to seek rehearing of the panel's holding on the validity issue in the event that MKC's motion for additional time were granted. S.A. 83sa-86sa. On June 14, 2007, the Federal Circuit

denied both motions in a written order without opinion. Pet. App. A20-21.

REASONS FOR DENYING THE WRIT

I. MKC'S CONTENTION THAT IT SHOULD HAVE BEEN PROVIDED ADDITIONAL TIME TO SEEK REHEARING IS NOT APPROPRIATE FOR CERTIORARI

MKC's contention that this Court should grant certiorari because the Federal Circuit denied its motion for additional time to seek rehearing is plainly unworthy of this Court's review. MKC cites *no* case from this Court to support its claim that the Federal Circuit so "departed from the accepted and usual course of judicial proceedings," Pet. 7, that a grant of certiorari is warranted. The reason for this omission is evident, as it appears that this Court has *never* exercised its supervisory authority to review a court of appeals' denial of a motion for additional time to seek rehearing, and it should not do so here.

As MKC concedes, the disposition of a motion for additional time to seek rehearing is a "discretionary ruling[]" entrusted to the court of appeals. *Id.* at 8; *see also* FED. R. APP. P. 40(a)(1). So long as the Federal Circuit "ke[pt] within the bounds of judicial discretion," its denial of MKC's motion is "not reviewable" by this Court. *In re Burwell*, 350 U.S. 521, 522 (1956) (refusing to review a court of appeals' use of a particular procedure for reviewing applications for certificates of appealability); *see also Shenker v. Balt. & Ohio R.R. Co.*, 374 U.S. 1, 5 (1963) (deferring to a court of appeals' discretionary denial of a petition for rehearing *en banc* because "to hold otherwise would involve [this Court] unnecessarily in

the internal administration of the Courts of Appeals"); *W. Pac. R.R. Corp. v. W. Pac. R.R. Co.*, 345 U.S. 247, 250 (1953) (deferring to a court of appeals' "free[dom] to devise its own machinery to provide the means whereby a majority may order" rehearing *en banc*).

MKC makes no serious argument that the Federal Circuit deviated from the bounds of its discretion in denying the motion for additional time. *First*, MKC's contention that "discretionary rulings are to be accompanied by written findings," Pet. 8-9, simply ignores both that Rule 40 prescribes no requirement of written findings and that the courts of appeals ordinarily do not and need not issue findings in every case when ruling on motions for additional time to seek rehearing. Indeed, the Federal Circuit's denial of MKC's motion conformed with the common practice in the courts of appeals, which routinely deny, without explanation, myriad motions for additional time to seek rehearing. Accordingly, the Federal Circuit acted wholly *consistent* with, rather than *contrary* to, "the accepted and usual course of judicial proceedings," and, thus, there is no basis for this Court's supervisory intervention. SUP. CT. R. 10(a).

Second, MKC's underdeveloped claim that Rule 40 raises "serious questions as to the equal protection[ ] of the laws," Pet. 10, is unpersuasive and puzzling given that all the parties in this case were subject to the same time limitation in which to seek rehearing. Surely, the Federal Circuit was not obligated to grant additional time to seek rehearing on the ground that Mr. Gambaro, who was not a party to the proceedings

below, had caused an explosion and fire in his apartment building. S.A. 87sa-94sa.

Third, MKC's attempt to bootstrap its assertion of discretionary abuse around the merits of its infringement claim, *see* Pet. 10-11, is unavailing. A court's discretion to grant or deny additional time for a filing is not dependant upon the ultimate merits of that filing. Moreover, the same panel that denied MKC's motion for additional time had already determined that, in fact, MKC's infringement claim was meritless. Pet. App. A6-13.

Finally, MKC fails to explain how the federal policy in favor of settlement allegedly contravened by the Federal Circuit, *see* Pet. 9, bears on cases, such as this one, that have already been adjudicated by a court of appeals. Indeed, Respondents stood to gain very little from any prospective settlement *after* the Federal Circuit upheld summary judgment in their favor on MKC's infringement claim. In fact, it was MKC that expressed interest in exploring settlement, and respondents only sought an extension of time in order to preserve their right to seek rehearing on the validity issue in the event that MKC's motion for additional time were granted. On this score, it is difficult to imagine that the Federal Circuit's denial of MKC's motion for additional time somehow violated the federal policy in favor of settlement, much less that it did so in a manner calling for the exercise of this Court's supervisory authority.

II. THERE IS NO REASON FOR THIS COURT TO REVIEW THE FEDERAL CIRCUIT'S AFFIRMANCE OF THE DISTRICT COURT'S GRANT OF SUMMARY JUDGMENT OF NON-INFRINGEMENT UNDER THE DOCTRINE OF EQUIVALENTS

This Court should deny the petition for a writ of certiorari with respect to the merits of the Federal Circuit's decision on non-infringement for three reasons. *First*, the decision below is narrow and fact bound, and is plainly correct, as the Federal Circuit faithfully adhered to this Court's precedent regarding the doctrine of equivalents in applying the correct standard of proof, and Petitioner proffered insufficient evidence to survive summary judgment. *Second*, there is no conflict or disuniformity in the lower courts as to the governing rule of law that would prescribe this Court's intervention. *Finally*, this case is a poor vehicle for addressing the standard for infringement under the doctrine of equivalents because, as the district court recognized, MKC's equivalents claims require the vitiation of at least one element of the relevant patent claims and would plainly ensnare prior art.

A. The Decision Below Is Narrow, Fact Bound, And Plainly Correct

The decision below presents no recurring or important issue because it was a narrow, fact bound determination that the requirements for application of the doctrine of equivalents were not satisfied based on the specifics of the patent claims involved, the record below and the arguments advanced by Petitioner before the district court.

1. Under the doctrine of equivalents, "a product or process that does not literally infringe upon the express terms of a patent claim may nonetheless be found to infringe if there is 'equivalence' between the elements of the accused product or process and the claimed elements of the patented invention." *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 21 (1997) (quoting *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 609 (1950)). Analysis of a claim of infringement under the doctrine of equivalents is inherently fact and case specific. "'What constitutes equivalency must be determined against the context of the patent, the prior art, and the particular circumstances of the case.'" *Id.* at 24 (quoting *Graver Tank*, 339 U.S. at 609). Accordingly, "[a]n analysis of the role played by each element in the context of the specific patent claim" is necessary to "inform the inquiry as to whether a substitute element matches the function, way, and result of the claimed element, or whether the substitute element plays a role substantially different from the claimed element." *Id.* at 40.

This required analysis will necessarily differ from case to case and involves the fact bound determination whether, in the context of a particular patent claim, an element substituted for an element in the claim performs substantially the same function in substantially the same way, and would lead to substantially the same result, as the claim element. Such a determination is inherently unworthy of this Court's review.

2. This case is particularly unworthy of review because the decision below is plainly correct, as the record below contained insufficient evidence to

support Petitioner's claims under the doctrine of equivalents. As this Court explained in *Celotex Corp. v. Catrett*, 477 U.S. 317, 322 (1986), "the plain language of Rule 56(c) mandates the entry of summary judgment, after adequate time for discovery and upon motion, against a party who fails to make a showing sufficient to establish the existence of an element essential to that party's case, and on which that party will bear the burden of proof at trial." Thus, "a complete failure of proof concerning an essential element of the nonmoving party's case necessarily renders all other facts immaterial. The moving party is 'entitled to a judgment as a matter of law' because the nonmoving party has failed to make a sufficient showing on an essential element of her case with respect to which she has the burden of proof." *Id.* at 323 (citation omitted). Additionally, this Court explained in *Warner-Jenkinson* that "[e]ach element contained in a patent claim is deemed material to defining the scope of the patented invention, and thus the doctrine of equivalents must be applied to individual elements of the claim." 520 U.S. at 29.

In light of these well-established rules, the Federal Circuit explained in *General Electric Co. v. Nintendo Co.*, 179 F.3d 1350, 1359 (Fed. Cir. 1999):

> Under [*Celotex*], GE has the burden of presenting enough evidence so that a reasonable jury could conclude that the alleged Nintendo systems infringe the '659 patent under the doctrine of equivalents. This burden means that GE had to present evidence that every limitation of the '659 patent . . . is met . . . by the alleged Nintendo systems.

Thus, GE's "failure to present evidence" of similarity on one of the elements of the patent "render[ed] summary judgment of non-infringement . . . appropriate." *Id.*

More recently, in *AquaTex Industries, Inc. v. Techniche Solutions*, 479 F.3d 1320, 1328-29 (Fed. Cir. 2007), the Federal Circuit reiterated that an equivalents claimant bears an ultimate burden of establishing infringement "by a preponderance of the evidence," and that this burden subsumes an obligation to provide "particularized evidence" on summary judgment as to the similarity of each substituted claim element. Accordingly, because the claimant in that case failed to offer "particularized testimony" of an "insubstantiality of difference" between the elements of relevant claims and the elements of the accused device, it could not discharge its preponderance burden and, therefore, summary judgment in favor of the defendant was proper. *Id.*

In this case, the court below faithfully followed this Court's guidance in determining that MKC had utterly failed to shoulder its burden to present evidence of insubstantial differences in the accused Nokia telephones as to each claim element not literally present. The court below explained that, "MKC only presented the district court with conclusory statements about equivalents." Pet. App. A11. MKC, for example, offered no evidence "that the accused [Nokia] phones perform substantially the same function in substantially the same way to obtain [substantially] the same result" as the device covered by the '322 patent, and produced no "testimony to specifically show that the keys" of the two devices "work in the same way." *Id.* A12-13.

Indeed, the evidence that MKC did offer in support of its infringement claims comes nowhere close to fulfilling the requirements to survive summary judgment. MKC's only expert witness–the patent attorney who originally prosecuted the '322 patent–made absolutely no reference to the doctrine of equivalents and offered no analysis as to whether the accused devices were substantially similar to the patented technology. S.A. 74sa-82sa; *id.* 42sa-43sa & n.5. In fact, the only testimony MKC identifies in its Petition that even arguably bears on its equivalents theory is the unsubstantiated statement of the inventor that "a concavity formed by the top surfaces of a cluster of keys is the functional equivalent of a concavity in the housing" because "it would be obvious to one reasonably skilled in the art of ergonometric keyboard design, such as myself, that the two are interchangeable." Pet. 15 (internal quotation omitted). But this conclusory statement is plainly insufficient to discharge MKC's summary judgment burden. *See Celotex*, 477 U.S. at 322-24; *Warner-Jenkinson*, 520 U.S. at 40.

3. MKC's contention that the Federal Circuit adopted a heightened summary judgment standard with respect to equivalents claims, Pet. 13, is meritless. Contrary to MKC's argument, the requirement of "particularized evidence" means that an equivalents claimant must offer at summary judgment evidence distinct from that presented in support of literal infringement and that is related to each *particular* element of similarity. Thus, the "particularized evidence" formulation is plainly not a heightened summary judgment standard; it is simply an application of the fundamental rule that summary

judgment is warranted "against a party who fails to make a showing sufficient to establish the existence of an element essential to that party's case." *Celotex*, 477 U.S. at 322. Thus, there was no error, let alone reviewable error, in the Federal Circuit's use of that formulation here. Under any meaningful pleading standard, MKC presented insufficient evidence to survive summary judgment.

B. There Is No Conflict Or Confusion In The Lower Courts As To The Legal Rule Governing Infringement Under The Doctrine Of Equivalents

MKC does not even attempt to show the existence of any split of authority regarding the legal rule applicable to infringement claims under the doctrine of equivalents. Indeed, there is no such split of authority: This Court has held for nearly sixty years that an equivalents claim is "a determination of fact" requiring a showing that the accused device "performs substantially the same function in substantially the same way to obtain the same result." *Graver Tank*, 339 U.S. at 608 (internal quotations omitted); *see also Warner-Jenkinson*, 520 U.S. at 25-29 (reiterating the *Graver Tank* rule); *Malta v. Schulmerich Carillons, Inc.*, 952 F.2d 1320, 1328 (Fed. Cir. 1991) (to prove infringement under the doctrine of equivalents, "a patentee must prove that each prong of the *Graver Tank* equivalency test is met").

Moreover, the Federal Circuit and other lower courts uniformly apply the requirement that an equivalents claimant put forward "particularized evidence" as to "'the insubstantiality of the

differences' between the claimed invention and the accused device, or with respect to the 'function, way, result' test." Pet. App. A11-12 (collecting cases); *see also Lear Siegler, Inc. v. Sealy Mattress Co. of Mich.*, 873 F.2d 1422, 1426 (Fed. Cir. 1989); *Tyco Healthcare Group LP v. Ethicon Endo-Surgery, Inc.*, No. 04-1702, _ F. Supp. 2d _, 2007 WL 2936240, at *13-14 (D. Conn. Oct. 8, 2007); *Sprint Commc'ns Co. v. Vonage Holdings*, 500 F. Supp. 2d 1290, 1342-45 (D. Kan. 2007); *Lucas Aerospace, Ltd. v. Union Indus., L.P.*, 899 F. Supp. 1268, 1280 (D. Del. 1995).

The lower courts have expressed no confusion regarding the scope or application of the "particularized evidence" requirement. Indeed, the lower courts have applied that requirement with remarkable consistency and clarity, particularly at the summary judgment phase. *Compare, e.g.*, *AquaTex Indus.*, 479 F.3d at 1328-29 (upholding a grant of summary judgment where the claimant failed to offer any evidence of an insubstantiality of difference between the devices); *with Tyco Healthcare*, 2007 WL 2936240, at *13-14 (denying summary judgment where the claimant offered expert testimony that the devices performed the same function in a substantially similar way); *Sprint Commc'ns*, 500 F. Supp. 2d at 1342-45 (denying summary judgment where expert testimony showed substantial similarity).

MKC sets forth no conflict or confusion for this Court to resolve.

C. This Case Is A Poor Vehicle For Addressing The Pleading Standards For Infringement Claims Under The Doctrine Of Equivalents

This case is a poor vehicle for addressing the pleading standards for infringement claims under the doctrine of equivalents because the district court's grant of summary judgment was based upon two alternative grounds having nothing to do with pleading requirements. *First*, MKC's equivalents theory is invalid because it would entirely vitiate at least one element of the '322 patent. *Second*, MKC's equivalents theory is invalid because it would ensnare prior art.

1. This Court explained in *Warner-Jenkinson* that "[i]t is important to ensure that the application of the doctrine [of equivalents], even as to an individual element, is not allowed such broad play as to effectively eliminate that element in its entirety." 520 U.S. at 29. Thus, the Federal Circuit has steadfastly refused to apply the doctrine where doing so would "vitiate an entire claim limitation." *Panduit Corp. v. HellermanTyton Corp.*, 451 F.3d 819, 830 (Fed. Cir. 2006) (internal quotations omitted); *see also Freedman Seating Co. v. Am. Seating Co.*, 420 F.3d 1350, 1361 (Fed. Cir. 2005) ("In the instant case, we think the district court's finding of infringement under the doctrine of equivalents had the effect of entirely vitiating the 'slidably mounted' limitation."), *cert. denied*, 546 U.S. 1150 (2006); *Seachange Int'l, Inc. v. C-COR, Inc.*, 413 F.3d 1361, 1378 (Fed. Cir. 2005) (holding that infringement under patent holder's equivalents theory "would vitiate the requirement that every processor be connected to

every other processor point-to-point, and therefore must fail as a matter of law").

As the district court recognized, MKC's equivalents theory here cannot stand because it would "vitiate" at least one element of the '322 patent. S.A. 35sa, 49sa. The '322 patent requires a "concavity in the housing" and a cluster of keys forming a keyboard "within" that concavity. Pet. App. A49. If the keys themselves were construed as the concavity, the keys could not be *within* the concavity, and the claim element requiring a keyboard "within the concavity" would be entirely vitiated. As the district court held, this prospect of vitiation provided independently sufficient grounds for summary judgment in Respondents' favor on MKC's equivalents claim. S.A. 35sa, 49sa.

2. In addition, "a patentee should not be able to obtain, under the doctrine of equivalents, coverage which he could not lawfully have obtained from the PTO by literal claims." *Wilson Sporting Goods Co. v. David Geoffrey & Assocs.*, 904 F.2d 677, 684 (Fed. Cir. 1990), *overruled in part on other grounds by Cardinal Chem. Co. v. Morton Int'l*, 508 U.S. 83 (1993). Thus, "[b]ased on the fundamental principle that no one deserves an exclusive right to technology already in the public domain, [the Federal Circuit] has consistently limited the doctrine of equivalents to prevent its application to ensnare prior art." *Marquip, Inc. v. Fosber Am., Inc.*, 198 F.3d 1363, 1367 (Fed. Cir. 1999).

Under this rule, the district court held in the alternative that because a prior art Einbinder patent teaches a concave keypad surface, MKC could not

rely on the doctrine of the equivalents to establish infringement of the '322 claims with respect to the concave keypad surface of some of the Nokia phones. "[P]laintiff is estopped from relying on the doctrine of equivalents to cover the sloped surface of the keypad, because to do so would ensnare the prior art Einbinder patent." S.A. 49sa. This independent basis for summary judgment further renders this case unsuitable for certiorari.

In short, this case presents an inappropriate vehicle for addressing the pleading standards of a claim under the doctrine of equivalents. MKC presented plainly insufficient evidence to survive summary judgment under any meaningful pleading standard, and there were two alternative bases for the district court's summary judgment ruling.

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted,

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November 29, 2007

MOTIONLESS KEYBOARD COMPANY, Plaintiff,

v.

MICROSOFT CORPORATION, Nokia Inc., and Saitek Industries, Ltd., Defendants.

United States District Court for the District of Oregon

No. 04-180-AA

May 6, 2005

OPINION AND ORDER

AIKEN, J.

Plaintiff filed suit for patent infringement under 35 U.S.C. § 283, alleging infringement of plaintiff's keyboard patents, United States Patent Nos. 5,178,477 (the '477 patent) and 5,332,322 (the '322 patent), by defendants' game controllers and mobile telephones. Plaintiff seeks permanent injunctive relief, damages, and attorney's fees.

On February 18, 2005, the court heard oral argument on the parties' cross-motions for summary judgment regarding infringement and defendants' motions for summary judgment of invalidity and anticipation. The court denies plaintiff's motions for partial summary judgment and grants each defendant's motion for summary judgment of non-infringement. The court also grants defendants' joint motion for summary judgment of invalidity of the '477 and '322 patents. Defendants' remaining motions

for summary judgment of invalidity and anticipation are denied.

FACTUAL BACKGROUND

Plaintiff is an Oregon corporation and the owner of the '477 and '322 patents through an assignment of rights from inventor and patentee Thomas L. Gambaro.

The '477 patent was filed on June 6, 1991 and issued on January 12, 1993. The '447 patent is entitled "Ergonomic Keyboard Input Device" and refers to a keyboard input device for transmitting information to an electronic system such as a computer. "More particularly, it relates to such a device wherein the keyboard is specially ergonomically designed with reference to the architecture of the human hand in such a fashion that, at least with respect to the fingers on the hand, only slight gestural finger motion is required for effective, multiple, differentiated key actuation." '477 Patent, Col. 1:8-14 (attached as Exhibit 1 to Amended Complaint, Exhibit 2 to the Declaration of Jared Goff (Goff Decl.), and Exhibit 2 to the Declaration of Keith B. Davis (Davis Decl.)).

The '322 patent was filed on January 11, 1993, issued on July 26, 1994, and is a continuation-in-part of the '477 patent. The '322 patent is entitled "Ergonomic Thumb-Actuable Keyboard for a Hand-Grippable Device" and, like the '477 patent, refers to a keyboard input device for transmitting information to an electronic system such as a telephone switching system or a computer. "More particularly, it relates to such a device wherein the keyboard is specially ergonomically designed with reference to the architecture of the human hand in such a fashion

that, at least with respect to the thumb on the hand, only slight gestural finger motion is required for effective, multiple, differentiated key actuation." '322 Patent, Col. 1:18-24 (attached as Exhibit 2 to Amended Complaint).

Defendant Microsoft Corporation (Microsoft) is a Washington corporation doing business in the state of Oregon. Microsoft develops and sells various computer and gaming-related products. Plaintiff alleges that three of Microsoft's game controllers infringe upon the '477 and the '322 patents. Specifically, plaintiff alleges that the "Strategic Commander" game controller infringes Claims 1, 2, 5, 6, and 8 of the '477 patent, and that the "Sidewinder Precision 2" and "Sidewinder Force Feedback 2" gaming joysticks (Sidewinder joysticks) infringe Claims 1, 2, 3, and 5 of the '322 patent.

Defendant Saitek Industries, Ltd. (Saitek) is a Delaware corporation doing business in the state of Oregon. Saitek develops and sells various gaming products, including joystick game controllers. As with the Microsoft Sidewinder joysticks, plaintiff alleges that several models of Saitek joysticks infringe Claims 1, 2, 3, and 5 of the '322 patent.

Defendant Nokia Inc. (Nokia) is a Delaware corporation doing business in the state of Oregon. Nokia develops and sells various models of mobile telephones. Plaintiff alleges that four models of Nokia's phones, the 3560, 3595, 6200, and 6820, infringe Claims 1, 2, 3, and 4 of the '322 patent.

SUMMARY JUDGMENT STANDARD

Summary judgment is appropriate "if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if

any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law." Fed. R. Civ. Pro. 56(c). Summary judgment is not proper if material factual issues exist for trial. *Warren v. City of Carlsbad*, 58 F.3d 439, 441 (9th Cir. 1995). The moving party has the burden of establishing the absence of a genuine issue of material fact. *Celotex Corp. v. Catrett*, 477 U.S. 317, 323, (1986). If the moving party shows the absence of a genuine issue of material fact, the nonmoving party must go beyond the pleadings and identify facts which show a genuine issue for trial. *Id.* at 324.

Special rules of construction apply to evaluating summary judgment motions: (1) all reasonable doubts as to the existence of genuine issues of material fact should be resolved against the moving party; and (2) all inferences to be drawn from the underlying facts must be viewed in the light most favorable to the nonmoving party. *T.W. Electrical Service, Inc. v. Pacific Electrical Contractor Assoc.*, 809 F.2d 626, 630 (9th Cir. 1987). When different ultimate inferences can be reached, summary judgment is not appropriate. *Sankovich v. Life Ins. Co. of N. America*, 638 F.2d 136, 140 (9th Cir. 1981).

DISCUSSION

A patent confers upon its owner the right to exclude others from making, using, offering for sale, selling, or importing the patented invention throughout the United States during the term of the patent. 35 U.S.C. § 154(a)(1). In order for an invention to be patentable, it must be of patentable subject matter, useful, new, and nonobvious. *Id.* §§ 101, 103; *Bonito Boats, Inc. v. Thunder Craft Boats,*

Inc., 489 U.S. 141, 150-51 (1989).

An infringement analysis involves two steps. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976 (Fed. Cir. 1995) (*en banc*). First, the court construes the claim language and determines the scope of the patent claims asserted to be infringed without regard for the allegedly infringing product. *Id.*; *Young Dental Mfg. Co. v. 03 Special Prods.*, Inc., 112 F.3d 1137, 1141 (Fed. Cir. 1997). Second, the finder of fact determines whether the properly construed claims read on – or cover – the accused infringing product or process, either literally or under the doctrine of equivalents. *Markman*, 52 F.3d at 976.

The court may use both "intrinsic" and "extrinsic" evidence to help construe a claim. *Vitronics Corp. v. Conceptronic*, Inc., 90 F.3d 1576, 1582 (Fed. Cir. 1996). Intrinsic evidence includes the language of the patent claim, the patent specification, and the prosecution history. *Id.*; *Markman*, 52 F.3d at 979.

Claim construction begins with the ordinary meaning of the claim language. *Vitronics*, 90 F.3d 1584; *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002). "Absent an express intent to impart a novel meaning, claim terms take on their ordinary meaning." *Elekta Instrument S.A. v. O.U.R. Sci. Int'l, Inc.*, 214 F.3d 1302, 1307 (Fed. Cir. 2000). Judges may rely on dictionary definitions if not inconsistent with definitions found in or ascertained through reading of the patent documents. *Vitronics*, 90 F.3d at 1584, n.6. A patentee, however, may choose to use a term in a manner other than its ordinary meaning, as long as the special definition of the term is clearly stated in the patent specification

or file history. *Hoechst Celanese Corp. v. BP Chems. Ltd.*, 78 F.3d 1575, 1578 (Fed. Cir. 1996).

The patent specification is a written description of the claimed invention and explains how to make or use it. 35 U.S.C. § 112, ¶ 1. The specification is particularly helpful in claim construction because it describes the claims in context. *C.R. Bard, Inc. v. U.S. Surgical Corp.*, 388 F.3d 858, 864 (Fed. Cir. 2004); *Microsoft Corp. v. Multi-Tech Sys., Inc.*, 357 F.3d 1340, 1347-48 (Fed. Cir.), *cert. denied*, 125 S. Ct. 61 (2004). Often the specification is dispositive in the claim construction analysis, as it "is the single best guide to the meaning of the disputed claim term." *Vitronics*, 90 F.3d at 1582.

The prosecution history of a patent is the record of exchange between the Patent and Trademark Office (PTO) and the patent applicant. Thus, it provides an accurate reflection of the patent's pre-issuance history. *Markman*, 52 F.3d at 980. It, like the specification and drawings, may be used to determine the scope of the claims. "The prosecution history gives insight into what the applicant originally claimed as the invention, and often what the applicant gave up in order to meet the [Patent] Examiner's objections." *Lemelson v. General Mills, Inc.*, 968 F.2d 1202, 1206 (Fed. Cir. 1992); *see also Middleton, Inc. v. Minn. Mining & Mfg. Co.*, 311 F.3d 1384, 1388 (Fed. Cir. 2002). Consequently, prosecution history is often relied upon for estoppel purposes. "Arguments and amendments made to secure allowance of a claim, especially those distinguishing prior art, presumably give rise to prosecution history estoppel." *Wang Lab., Inc. v. Mitsubishi Elecs.*, 103 F.3d 1571, 1578 (Fed. Cir.

1997) (citation omitted).

If, after consideration of intrinsic evidence, genuine ambiguity remains as to the meaning of the claim language, the court may consult extrinsic evidence to aid in its construction of the claim language. *Vitronics*, 90 F.3d at 1583. Extrinsic evidence consists of all evidence external to the patent and file history, including inventor and expert testimony. *Id.* at 1584.

Once the claims are construed, the trier of fact compares the patent claims to the accused device. *International Rectifier Corp. v. Ixys Corp.*, 361 F.3d 1363, 1369 (Fed. Cir. 2004). Infringement may be found only if "every element of the invention as claimed is present in the accused device." *Acco Brands Inc. v. Micro Sec. Devices, Inc.*, 346 F.3d 1075, 1080 (Fed. Cir. 2003). There is no infringement, as a matter of law, if even a single claim limitation is missing from the accused device.

If an accused device does not literally infringe a patent, a patent holder may still show infringement under the doctrine of equivalents. *Id.* "The doctrine of equivalents expands the reach of claims *beyond* their literal language." *Tate Access Floors, Inc. v. Interface Architectural Resources, Inc.*, 279 F.3d 1357, 1367 (Fed. Cir. 2002). Thus, "[i]nfringement under the doctrine of equivalents occurs when a claimed limitation and the accused product perform substantially the same function in substantially the same way to obtain substantially the same result." *Business Objects, S .A. v. Microstrategy, Inc.*, 393 F.3d 1366, 1374 (Fed. Cir. 2005). Elements of equivalency must be presented "in the form of particularized testimony and linking argument."

Lear Siegler, Inc. v. Sealy Mattress Co., 873 F.2d 1422, 1426 (Fed. Cir. 1989).

I. The '477 Patent

The '477 patent discloses a keyboard designed in a manner to enable "slight gestural motion of different portions of a user's fingers to effect appropriate key actuation." '477 Patent, Col. 2:27-29. Specifically, the keyboard "is organized with an array of actuation keys that are disposed generally to complement the flayed underside architecture of a user's hand." '477 Patent, Preamble. Plaintiff alleges infringement of Claims 1, 2, 5, 6, and 8.

Claim 1 of the '477 patent describes:

> An ergonomic keyboard input device for the transmission of information by a human operator to an electronic system coupled with said device, comprising:
>
> a keyboard organized with an array of transmission-actuation keys disposed generally to compliment the flayed underside-architecture of a users hand, said array including
>
> for each finger, a finger-associable cluster of input keys, each key in which is arranged facially to confront, in close proximity and in parallel planar relationship, one of various different, underside, finger-expanse portions of an associated, adjacent finger, thus to enable actuation of a selected one or more of said keys in said cluster via only slight, gestural, relatively closing motion of the confronting corresponding finger-expanse portion, wherein each finger-associable

> cluster is elongate, and said keys therewithin are distributed along the length of the cluster with respective key-actuation axes that intersect normal to different angularly disposed planes, one plane for each key, which planes intersect one another along the length of the cluster in a mixed pattern of obtuse and reflex angles and
>
> for the thumb, a thumb-associable cluster of input keys disposed generally over three mutually intersecting surfaces to enable key actuation via mixed lateral and slight endo, translation of an associated adjacent thumb within, generally, a cone of motion whose apex resides adjacent the base of the thumb.

'477 Patent, Col. 7:45-68, 8:1-6.

Claim 2 describes the device of Claim 1, "wherein said clusters extend generally radially from a region of confluence, and said device further comprises a convex, mound-like palm rest structure located adjacent said region." *Id.* Col 8:7-10.

Claim 5 describes the device of claim 1, with the added limitation of a base "wherein at least some of said clusters are mounted on said base for selective, relative positional adjustment." *Id.* Col. 8:29-32. Claims 2 and 5 are thus dependent claims which rely on and incorporate independent Claim 1.

Claim 6 describes the device of Claim 1, except that it does not require the planes of the finger clusters to intersect one another "in a mixed pattern of obtuse and reflex angles" and adds to the cluster feature "a base, wherein at least some of said clusters are mounted on said base for selective relative positional adjustment," as disclosed in Claim 5. *Id.*

Col. 8:33-58.

Claim 8 describes the device of Claim 6, "wherein said clusters extend generally radially from a region of confluence, and said device further comprises, a convex, mound-like palm-rest structure located adjacent to said region." *Id.* Col. 8:62-65. Thus, Claim 8 is a dependent claim which relies on and incorporates independent Claim 6.

A. Claim Construction

1. A Thumb-Associable Cluster of Input Keys Disposed Generally Over Three Mutually Intersecting Surfaces

Microsoft argues that this phrase should be construed to mean that the thumb keys must be disposed over three distinct surfaces, with each surface sharing an intersection with the other two surfaces, and that "the keys of the thumb cluster cannot be in a uni-planar array," i.e., on one planar surface. Microsoft's Memorandum in Support of Non-Infringement of '477 Patent, p. 11. Plaintiff does not contest Microsoft's proposed construction or offer an alternative construction for this phrase.

I agree that the claim language does not refer to a device with the thumb keys located on one generally planar surface; rather, the three surfaces must "mutually intersect." "Mutual" means "shared in common." *See* Goff Decl., Ex 8 (Webster's Ninth New Collegiate Dictionary, p. 783). Further, the patent specification describes the surfaces of the clusters as forming a "keyboard sub-amphitheater" as depicted in Figure 1; this corner formation is distinct from a "uni-planar" surface. *See* '477 Patent, Col. 4:19-23 and Figures 1, 2, 6.

Notably, during prosecution of the '447 patent, the PTO rejected certain claims of the '477 patent as indefinite. Goff Decl., Ex. 3, pp. 2-3.[1] Specifically, the PTO found that the term "three mutually intersecting surfaces" was indefinite, because it was "recited in an inferential manner, there being no positive recitation of three surfaces and the manner in which they intersect." *Id.* at Ex. 3, p. 2. In response, Gambaro emphasized "that claims are read in light of the specification, including any drawings" and argued that "it is abundantly clear what is meant by three mutually intersecting surfaces by brief reference to Fig. 1 and the description of surfaces 34a, 34b, 34c of thumb key sub-amphitheater 34." *Id.* at Ex. 4, p. 9. As noted above, the patent specification and drawings describe and depict a corner formation housing the thumb key clusters.

Plaintiff contends that prosecution estoppel applies only when the applicant offers an amendment to the patent claims, but not when an applicant provides an explanation or clarification to the PTO. Plaintiff is incorrect. "Just as prosecution history estoppel may act to estop an equivalence argument under the doctrine of equivalents, positions taken before the PTO may bar an inconsistent position on claim construction under § 112, ¶ 6." *Alpex Computer Corp. v. Nintendo Corp. Ltd.*, 102 F.3d 1214, 1221 (Fed. Cir. 1996); *see also Elkay Mfg. Co. v. Ebco Mfg. Co.*, 192 F.3d 973, 979 (Fed. Cir. 1999) ("Arguments

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[1] Additional claims were rejected as unpatentable in light of prior art. Goff Decl., Ex. 3, pp. 4-5.

made during the prosecution of a patent application are given the same weight as a claim amendment . . . . [It] is irrelevant whether [the patentee] relinquished [a] potential claim construction in an amendment to the claim or in an argument to overcome or distinguish a reference"). Therefore I find that Gambaro's representations to the PTO narrow the scope of the claim language.

Finally, the PTO also found that the '477 claims were not patentable over the prior art Malt keyboard, United States Patent No. 4,244,659. In response, Gambaro distinguished the Malt keyboard as having thumb keys placed in a "uni-planar array," rather than "disposed over three mutually intersecting surfaces" as recited in Claim 1 of the '477 patent. Goff Decl., Ex. 4, p. 15. "[A] concession made or position taken to establish patentability in view of prior art on which the examiner has relied, is a substantive position on the technology for which a patent is sought, and will generally generate an estoppel." *Pall Corp. v. Micron Separations, Inc.*, 66 F.3d 1211, 1220 (Fed. Cir. 1995).

Accordingly, I construe this claim to mean that the thumb key clusters must be spread over three distinct and separate surfaces, with each surface sharing an intersection with the other two surfaces.

2. For Each Finger, a Finger-Associable Cluster of Input Keys

Microsoft argues that this phrase should be construed to mean that "for each of the four (non-thumb) fingers of the hand, the device includes a separate group of multiple input keys for use by the associated finger." Microsoft's Memorandum in Support of Non-Infringement of '477 patent, p. 14.

Microsoft further maintains that the term "cluster" requires at least two keys for each finger, and the term "each finger" means each finger of each hand, i.e., a two-handed device.

Plaintiff contests Microsoft's construction that the device must be designed for two hands and argues that the claim language does not include such a limitation. I agree. While Microsoft relies on the preferred embodiment depicting a two-handed keyboard, the court "must use the written description for enlightenment and not to read a limitation from the specification." *Playtex Prods., Inc. v. Procter & Gamble Co.*, 400 F.3d 901, 906 (Fed. Cir. 2005). I find that the claim language and the specification neither require nor exclude a one-handed embodiment.

Otherwise, plaintiff does not contest Microsoft's proposed construction, and I find it consistent with the plain language of the claim and the patent specification. *See* Col 1:4-18, Figures 1, 3. Thus, I construe the claim language to mean that for each of the four fingers, the device must include a separate group of multiple input keys that correspond to the associated finger.

3. Each Key Which is Arranged Facially to Confront, in Close Proximity and in Parallel Planar Relationship, One of Various Different, Underside, Finger-Expanse Portions of an Associated, Adjacent Finger

Microsoft argues that this phrase should be construed to mean that "each key of each non-thumb finger cluster must be positioned to face in close proximity and be parallel to the tip or the underside of the adjacent finger of a user." Microsoft's Memorandum in Support of Non-Infringement of '477

patent, p. 15. In other words, Microsoft argues that "[t]he cluster cannot be disposed along a uniform curved convex surface." *Id.*

Microsoft maintains that the ordinary meaning of the term "confront" requires that each key face and be parallel to the "finger expanse portions," *i.e.*, the underside, of the corresponding finger. Goff Decl., Ex. 7 (American Heritage Dictionary of the English Language, 4th Ed., p. 387). Microsoft further contends that the key clusters cannot be arranged along a uniform convex surface, because the underside of each finger must "alternate[ ] between various angles" to correspond with the keys. *See* '477 Patent, Figure 8.

Plaintiff disputes Microsoft's construction and argues that "[d]evices embodying the invention may or may not have a uniformly curved convex surface, but must have the keys oriented to confront, in parallel planar relationships, two or more portions of the underside of the fingers." Plaintiff's Opposition to Defendants' Motions for Summary Judgment, p. 30. Put simply, plaintiff contends that the claim language encompasses keys placed on a uniform, convex surface so long as the keys correspond with the underside of the associated finger.

It is true that plaintiff is entitled to all reasonable constructions of the claim language; however, the construction must be consistent with the claim language and the description of the invention in the specification. Here, the claim language requires that keyboard be designed to correspond with the "underside architecture of the hand." *Id.* Col. 4:26-27. Further, the specification describes the keyboard portion as "a sort of curvilinear keyboard

amphitheater," depicted in the specification drawings. *See* '477 Patent, Col. 3:47-48, Figures 1-4. Notably, the specification drawings shown in Figures 1, 3, 4, 7, and 8 show a concave corner housing with keys placed in varying angles to conform to the underside and tip of the corresponding finger. *See also* '477 Patent, Col. 3:13-18 (Figures 7 and 8 illustrate "the nominal position of a user's finger with respect to this structure" and the "different gesture motions used by a finger").

Additionally, the specification explains that along the length of a key cluster, the planar surfaces supporting the keys "intersect one another" as detailed in Figure 3. '477 Patent, Col. 5:8-12, Figure 3. "[T]he keys mentioned above in cluster 26 may be thought of as having actuation axes, respectively, which intersect normally the respective underlying support planed provided for the keys." *Id.* Col. 5:36-39. Thus, the claim language and specification describes a corner sub-amphitheater housing keys placed in intersecting planes and excludes a uniform, convex surface.

Finally, plaintiff's construction extending to a convex surface is contrary to Gambaro's representations to the PTO. As established by defendants' submissions, Gambaro unambiguously disavowed that a uniform convex curved surface was claimed by the '477 patent. Specifically, Gambaro distinguished several prior art keyboard references containing key clusters that were "uniformly curvilinearly convex in two orthogonal axes" and not "arranged in a cluster to confront 'in close proximity and in parallel planar relationship' an associated finger-expanse portion." Goff Decl., Ex. 4, pp. 13-14.

Gambaro stated: "Nothing could be further from what applicant claims as his invention" and directed the PTO to Figures 7 and 8 for clarification. *Id.* Ex. 4, p. 14.

Plaintiff argues that Gambaro merely explained to the PTO that the Malt keyboard did not include the claimed element of keys arranged to confront the underside of the finger as opposed to the tip, but that Gambaro's clarifications cannot invoke prosecution estoppel. Plaintiff is incorrect. Gambaro did not merely clarify the elements of his invention; he specifically distinguished prior art in order to secure issuance of the patent. *Southwall Techs., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1583 (Fed. Cir. 1995) ("Clear assertions made during prosecution in support of patentability, whether or not actually required to secure allowance of the claim, may also create an estoppel."). For example, Gambaro explained that the importance of the cluster limitation was to correspond with the underside of the finger, *"an important distinction over prior art keyboards,* the structure of which enable only the traditional fingertip keystroking . . . ." Goff Decl., Ex. 4, p. 14 (emphasis added). Prosecution estoppel thus precludes plaintiff from claiming that the claim language encompasses devices with a uniformly convex surface. *See Wang Lab., Inc.*, 103 F.3d at 1578 (arguments distinguishing prior art made during prosecution of patent "presumably give rise to prosecution history estoppel").

Accordingly, I construe the phrase to mean that each key of each finger cluster must be positioned parallel and in close proximity to the tip and the underside of the adjacent finger, and that the

clusters be disposed along a concave surface.

4. Each Finger-Associable Cluster is Elongate, and Said Keys Therewithin are Distributed Along the Length of the Cluster With Respective Key-Actuation Axes That Intersect Normal to Different Angularly Disposed Planes, One Plane for Each Key, Which Planes Intersect One Another Along the Length of the Cluster in a Mixed Pattern of Obtuse and Reflex Angles

Microsoft argues that this phrase should be construed to mean that for each cluster of finger keys, "the angles between the adjacent keys [must] alternate between an obtuse angle (between 90 and 180 degrees) and a reflex angle (greater than 180 degrees)," and that for each finger there must be at least two alternating angles between three keys. Microsoft's Memorandum in Support of Non-Infringement of '477 patent, p. 18. Plaintiff offers no alternative construction for this phrase and does not contest Microsoft's proposed construction. The ordinary meaning of the claim terms require that the planes of each key intersect one another in a "mixed" pattern of obtuse and reflex angles. This pattern would include one reflex angle and one obtuse angle, with two angles between three keys. Microsoft's construction is further supported by the specification drawings. *See* '477 Patent, Figures 3-8. Therefore, I adopt Microsoft's construction as set forth above.

5. At Least Some of Said Clusters Are Mounted on Said Base for Selective, Relative Positional Adjustment

Microsoft argues that this phrase should be construed to mean that the keys or the keys clusters

must be mounted in a way that allows the keys or the clusters "to be moved by the user to different locations relative to each other to fit different hand sizes." Microsoft's Memorandum in Support of Non-Infringement of '477 patent, p. 21. Plaintiff does not contest Microsoft's construction or offer an alternative one. Rather, plaintiff argues that the plain language of the claim does not require that the keys or key clusters be adjusted to accommodate different hand sizes. I disagree.

The claim language discloses key clusters "mounted . . . for selective, positional adjustment"; thus, the plain meaning of the terms require that the keys be attached in a manner that allows them to be adjustable. Further, the specification gives context to this claim language:

> The kind of positional adjustment which has just been described may, in a certain way, be viewed as a gross adjustment-namely, one wherein entire clusters of keys are shifted as a unit to accommodate different hand sizes. . . . For example, one can imagine a modification in which . . . the mounting structure could actually be a divided structure which permits relative positional adjustment between . . . the two keys closest to the tip of the associated finger as a unit with respect to the other two keys in the row.

'477 Patent, Col. 6:53-64.

Whatever this means, it is clear that the keys or key clusters must be adjustable in relation to one another. Microsoft also relies on the patent specification, which describes the purpose of allowing adjustment of the keys or the key clusters to fit

different hand sizes:

> Recognizing that a one-size-fits-all approach may not be entirely appropriate to deal with users' hands that are significant larger or smaller than, say, hands fitting within the 'median' of hand sizes, the structure of the invention proposed herein permits positional adjustment of arrays and clusters of keys to accommodate a size-differential concern.

'477 Patent, Col 2:46-53; *see also* Col. 6:42-43, 52-63.

Thus, I find that Microsoft's construction reflects the plain meaning of the language and the description of the claimed element in the specification. Accordingly, I construe this claim element to mean that keys or key clusters must be mounted on a base so as to allow for selective adjustment of the keys or key clusters to accommodate different hand sizes.

B. Infringement

Microsoft's Strategic Commander is a convex-shaped hand rest mounted on a base. The hand rest includes three pairs of "number" keys and one "rocker" key for the fingers placed on a sloped top surface, with three thumb keys located on a curved side surface. *See* Goff Decl., Ex. 11; Physical Ex. C. Microsoft argues that five required features of the '477 Patent are not found in the Strategic Commander, and that plaintiff therefore cannot establish either literal infringement or infringement under the doctrine of equivalents.

1. Three Mutually Intersecting Surfaces

First, Microsoft argues that the Strategic Commander does not infringe any claim of the '477

patent, because its thumb keys are not found on "three mutually intersecting" surfaces as described in Claims 1 and 6, on which Claims 2, 5, and 8 depend. Plaintiff concedes that the Strategic Commander does not literally infringe. Rather, plaintiff relies on the doctrine of equivalents and argues that the thumb keys of the Strategic Commander are the functional equivalent of the thumb keys described in the '477 patent, because "the curvature of [the side] surface" is such that each key is in a different plane, forming the functional equivalent of "three mutually intersected surfaces." Plaintiff's Memorandum in Opposition to Defendants' Motions for Summary Judgment, p. 29; Transcript of Proceedings, p. 62 (February 18, 2005).

Even if the court agreed that the side surface of the Strategic Commander is curved so that each thumb button is an a different "plane," the requirement of "mutually intersecting surfaces" is not met, because plaintiff fails to establish that the planes for the thumb keys share a common, i.e., mutual, intersection. *See* Goff Decl., Exs. 11, 12. Plaintiff bears the burden of presenting evidence to show that the Strategic Commander thumb keys perform substantially the same function in substantially the same way to achieve substantially the same result as keys disposed over three mutually intersecting surfaces. *V-Formation, Inc. v. Benneton Group SpA*, 401 F.3d 1307, 1313 (Fed. Cir. 2005). Plaintiff presents no evidence to meet this burden.

Furthermore, prosecution estoppel bars application of the doctrine of equivalents. As discussed with respect to claim construction, Gambaro distinguished prior art keyboard references with thumb keys "in a

uni-planar array" rather than dispersed over "three mutually intersecting surfaces." *See* Goff Decl., Ex. 4, pp. 15-16; *Eagle Comtronics, Inc. v. Arrow Comm. Labs., Inc.*, 305 F.3d 1303, 1316 (Fed. Cir. 2002) (explaining that prosecution history estoppel bars a patentee from asserting as an equivalent subject matter surrendered by argument during prosecution of the patent application). Gambaro also relied on the claim requirement of a "mixed pattern of angles" in distinguishing the prior art with an "uni-planar array." Goff Decl., Ex. 4, p. 14; Ex. 6, p. 9.

Finally, Gambaro directed the PTO to the specification drawings in response to indefiniteness and obviousness objections. *Irdeto Access, Inc. v. Echostar Satellite Corp.*, 383 F.3d 1295, 1302-03 (Fed. Cir. 2004) (relying on specification in responding to indefiniteness challenge limits the claim to the content relied upon). Gambaro explained that the claims were to be read in context of the specification and drawings and clarified that "mutually intersecting surfaces" were depicted in figures showing a "thumb key sub-amphitheater." Goff Decl., Ex. 4, p. 9. Because Gambaro "unequivocally directed the patent examiner, as well as the public, to the specification as the complete source of meaning for the disputed terms," plaintiff is bound by those representations. *Irdeto Access, Inc.*, 383 F.3d at 1302-03.

Plaintiff admits that Gambaro's representations to the PTO during the '477 patent prosecution "might well forbid plaintiff from charging infringement based upon devices whose surfaces were quite dissimilar" from the '477 patent; nevertheless, plaintiff argues that the surfaces of the Strategic

Commander are "similar enough." Plaintiff's Reply Memorandum in Support of Supplemental Motion for Summary Judgment, p. 14. The doctrine of equivalents, however, is not met by mere or adequate similarly; the claimed limitation and the accused product must "perform substantially the same function in substantially the same way to obtain substantially the same result." *V-Formation, Inc.*, 401 F.3d at 1313. Further, "[t]he determination of equivalence should be applied as an objective inquiry on an element-by-element basis." *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 40 (1997). Thus, a conclusory assertion of equivalence is insufficient to establish a genuine issue of material fact. *Hewlett Packard Co. v. Mustek Systems*, 340 F.3d 1314, 1322-23 (Fed. Cir. 2003).

Not only does plaintiff fail to establish substantial similarities between the patented and accused device, plaintiff fails to offer a compelling argument why prosecution estoppel does not bar its reliance on doctrine of the equivalents. "[T]he reason for the limitation is to prevent the patentee from obtaining under the doctrine of equivalents coverage it could not have obtained from the [PTO] by literal claims." *Marquip, Inc. v. Fosber Am., Inc.*, 198 F.3d 1363, 1367 (Fed. Cir. 1999). Therefore, plaintiff cannot now expand the scope of this claim language and argue that the curved side surface of the Strategic Commander is the functional equivalent of "three mutually intersecting" surfaces.

2. Multiple Keys for Each Finger

Second, Microsoft argues that the Strategic Commander lacks multiple keys for each finger as recited in Claim 1. Although the Strategic

Commander includes a pair of keys for three fingers, it has only one rocker switch for the remaining finger. Plaintiff concedes that there is no literal infringement of this element. Instead, plaintiff argues that the Strategic Commander has the functional equivalent of multiple keys for each finger, because the rocker key performs the function of two keys.

Microsoft responds that application of the doctrine of equivalents would "vitiate" the requirement of "clusters" as multiple keys and therefore violate the principle known as the "all-elements rule." *Asyst Tech., Inc. v. Emtrak, Inc.*, 402 F.3d 1188, 1195 (Fed. Cir. 2005). "It is important to ensure that the application of the doctrine, even as to an individual element, is not allowed such broad play as to effectively eliminate that element in its entirety." *Warner-Jenkinson Co.*, 520 U.S. at 29. Based on the record before me, I cannot find as a matter of law that the claimed element of "cluster" would be eliminated by application of the doctrine of equivalents. The rocker switch is hourglass shaped, with each portion of the key potentially performing a different function.

Nonetheless, plaintiff fails to meet its burden of establishing "insubstantial differences" between the claimed cluster for each finger and the rocker switch. *See Texas Instruments Inc. v. Cypress Semiconductor Corp.*, 90 F.3d 1558, 1566 (Fed. Cir. 1996) ("objective evidence rather than unexplained subjective conclusions" is relevant to determine whether the differences between the accused product or process and the claimed invention are insubstantial). Here, plaintiff presents no evidence of

equivalence other than demonstrating the accused joystick for the court. Therefore, plaintiff fails to establish infringement of this claim requirement under the doctrine of equivalents.

3. Mixed Pattern of Angles Corresponding to the Underside of the Associated Finger

Third, Microsoft argues that there is no infringement of any claim, because the Strategic Commander displays its finger cluster keys on a uniformly convex surface rather than parallel and in close proximity to the tip and the underside of the adjacent finger. Plaintiff argues that literal infringement is established because the claim language encompasses a convex surface. However, the court's construction of the claim excludes devices with key clusters disposed over a convex surface, based on the description contained in the specification and depicted in the drawings. Therefore, plaintiff cannot rely on literal infringement.

Likewise, plaintiff cannot establish infringement of this element under the doctrine of equivalents, because Gambaro distinguished prior art references and unambiguously disavowed that a uniform convex surface fell within the claim limitations. Goff Decl., Ex. 4, pp. 13-15. Thus, plaintiff cannot read into its claims what Gambaro previously distinguished to obtain the patent. *Marquip, Inc.*, 198 F.3d at 1367.

4. The Planes of Each Key Intersecting One Another in a Mixed Pattern of Obtuse and Reflex Angles

Fourth, Microsoft argues that there can be no infringement of Claims 1, 2, and 5, because none of the finger clusters on the Strategic Commander contain three keys dispersed in a mixed pattern of

obtuse and reflex angles. Plaintiff concedes that the Strategic Commander has only two keys per finger cluster, and that the rocker key is not a cluster. Nevertheless, plaintiff argues that "[t]he limitation is, however, present when one considers the shape of the two keys, which are associated with four planes of actuation." Plaintiff's Memorandum in Opposition to Defendants' Motions for Summary Judgment, p. 30. If plaintiff intends to argue literal infringement, plaintiff's argument fails in light of the court's construction of the claim as meaning three keys in each cluster. Moreover, the planes of the finger keys in the Strategic Commander do not intersect one another in a mixed pattern of angles. I thus view plaintiff's argument as relying on the doctrine of equivalents.

However, plaintiff fails to present evidence that substantial similarities exist between the claimed key cluster and the keys of the Strategic Commander. Moreover, application of the doctrine of equivalents to cover the Strategic Commander would vitiate these elements of the claim. Each key "cluster" of the Strategic Commander has no more than two keys and none of the planes underlying the keys intersect each other or are arranged in a mixed pattern of angles. *Warner-Jenkinson Co.*, 520 U.S. at 29. Finally, prosecution estoppel precludes reliance on the doctrine of equivalents, because Gambaro amended the '477 patent claims to include key clusters placed so that the planes of each key intersect each other in a mixed pattern of angles, and Gambaro relied on this amendment in distinguishing prior art. Goff Decl., Ex. 6, pp. 1-2, 9. *Eagle Comtronics*, 305 F.3d at 1315-16. Therefore, plaintiff cannot rely on the doctrine of the equivalents to establish infringement

of this claim element.

5. Adjustable Finger Keys

Fifth, Microsoft argues that there is no infringement of Claims 5, 6, and 8, because the Strategic Commander does not have adjustable keys or key clusters to meet the "selective, positional adjustment" limitation of the claim. Plaintiff asserts literal infringement and does not rely on the doctrine of equivalents for this claim element. *See* Plaintiff's Memorandum in Opposition to Defendants' Motions for Summary Judgment, p. 30.

The claim language requires a base on which key clusters "are mounted for selective positional adjustment"; thus, the keys or the key clusters must be adjustable to fit different hand sizes. The Strategic Commander does not literally infringe this claim element, because the keys cannot be adjusted to accommodate different hand sizes. Rather, the keys are mounted in a fixed position on the hand rest, which moves slightly over the base.

Even if argued by plaintiff, the doctrine of equivalents is equally unavailing because it would vitiate the requirement of adjustable keys or key clusters; this element is lacking completely in the Strategic Commander. Moreover, plaintiff presents no evidence that the differences between the claim element and the Strategic Commander are insubstantial, or that they perform substantially the same function, in substantially the same manner, with substantially the same result. *See V-Formation, Inc.*, 401 F.3d at 1313. Plaintiff suggests that equivalence is established, because the base of the Strategic Commander is movable. However, plaintiff cannot rely on conclusory arguments and must

present objective evidence of equivalence.

In sum, I find that plaintiff fails to present evidence or raise a genuine issue of fact that Microsoft's Strategic Commander infringes Claims 1, 2, 5, 6 or 8 of the '477 patent.[2]

II. The '322 Patent

The '322 patent is directed to a keyboard input device that is ergonomically designed for hand-held use, with a grippable portion held by the fingers and a key arrangement within a concavity for selective actuation of individual keys by the thumb. *See* '322 Patent, Figures 1-3.

Plaintiff alleges that the Microsoft Sidewinder and Saitek joysticks infringe Claims 1, 2, 3, and 5 of the '322 patent, and that four models of Nokia mobile phones infringe Claims 1, 2, 3 and 4 of the '322 patent.

Claim 1 describes:

> A handheld device for entering information into an electronic system via a keyboard, the device comprising:

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[2] Microsoft also notes that in response to Nokia's argument regarding invalidity, plaintiff construed the term "cluster" to mean "a two-or-three dimensional 'bunch' of objects" rather than a single row of keys. Plaintiff's Memorandum in Opposition to Defendants' Motions for Summary Judgment, p. 9. Given that the '322 patent is a continuation-in-part of the '477 patent, the term "cluster" would have the same meaning. If cluster is so construed, the Strategic Commander does not contain a "cluster" of keys, because its keys are displayed in a single row. Although I need not decide this issue, Microsoft's argument, if accepted, provides an additional basis for non-infringement.

> a housing having a grippable portion which permits the device to be held in one hand with the thumb free to move at least temporarily to a predetermined key-actuation position while the device is held,
>
> a concavity in said housing at said key-actuation position, and
>
> a thumb-associable cluster of keys forming a keyboard within said concavity, each of the plurality of keys in said cluster being selectively actuable via mixed lateral and slight endo, translation of a thumb within said concavity, whereby information is entered into an electronic system.

'322 Patent, Col. 8:16-31.

Claim 2 describes: "A device as in claim 1 in which said keys are located in said concavity within a cone of motion of a user's thumb, when the thumb is positioned is said concavity, whose apex resides adjacent to the base of the thumb." *Id.* Col 8:32-36.

Claim 3 describes: "A device as in claim 1 wherein said cluster of keys includes individual keys oriented in planes which are angularly offset from one another to permit selective actuation by said mixed lateral, and slight endo, translation of a thumb positioned in said concavity." *Id.* Col. 8:37-41.

Claim 4 describes:

> A device as in claim 1 in which said concavity in said housing includes wall surfaces for supporting individual keys in said cluster in orientations which are angularly offset from one another, including a distal wall which angles downwardly into

> said concavity and supports a plurality of distal keys arrayed generally radially about the tip of a thumb when positioned in said concavity, a proximal wall which angles downwardly into said concavity and supports a plurality of proximal keys arranged generally radially about the first phalanx of a thumb when positioned in said concavity, and a plurality of medial wall surfaces supporting a plurality of medial keys in orientations which partially surround the interphalangeal joint of a thumb when positioned in said concavity.

Id. Col. 8:42-56.

Finally, Claim 5 describes:

> A device as in claim 1, in which said grippable portion is a handle which can be gripped between the fingers and thenar eminence of a user's hand, whereby when the device is gripped thus, the user's thumb is selectively movable into said concavity without the user losing a grip on the device.

'322 Patent, Col 8:57-62. Claims 2, 3, 4 and 5 are thus dependent claims which rely upon and incorporate by reference independent Claim 1.

A. Claim Construction

1. A Hand-Held Device . . . Comprising a Housing Having a Grippable Portion Which Permits the Device To Be Held in One Hand With the Thumb Free

Microsoft argues that this phrase should be construed to mean that the "device must be designed to be used while it is supported by the one hand that

is doing the gripping and that has the thumb which actuates the keys during normal operation." Microsoft's Memorandum in Support of Motion of Non-Infringement, p. 15.[3] Saitek proposes a similar construction: "[A] device that is designed to operate and function properly when held and carried in one hand and not simply a device on which a hand can be placed." Saitek's Memorandum in Support of Motion for Non-Infringement, p. 6. Nokia agrees that the claim language should be construed to mean a device that is operable while held in one hand.

Plaintiff argues that "hand-held" means a device with a "grippable" housing, and that the claim language covers a grippable device attached to a larger piece of machinery, i.e., a joystick. In other words, plaintiff argues that the claim language does not require the device to be operable while held in one hand.

Defendants argue that plaintiff's construction essentially would render the meaning of "hand-held" the same as "grippable." I agree. The subject matter claimed is described as "a housing having a *grippable portion* which permits the device *to be held in one hand* . . . ." '322 Patent, Col. 8:19-20. In the context of this language, the terms have different meanings. Unless otherwise specified, claim terms should be construed to give different meanings to different terms. *CAE Screenplates, Inc. v. Heinrich Fiedler GmbH Co.*, 224 F.3d 1308, 1317 (Fed. Cir. 2000) ("In

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[3] Microsoft also proffered a construction for the term "key"; however, I do not find construction of this term necessary to resolve the issues before the court.

the absence of any evidence to the contrary, we must presume that the use of these different terms in the claims connotes different meanings."); *see also Wright Med. Tech. v. Osteonics Corp.*, 122 F.3d 1440, 1444 (Fed. Cir. 1997). Moreover, defendants' construction is consistent with the ordinary meaning of hand held: "compact enough to be used or operated while being held in the hand or hands." Goff Decl., Ex. 7 (American Heritage Dictionary, 4th Ed., p. 795). Thus, the claim language requires a grippable housing so that the device-as a whole-can be held in one hand while operated.

Defendants' proposed constructions are supported further by the patent specification. The preamble to Claim 1 describes "a hand-held device for entering information into an electronic systems via a keyboard" suggesting that the claim is limited to devices that allow for the input of information while being held in one hand. *See Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1306 (Fed. Cir. 1999) (the preamble is "necessary to give life, meaning, and vitality" to the claim). The specification also describes the invention as "devices to be gripped and held," contrary to plaintiff's argument that the term "hand-held" means the same as "grippable":

> Hand-held devices, *particularly devices designed to be gripped and held in one hand,* are made for a variety of tasks. A portable telephone, such as a cellular telephone, is an example of a hand-held device *designed to be gripped and held in one hand* and which includes a keyboard information entry system.

'322 Patent, Col. 1:27-33 (emphasis added), Figures 1

and 2. The specification also emphasizes the advantage of a device that is held and operated with a single hand:

> Because portable telephones are sometimes used by a person engaged in an activity which requires more or less continuous use of the hand which is not holding the telephone, such as driving a car, *the ability to both grip a portable telephone and operate its keyboard with a single hand would be useful.*

Id. Col 1:33-38 (emphasis added).

Plaintiff relies on one potential embodiment described in the specification as a device that could be "a control stick on a larger piece of machinery." '322 Patent, Col. 7:51-53, Figure 7. As noted by defendants, this example is the only one in the specification that is not described as "hand-held." *Id.* Col. 7:47-63, Col. 8:1-4. Claims need not be construed to cover all alternative embodiments described in the patent specification. *Cf. Elekta Instrument S.A.*, 214 F.3d at 1308-09 (affirming claim construction even though it excluded preferred and only embodiment disclosed in the specification). Regardless, I find that one statement cannot overcome unambiguous claim language and the description contained in the specification.

Thus, I adopt defendants' proposed constructions and construe this language to mean that the device must have a grippable portion so that the device is operable when gripped and held in one hand.

2. A Concavity in Said Housing at Said Key-Actuation Position and a Thumb-Associable Cluster of Keys Forming a Keyboard Within Said Concavity

Microsoft argues that the phrase "concavity in said housing" means that the "housing of the device must include a region that is bowl-shaped (i.e., sunk below the surrounding margin)," and that "a keyboard within said concavity" means that "all of the keys of the keyboard are contained entirely within the space defined by the concavity, so that the keyboard does not extend beyond the concavity," Microsoft's Memorandum in Support of Motion for Summary Judgment of Non-Infringement, pp. 10, 12.

Saitek proffers a similar construction for this phrase: "An area sunk below a surface of the housing" with "a set of keys contained entirely within an area sunk below a surface of the housing." Saitek's Memorandum in Support of Motion for Summary Judgment of Non-Infringement, p. 9, 14.

Nokia argues that "concavity" means "a bowl-like depression in the housing," and that "a keyboard within said concavity" means that keys are mounted "inside" the concavity, not that they "form the concavity." Nokia's Memorandum in Support of Motion for Summary Judgment of Non-Infringement, p. 11.

Plaintiff originally proffered the following construction: "Concavity means a hollowed or indented region extending along one or two axes." Supplemental Declaration of James Stewart, Ex. 1, p. 7. However, in opposing defendants' motions, plaintiff expanded its construction of this phrase: "Concavity . . . refers to a hollow or opening in or on the outer surface of a device, containing keys. A concavity can

be formed by the tops of keys when the tops of such keys are arranged in an angularly offset manner. A planar surface surrounded by a rim is not a 'concavity' in the housing." Plaintiff's Memorandum in Opposition to Defendants' Motions for Summary Judgment, p. 34.

Plaintiff seemingly offers alternative constructions, because they set forth incompatible meanings of "concavity in said housing" and "keyboard within said concavity." One proposed construction defines concavity as a concave "hollow" or opening in which a keyboard is placed, and the other defines concavity as a bowl-shaped area formed by the top of the keyboard or keypad.

Plaintiff's proposed constructions are at odds with a basic tenet of patent law-that claims are to be construed without regard to the accused device. *Young Dental Mfg. Co.*, 112 F.3d at 1141. Notwithstanding the fact that the construction of claims is not a moving target that varies to correspond with a patentee's infringement allegations, I find that neither of plaintiff's constructions are supported by the plain language of the claim, the '322 patent specification, or the prosecution history.

The plain and ordinary meaning of the term "concavity," originating from "concave," is rounded or curved, like the inside of a bowl or sphere. Therefore, the claim language requires a bowl-like depression in the housing of the device. *See* Goff Decl., Ex. 7, p. 5 (American Heritage Dictionary, 4th Ed., p. 380); Ex. 8, (Webster's Ninth New Collegiate Dictionary, p. 271); Davis Decl., Ex. 10 (same). Plaintiff does not dispute that concavity means a depression or indentation.

Rather, plaintiff argues that the claim language encompasses either a "concavity" formed by the tops of the keys or an opening in the housing for the keyboard.

However, the claim language requires that the concavity be "in" the device housing. "In" should need no definition; it means "within the limits, bounds or area of"; i.e., "not out." American Heritage Dictionary, 2d Ed., p. 648. Thus, for the concavity to be in the housing, it must be within the limits or area of the housing, or formed by or form a part of the housing. Although a concavity construed an opening or "hollow" in the device could be contained "in" the device housing, a concavity formed by the keyboard could not. The concavity cannot be "in" the housing if it is in the keys or keyboard.

Further, the plain language of the claim requires that the keyboard be "within" the concavity. "Within" means "inside the limits of" or "enclosed." Goff Decl., Ex. 8 (Webster's Ninth New Collegiate Dictionary, p. 1355). The keyboard cannot be "within" the concavity if it is the tops of the keys or the keyboard that forms the concave surface. Thus, if the court construed "concavity" to include a depression formed by the tops of the keys or the keyboard, the claim limitations that require the concavity to be "in" the housing and the keyboard to be "within" the concavity would have no meaning.

The patent specification also describes keys positioned "in a concavity or depression" in the housing and illustrates the concavity as a bowl-like depression in the housing the device. '322 Patent, Col. 4:58-60. The specification makes no reference to a concavity formed by the keys of the keyboard, and

no specification drawing suggests that the keys or keyboard form the claimed concavity. *Id.* Col. 3:18-23; Col. 4:58-62, 65-67; Col. 5:27-30, 35-37, 55-56; Col. 6:13-16; Col. 7:8-10, 20-26, 30-34; Figures 1-8.

Similarly, the specification does not describe a concavity in the terms of a "hollow" in which the keyboard is placed. Rather, the specification repeatedly refers to a keyboard "within" the concavity, and all drawings of the invention depict a keyboard sunk down inside a concave area, below the surface of the housing. *See* '322 Patent, Figures 4-6. For example, in Figures 4 and 5 of the specification, the keys are located inside the concavity and do not form the outer boundary of the concavity or rise above the concave area. If the invention is designed for key actuation by the thumb "within the concavity," then the keys must be within concavity of the housing and below its surface. *Id.* Col. 3:22-24. Thus, plaintiff's construction of an opening hollow in which a keyboard is contained is not supported by the claim language or the specification unless the keyboard is sunk down in the "hollow" so that the keys are below the surface of the housing.

Finally, prosecution estoppel precludes a construction of the claim that encompasses a "concavity" formed by the keys of the keyboard. The '322 patent was the subject of a patent interference, a proceeding designed to resolve the question of invention priority when more than one applicant seeks a patent on substantially the same invention. *Stevens v. Tamai*, 366 F.3d 1325, 1330 (Fed. Cir. 2004). The patent interference involved a patent application called "Hand Held Encoding Instrument" by Goddard. Davis Decl., Exs. 5, 7. To invoke the

interference and determine who first invented the device claimed in the '322 patent, Goddard copied Claims 1 through 3 and 5 of the '322 patent into his patent application.

In particular, the Goddard Claim 33 described a "keypad and handle combination of claim 32 wherein said keypad surface is substantially concave." Davis Decl., Ex. 8, p. 5. Declaration of Chin See Ming (Ming Decl.), Ex. 5, p. 5. Gambaro argued that the Goddard Claim 32 corresponded to the concavity recited in Claim 1 of the '322 patent: "Gambaro argues that the limitation of a portion of the keypad position toward the thenar eminence facing portion of the hand . . . is an inherent feature of the 'concave keypad surface' of Gambaro Claim 1." Davis Decl., Ex. 8, p. 5. The Administrative Patent Judge disagreed:

> Gambaro's claim 1 recites "a concavity in said housing . . . and a cluster of keys forming a keyboard in said concavity." Gambaro's claim does not recite a "concave keypad surface" . . . . That the keyboard is positioned in the concavity does not mean that the keyboard itself conforms to the concavity.

Id. Ex. 8, pp. 5-6; Ming Decl., Ex. 4, pp. 5-6. "[B]ecause the interference proceedings are part of the public record and shed light on the meaning of the claims, it is proper to rely on the record of those proceedings in construing the claims." *Phillips Petroleum Co. v. Huntsman Polymers Corp.*, 157 F.3d 866, 872 (Fed. Cir. 1998).

Gambaro also distinguished the prior art keyboard of the Einbinder patent, U.S. Patent No. 4,332,493, which disclosed a concave slope of the keys. "A patentee may not write narrow claims for allowance

by the PTO and subsequently attempt to broaden the claims in court by using the doctrine of equivalents." *PSC Computer Prods., Inc. v. FoxComm Int'l Inc.*, 355 F.3d 1353, 1357 (Fed. Cir. 2004). I therefore reject plaintiff's construction of concavity as a depression formed by the keys or the keyboard.

Instead, I construe this phrase to mean that the concavity must be formed by a depression in the housing of the device, and that all keys comprising the keyboard must be contained entirely within the concave area and sunk below the surface of the housing, so that the thumb movement occurs within the concave area.

3. Each of the Plurality of Keys in Said Cluster Being Selectively Actuable via Mixed Lateral, and Slight Endo, Translation of a Thumb Within Said Concavity

Nokia argues that the phrase "mixed lateral and slight endo translation of a thumb" should be construed to mean that each key must be individually actuated by "side-to-side and slight forward movement . . . with the thumb remaining at least fully extended during all movement so that there is no inward, closing bending of the thumb." Nokia's Memorandum in Support of Motion for Summary Judgment of Non-Infringement, p. 19. Nokia contends that the claim language describes a forward and/or downward direction into the concavity rather than an inward bending the thumb to actuate any of the keys with the thumb tip. '322 Patent, Col. 6:30-32, 34-38. In other words, Nokia argues that the '322 patent teaches a dialing method whereby the thumb remains fully extended while actuating keys.

All defendants further argue that the phrase

"translation of a thumb within said concavity" means that the thumb must be within the concavity when actuating the keys. "During normal operation of the device, the portion of a user's thumb that actuates each of these keys must remain contained within the space defined by concavity during the entire motion of actuating the key." Microsoft's Memorandum in Support of Motion for Summary Judgment of Non-Infringement, p. 12; *see also* Saitek's Memorandum in Support of Motion for Summary Judgment of Non-Infringement, p. 14. ("During actuation of the keys, the thumb must remain within an area sunk below a surface of the housing."); *see also* Nokia's Memorandum in Support of Motion for Summary Judgment of Non-Infringement, p. 20.

Plaintiff originally construed endo to mean "generally within a defined area or along the long axis of an elongate object or thing," a construction that supports Nokia's contention that the thumb must move in an elongate position. Second Supplemental Declaration of James Stewart, Ex. 2, p. 6. However, in opposing Nokia's construction, plaintiff now argues that endo "includes slight extension, slight retraction, and slight flexture of the joints, consistent with the '322 specifications," i.e., that "slight endo movement" includes a downward and inward retraction or bending of the thumb. Plaintiff's Memorandum in Opposition to Defendants' Motions for Summary Judgment, p. 34. Thus, the crux of the parties' dispute over claim construction is whether and to what extent the claim language or patent specification require a particular movement of the thumb.

I agree with Nokia that reference to the

specification is necessary to determine the meaning of endo, given that this term generally means "within" when used as a prefix. *See* Davis Decl., Ex. 11 (Webster's Third New International Dictionary, p. 748). As described in the specification, the distinguishing feature of the claimed invention is that it minimizes finger, thumb, and wrist motion to alleviate "keyboard motion 'injuries.'" '322 Patent, Col. 2:58. Thus, the object of the claimed invention "is to provide a thumb-actuable key cluster which is readily usable, by temporary movement of the thumb, to a key-actuation position on the device without having to release the user's grip on the device." *Id.* Col 3:7-11. To achieve this result, the keyboard is located in a concavity at the "key-actuation position." *Id.* Col. 3:16-20.

The specification explains that the "thumb-actuated keyboard . . . requires only a small amount of movement of the user's thumb to selectively actuate any of the keys of the keyboard. The thumb need only be moved within a small cone of motion . . . in order to actuate any individual key." '322 Patent, Col. 6:57-64. As described in the specification, Figure 4 depicts a thumb positioned above the key-actuation position, i.e., above the keyboard within the concavity, with arrows pointing in the intended movement of the thumb to actuate certain keys. *Id.* Col. 6:19-43 ("Small arrows . . . indicate generally the direction in which actuating force must be applied to keys . . . ."). The arrows indicate a forward and downward movement of the thumb within the concavity, with no suggestion of a thumb flexture or retraction. "[T]he thumb . . . is rotated downwardly onto the keyboard. In that position, each key in the keyboard can be actuated by slight gestural

movements of the thumb." *See* '322 Patent, Col. 6:26-29, Figure 4.

Finally, the plain language of the claim discloses the placement of keys so that they are actuated by movement of the thumb "within" the concavity. The specification supports this construction: "In its preferred form, the concavity on the housing of the devices contains a plurality of keys . . . *to permit selective actuation by minimal movement of a thumb positioned in the concavity.*" *Id.* Col. 3:26-27, 30-33 (emphasis added).

Therefore, based on the description and drawings in the specification, I construe this phrase as meaning that the device must allow for actuation of the keys within the concavity by the thumb using slight, forward and downward gestural motion, so that the thumb movement is within the concavity. *See Carman Indus., Inc. v. Wahl*, 724 F.2d 932, 939 n.13 (Fed. Cir. 1983) ("Utility patents afford protection for the mechanical structure and function of an invention . . . .").

B. Infringement

Plaintiff claims that Microsoft's Sidewinder joysticks and several models of Saitek joysticks infringe claims 1, 2, 3, and 5 of the '322 patent, and that Nokia cellular phones 3560, 3595, 6200, and 6820 infringe claims 1, 2, 3, and 4.[4] Defendants

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[4] Plaintiff originally claimed infringement by three models of Nokia phones: 3650, 3660, and 6220. Plaintiff withdrew infringement allegations against models 3650 and 3660 and admits that model 6220 is not made, used, sold, offered for sale, or imported into the United States. *See* Davis Decl., Ex. 26, p. 2.

Microsoft, Saitek, and Nokia all move for summary judgment of non-infringement.

1. Microsoft and Saitek Products

Microsoft and Saitek argue that their joysticks do not contain two elements of Claim 1: 1) that the device be "hand held," and 2) that the device contain a keyboard within a concavity in the housing of a device.

a. Hand-Held Device

Microsoft and Saitek argue that plaintiff cannot establish infringement of Claim 1, because the Sidewinder and Saitek joysticks are not "hand-held" devices. The Microsoft Sidewinder and Saitek joysticks are operated by pivoting the joystick handle-relative to a stable base-to move a cursor on a computer screen or otherwise control a program. Microsoft and Saitek explain that pivotal control is the primary function of the joysticks and is what separates a joystick from other types of data entry devices. Thus, a stable surface or a second hand is required for proper functioning.

I agree that plaintiff cannot establish literal infringement of this claim element, because neither the Sidewinder nor the Saitek joysticks are "hand-held devices" designed to be operated in one hand. Although the "stick" part of the joystick might be grippable by the fingers with the thumb free to reach the keys, the base must be held in another hand or placed on a surface for the joystick to be operable. Even plaintiff's so-called expert agrees that the Sidewinder and Saitek joysticks would not function effectively if gripped and suspended in the air by one

hand. Goff Decl., Ex. 22, pp. 195-96.[5]

Microsoft and Saitek further argue that plaintiff cannot rely on the doctrine of equivalents under the "all-elements" rule, because the hand-held limitation of Claim 1 would be eliminated entirely if extended to cover the Microsoft Sidewinder and Saitek joysticks. I agree. *Warner-Jenkinson Co.*, 520 U.S. at 29; *Searfoss v. Pioneer Consolidated Corp.*, 374 F.3d 1142, 1151 (Fed. Cir. 2004) (claim requiring "direct" connection could not be equivalent to accused "indirect" connection); *Moore U.S.A, Inc. v. Standard Register Co.*, 229 F.3d 1091, 1106 (Fed. Cir. 2000) (claim requiring that strips of adhesive extend to the "majority" of lengths could not be equivalent to the accused's device that extended only to 47.9% of the lengths).

Moreover, plaintiff presents no evidence that the differences between the joysticks and the claimed element are insubstantial, or that the joysticks perform "substantially the same function in substantially the same way to obtain the same result" as the hand-held limitation. *Warner-*

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[5] The Court hesitates to call Mr. Stewart an expert in this case; he is not a person of ordinary skill in the field of the art, and he is not qualified to render opinions as to the engineering of ergonomic keyboards. *See* Goff Decl. in Opposition to Plaintiff's Motion for Summary Judgment, Ex. 2 (Stewart Dep., p. 14). Stewart has not performed work in the field of ergonomics, has no education or training in ergonomics, does not subscribe to publications dealing with ergonomics, or attend conferences dealing with ergonomics. The sum total of Stewart's experience in the field appears to be choosing the proper chair at his workplace. *Id.* (Stewart Dep., pp. 14-15).

Jenkinson Co., 520 U.S. at 39. Plaintiff cannot rely on conclusory statements; rather, it must establish substantial equivalence by a preponderance of the evidence. *Lemelson*, 752 F.2d at 1547, 1551.

b. Concavity in Housing and Keyboard Within Concavity

Second, Microsoft and Saitek argue that none of the joysticks contain a keyboard within a concavity in the housing of the device.

The Microsoft Sidewinder joystick handles each have a broad top surface that faces toward the user's thumb when the handle is gripped by the user. The surface is almost imperceptibly curved from side to side, resembling a flat, shallow channel. Located within the shallow channel are four keys, including a miniature joystick key and three other keys. Several ridges surround the channel and the keys, and the top of the miniature joystick extends beyond the channel space and the other keys raise above the surface of the channel. Goff Decl., Ex. 12; Physical Exs. A, B.

Upon viewing the accused Sidewinder joysticks, it is clear that there is no "concavity" in the housing, no keyboard "within" the concavity, and no keys actuable by slight, gestural thumb motion within a concavity. The alleged "concavity" is actually a channel on which the thumb keys are located; it is not a bowl-shaped depression sunk below the surface of the housing. *See id.* Even if the court construed concavity to cover the shallow channel of the Sidewinder joysticks, the keys are not "within" a concavity, because they extend beyond the limits of the channel.

Plaintiff maintains that-viewed from above-all four

keys lie within the concavity. In other words, plaintiff would have the court look to the Sidewinder joysticks from a two-dimensional viewpoint. Notwithstanding the fact that this argument would render "concavity" a nullity, the Sidewinder joysticks are not two-dimensional devices. Plaintiff also argues that it is irrelevant that the miniature joystick key extends beyond the limits of the "channel," because an accused device may have additional features not present in the patented device, *i.e.*, additional keys not within the concavity. Regardless, plaintiff must still establish that the accused device includes *all* elements of the claimed device. *Laitram Corp. v. Rexnord, Inc.*, 939 F.2d 1533, 1535 (Fed. Cir. 1991). Here, none of the thumb keys are contained within any "concavity" in the housing of the joysticks.

Like the Sidewinder joysticks, the Saitek joysticks each have a handle protruding upward from the center of the housing base. Keys are positioned on top of the handle and generally form a wide curve where the thumb actuates the keys, with the keys extending above the upper end of the joystick handle. *See* Physical Exs. 30-36. I find that no Saitek joystick model contains a concavity in the housing or a keyboard within a concavity. In some models the keys are attached to the joystick housing by a hinge. In others, the keys are located on top of the joystick handle, and the keys are shaped to formed a curved surface. In either case, no concavity is present in the device housing and no keyboard is located within a concavity. *See* Ex. Physical Exs. 30-32.

Plaintiff argues that the shape of the Saitek joystick keys surfaces define a concavity above the keys, and that the Saitek joystick keys constitute a

portion of the housing. Plaintiff's argument rests on its construction of the term "concavity" as that formed by key tops, a construction the court has rejected. Moreover, plaintiff fails to explain how a "concavity" can be both a shallow channel on which keys are located as well as a slope formed by the keys. Regardless, I find that neither the Microsoft nor the Saitek joysticks contain a concavity in the housing or a keyboard within a concavity. It goes without saying that the joysticks do not include keys actuable by slight, gestural thumb movement within a concavity.

Infringement likewise cannot be established under the doctrine of equivalents, because to so find would vitiate these claimed elements. Moreover, plaintiff presents no evidence that the joysticks are substantially similar to the '322 patent device in terms of form, function, or result. *Texas Instruments Inc.*, 90 F.3d at 1566.

Moreover, plaintiff is estopped from relying on the doctrine of equivalents, because a "concavity in keytop surface" is found in the prior art of the Einbinder patent as disclosed in the '322 Patent. '322 Patent, Col. 2:34-36. "It is well settled law that a patentee cannot assert a range of equivalents that encompasses the prior art." *Interactive Pictures Corp. v. Infinite Pictures, Inc.*, 274 F.3d 1371, 1380 (Fed. Cir. 2001). "[I]t would not be equitable to allow a patentee to claim a scope of equivalents encompassing material that had been previously disclosed by someone else, or that would have been obvious in light of others' earlier disclosures." *Tate Access Floors*, 279 F.3d at 1367. Thus, because the Einbinder patent teaches a concave keypad surface,

plaintiff cannot rely on the doctrine of the equivalents to establish infringement of the '322 claims by the Saitek joysticks. "[O]ne cannot, in the course of litigation and outside of the PTO, cut and trim, expanding here, and narrowing there, to arrive at a claim that encompasses an accused device, but avoids the prior art." *Streamfeeder, LLC v. Sure-Feed Systems, Inc.*, 175 F.3d 974, 983 (Fed. Cir. 1999); *Marquip, Inc.*, 198 F.3d at 1367 ("Based on the fundamental principle that no one deserves an exclusive right to technology already in the public domain, this court has consistently limited the doctrine of equivalents to prevent its application to ensnare prior art.").[6]

Accordingly, plaintiff fails to establish that the Microsoft and Saitek joysticks are hand-held devices or that any of them contain a concavity in the housing for placement of a keyboard actuable by slight gestural motion of the thumb. Therefore, I grant Microsoft's and Saitek's motions for summary judgment of non-infringement of the '322 patent.

2. Nokia Products

Nokia argues that its accused models of phones do not contain: 1) a concavity in the housing or a keyboard within the concavity; or 2) keys that are "selectively actuable via mixed lateral and slight

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[6] Microsoft also argued that application of the doctrine of equivalents would ensnare the prior art aircraft joysticks owned by the McDonnell-Douglas Corporation (the Walker and Marshall patents). However, the court has rejected plaintiff's doctrine of equivalence arguments and need not determine whether the Marshall or Walker patents constitute prior art.

endo" movement of the thumb within the concavity. Nokia maintains that none of the accused phones contains a "concavity" in the phone housing at the "key actuation position" into which a user can place a thumb to selectively acuate the keyboard within the concavity, and therefore plaintiff cannot establish infringement of the '322 patent.

a. Keyboard Within Concavity

Like Microsoft and Saitek, Nokia argues that plaintiff cannot show infringement of Claim 1, because none of its phones have a keyboard within a concavity, i.e., a bowl-like depression in the housing of the phone. All of the accused Nokia models of phones are designed in a similar fashion; each has a cover that fits over the keypad and internal mechanisms of the phones. The cover has an opening for the keypad, so the keys of the keypad rise slightly above the housing cover. *See* Davis Decl., Ex. 15, pp. 1-5; Nokia Inc. Demonstrative Exhibits, pp. 11-13, 15-18, 20-22, 24-26.

To establish infringement, plaintiff relies on its alternative constructions of "concavity" as either an opening or "hollow" in the phone intended for the placement of the keypad or as a depression formed by the keypad surface.

I do not find that an opening in the cover of the Nokia phones meets the claimed limitation of "concavity" as construed by the court. An opening in a phone cover is not a "depression" sunk down below the surface of the housing. Likewise, I find that none of the phones contain a concavity by virtue of the slight depression formed by the keys or keypad surfaces, because the concavity must be in the "housing" of the device and the keypad must be

located "within" the concavity to accommodate thumb actuation of the keys. If the keypad forms the concavity, the keys are not "within" the concavity, and the keypad cannot be activated by moving the thumb within the concavity.

Plaintiff responds that even if keys on the accused Nokia phones are not within the "concavity," it is irrelevant, because the presence of additional elements will not avoid infringement so long as the elements of the claim are met. However, plaintiff appears to be missing the point of Nokia's argument- the claim requires the keyboard to be "within" the concavity.

Plaintiff also relies on the doctrine of equivalents, arguing that the "concavity" formed by the surface of the keys is the functional equivalent of keys within a concavity. Plaintiff maintains that application of the doctrine would not "vitiate" the element of a "concavity in said housing" and a keyboard "within said concavity," because the concavity formed by the keyboard allows the thumb to actuate the keys with light movements within the concavity.

Plaintiff, again, fails to provide any evidence that the accused phones perform substantially the same function in substantially the same way with substantially the same result. Regardless, for the reasons explained above, plaintiff is estopped from relying on the doctrine of equivalents to cover the sloped surface of the keypad, because to do so would ensnare the prior art Einbinder patent.

b. Endo Translation of Thumb

Nokia contends that the keyboard on the accused phones are not "selectively actuable via mixed lateral, and slight endo translation of a thumb within

said concavity," because the accused Nokia phones are designed to be dialed with the tip of the thumb or the thumbnail through an inward bending of the thumb followed by a downward movement into the phone. Davis Decl., Exs. 22, 23, 24, 25 (expert affiants opining that Nokia phones are not designed for the dialing method described in '322). In contrast, Nokia argues that the '322 patent is designed to be dialed using side-to-side and forward translations of an elongate thumb within the housing's concavity. *See* 322 Patent, Col 6:11-16, 30-42; Figures 4, 5 and 6. Nokia therefore argues that the accused phones do not perform the same function or teach the same dialing method as disclosed in the '322 patent.

Plaintiff disagrees, arguing that the structure of the Nokia phones support the dialing method of the '322 patent and therefore can be found to infringe. I find that whether the Nokia phones support the slight endo translation of the thumb as described in the '322 patent specification is ultimately a question of fact. Regardless, the keyboard is not actuable via translation of the thumb within the concavity, because the phones do not contain a keyboard within a concavity as construed by the court. Therefore, plaintiff fails to establish infringement of Claims 1, 2, 3, and 4 by the Nokia phones, and Nokia's motion for summary judgment of non-infringement is granted.

III. INVALIDITY

Defendants Microsoft and Saitek seek a declaratory judgment of invalidity of the '477 and '322 patents and move for summary judgment on this ground. Nokia also moves for summary judgment on its affirmative defense of invalidity, but it did not assert a counterclaim for declaratory judgment.

Therefore, the court's finding of non-infringement renders the question of invalidity moot with respect to Nokia's affirmative defense. *See Cardinal Chem. Co. v. Morton Int'l, Inc.*, 508 U.S. 83, 93-94, 95-96, (1993).

Microsoft also moves for summary judgment of invalidity of the '477 patent if the court adopted plaintiff's construction of the patent claims.[7] However, the court declined to adopt plaintiff's proffered constructions; therefore, Microsoft's motion for summary judgment of invalidity of the '477 patent is rendered moot. Therefore, the court considers defendants' invalidity motions that do not rely on the court's construction of claim terms: defendants' joint motion for summary judgment of invalidity, Microsoft's Motion for Summary Judgment of Invalidity of the '322 Patent, and Saitek's Motion for Summary Judgment of Invalidity of the '322 patent.[8]

A patent is invalid if "the invention was patented or described in a printed publication in this or a foreign country or in public use . . . more than one year prior to the date of the application for patent."

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[7] Specifically, Microsoft argued that two prior art keyboard designs, the Retter and Stucki patents, anticipated the '477 patent if the court adopted plaintiff's construction of the claims to cover the Strategic Commander.

[8] Originally, the court believed that Saitek's Motion for Summary Judgment of Invalidity was also brought in the event the court adopted plaintiff's claim construction. After further consideration of Saitek's motion, I find that it is limited with respect to the "Hot Gun Grip." In an abundance of caution, the court considers Saitek's motion with respect to its argument that the Tomy Car Toy anticipates the '322 Patent.

35 U.S.C. § 102(b). A patent is presumed valid, and the burden of proving invalidity by clear and convincing evidence rests with the challenger. *Id.*; *United States v. Telectronics Inc.*, 857 F.2d 778, 785 (Fed. Cir. 1988). All defendants assert invalidity on grounds of public use, and Microsoft and Saitek assert invalidity on grounds of anticipation by prior art.

A. Public Use

Defendants argue that the '477 and '322 patents are invalid, because the patents were filed more than one year after public use of Gambaro's "Cherry Model 5" keyboard (Cherry Model). Defendants argue that Gambaro's 1987 disclosures of the Cherry Model to third parties for commercial purposes constitutes "public use" within the meaning of the Patent Act, and therefore the '477 and '322 patents are invalid.

Public use is a question of law based on underlying facts. *Manville Sales Corp. v. Paramount Sys., Inc.*, 917 F.2d 544, 549 (Fed. Cir. 1990). The party with the burden of proof must show that "the subject of the barring activity met each of the limitations of the claim, and thus was an embodiment of the claimed invention." *Scaltech Inc. v. Retec/Tetra, L.L.C.*, 178 F.3d 1378, 1383 (Fed. Cir. 1999). Further, the moving party must show that the device was in public use. *Id.*

The '477 patent has an effective filing date of June 6, 1991. The '322 patent, with the added feature of a hand-held device, has an effective filing date of January 11, 1993. Plaintiff has admitted that the Cherry Model embodies the '477 and '322 patent claims. *See* Davis Decl., Ex. 17, pp. 19, 20 (Gambaro Dep., pp. 138-39, 287). Thus, June 6, 1990 is the

critical date by which defendants must establish public use of the Cherry Model to invalidate the '447 patent, and January 11, 1992 is the critical date to establish invalidity of the '322 patent.[9]

Public use "includes any use of the claimed invention by a person other than the inventor who is under no limitation, restriction or obligation of secrecy to the inventor." *Minn. Mining & Mfg. Co. v. Chemque, Inc.*, 303 F.3d 1294, 1301 (Fed. Cir. 2002); *see also In re Smith*, 714 F.2d 1127, 1134 (Fed. Cir. 1983). Thus, the court must consider "the nature of the activity that occurred in public; the public access to and knowledge of the public use; [and] whether there was any confidentiality obligation imposed on persons who observed the use . . . among other factors." *Allied Colloids Inc. v. Am. Cyanamid Co.*, 64 F.3d 1570, 1574 (Fed. Cir. 1995).

The court must also consider policies underlying the public use doctrine, which include "discouraging the removal of inventions from the public domain which the public justifiably comes to believe are freely available, prohibiting an extension of the period for exploiting the invention, and favoring prompt and widespread disclosure of inventions." *Manville Sales*, 917 F.2d at 550 (internal citation and quotation marks omitted). The "onus is on . . . the inventor, to protect the confidentiality of his

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[9] In this proceeding, plaintiff denies that the Cherry Model embodies Claims 5, 6 and 8 of the '477 patent, because it does not have key clusters mounted for "selective, positional adjustment." However, Gambaro's admissions are binding on plaintiff.

invention and its use by others before the critical date." *Netscape Communications Corp. v. Konrad*, 295 F.3d 1315, 1323 (Fed. Cir. 2002).

The Cherry Model was developed and reduced to practice by Gambaro as of February 22, 1987. Davis Decl., Ex. 17, pp. 18-19 (Gambaro Dep. pp. 137-38). Shortly thereafter, Gambaro disclosed and demonstrated the Cherry Model to Keith Coulter, his business partner, Kathie Roberts, a friend, and potential investors Bill Marx, Loren Ray, Doug Stroh, Jack Hull, and Bill Osborne, among other investors. *See* Davis Decl., Ex. 17 (Gambaro Dep. pp. 140-41, 285, 472-73, 475-76); Ex. 34, pp. 1, 2, 5, 7-10; Declaration of Keith Coulter (Coulter Decl.). Coulter also disclosed the Cherry Model to Sheila Lanier on June 25, 1990 for the purpose of conducting typing tests. Although many third parties entered into two-year non-disclosure agreements to keep the Cherry Model confidential, the non-disclosure agreements signed by Marx, Ray, Hull, and Osborne expired in 1989. Davis Decl., Ex. 34, pp. 1, 2, 5, 7-10.

According to Gambaro's deposition testimony, almost all disclosures of the Cherry Model were for the purposes of commercial evaluation and the procurement of investment capital. Davis Decl., Ex. 17, pp. 11-12, 21, 22, 33 (Gambaro Dep., pp. 107-08, 140-41, 287). Specifically, Gambaro disclosed the Cherry Model to Coulter to recruit potential investors, generate commercial interest in Gambaro's keyboards, and determine their marketability. *Id.* Ex. 17, pp. 9-10, 25-28, 29-30 (Gambaro Dep., pp. 105-07, 144-47, 272-73). Coulter Decl., p. 2. Defendants emphasize that these activities were not made known to the PTO.

Plaintiff argues that defendants have merely shown a series of disclosures rather than "public use" of the Cherry Model within the meaning of § 102(b). Plaintiff maintains that "public use" requires commercial use of an invention that is fully commercialized, i.e., for sale or ready to be sold. Plaintiff argues that the display and presentation of the Cherry Model was merely to prepare for commercialization and does not constitute "literal" or actual use to fall within the public use prohibition. Plaintiff provides little support for this argument, and I do not find it persuasive.

The public use doctrine does not require that the invention be a fully commercialized product or made available for sale. 35 U.S.C. § 102(b) (a patent is invalid if "in public use *or* on sale in this country" for more than one year before its effective filing date (emphasis added)). Further, public use does not require "actual" or "literal" use. *Watson v. Allen*, 254 F.2d 342, 345 (D.C. Cir. 1958) (public use has "extraordinarily broad" meaning). Although disclosures constituting "bona fide experimental purpose" are excluded from the public use bar, the amount and type of public use under § 102(b) is *de minimis*. *Grain Processing Corp. v. American-Maize Products Co.*, 840 F.2d 902, 906 (Fed. Cir. 1988). Finally, there can be no experimental use of an invention once it has been reduced to practice. *In re Smith*, 714 F.2d at 1134-35; *see also New Railhead Mfg. L.L.C. v. Vermeer Mfg. Co.*, 298 F.3d 1290, 1297-98 (Fed. Cir. 2002).

Plaintiff concedes that the Cherry Model was reduced to practice as of February 1987. Thus, no experimental use occurred after this date. Further,

Gambaro and Coulter admit that the Cherry Model was shown or demonstrated to potential investors, and that the investors sometimes "handled" the keyboard. Coulter Decl., p. 2. A demonstration by the inventor or a third party may invoke the public use bar under § 102(b). *See Eolas Techn. Inc. v. Microsoft Corp.*, 399 F.3d 1325, 1334 (Fed. Cir. 2005) (third-party demonstration to two employees without confidentiality agreements was a public use). Plaintiff also admits that Lanier used the Cherry Model on June 25, 1990 to see how fast she could type. *Netscape Communications*, 295 F.3d at 1322 ("Konrad's demonstration was geared more toward making the remote database object more commercially attractive, with endorsements from outside technical people, than for experimental use purposes."). Therefore, I find that the Cherry Model was disclosed for public use more than one year before the '477 or '322 patents were filed.

Plaintiff next argues that the non-disclosure agreements created an obligation of secrecy, and therefore the public use doctrine does not render the '477 or the '322 invalid. Plaintiff maintains that the disclosures to potential investors were not "public," because the third parties were bound to keep the Cherry Model confidential. Finally, plaintiff contends that while it is "theoretically" possible that a third party used the Cherry Model, defendants fail to produce clear and convincing evidence that such use occurred.

It is undisputed that several third parties signed non-disclosure agreements and agreed to keep the Cherry Model confidential. However, the term of most of the agreements expired after two years, in

1989-two years prior to the filing of the '477 patent. Accordingly, once the confidentiality agreements expired, the Cherry Model disclosure entered the public domain. Notably, Gambaro's business partner, Coulter, was not subject to the non-disclosure agreement when he disclosed the Cherry Model to spur commercial interest in it and other Gambaro keyboards. Davis Decl., Ex. 17 (Gambaro Dep., pp. 25, 105, 107-08).

Regardless, "[t]he presence or absence of a confidentiality agreement is not dispositive of the public use issue, but 'is one factor to be considered in assessing all the evidence.'" *Bernhardt, L.L.C. v. Collezione Europa USA, Inc.*, 386 F.3d 1371, 1379 (Fed. Cir. 2004) (quoting *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 1266 (Fed. Cir. 1986)); *see also Kinzenbaw v. Deere & Co.*, 741 F.2d 383, 390 (Fed. Cir. 1984) ("While secrecy is one factor to be considered in determining whether the use was experimental or public, secrecy alone does not necessarily negate public use." (citations omitted)). Here, I find that the totality of the circumstances support application of the public use doctrine.

Importantly, a confidentiality agreement will not preclude application of the public use doctrine, if the device was disclosed for commercial purposes. "A commercial use is a public use even if it is kept secret." *Kinzenbaw*, 741 F.2d at 390. In order to be commercial, the use must provide some type of commercial advantage to the inventor. *Id.* at 391; *D.L. Auld Co. v. Chroma Graphics Corp.*, 714 F.2d 1144, 1147 (Fed. Cir. 1983) (the purpose of the public use and on sale bar "is to preclude attempts by the inventor or his assignee to profit from commercial use

of an invention for more than a year before an application for patent is filed"). As explained by the esteemed Judge Learned Hand:

> It is indeed true that an inventor may continue for more than a year to practice his invention for his private purposes of his own enjoyment and later patent it. But that is, properly considered, not an exception to the doctrine, for he is not then making use of his secret to gain a competitive advantage over others; he does not thereby extend the period of his monopoly.

Metallizing Eng'g Co. v. Kenyon Bearing & Auto Parts Co., 153 F.2d 516, 520 (2d Cir. 1946).

Here, Gambaro disclosed an embodiment of the '477 and '322 patents after the Cherry Model was reduced to practice for the purpose of commercial evaluation and procurement of capital investment. The disclosures were intended to convince third-parties to invest in the device, and Gambaro used some of the investment funds for personal income. Davis Decl., Ex. 17 (Gambaro Dep. 107-08, 466-67, 475-76). "[I]t is a condition upon an inventor's right to a patent that he shall not exploit his discovery competitively after it is ready for patenting; he must content himself with either secrecy, or legal monopoly." *Metallizing Eng'g Co.*, 153 F.2d at 520. To avoid invalidity by public use, Gambaro was required to file patents of his invention within one year after public use of the Cherry Model. Gambaro failed to do so, and now the '477 and the '322 patent are invalid.

B. Obviousness of the '322 Patent

Defendants next argue that the '322 patent is invalid for obviousness as well as for public use.

A claimed invention is unpatentable if the differences between it and the prior art "are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. § 103(a); *Graham v. John Deere Co.*, 383 U.S. 1, 13 (1966). The relevant inquiry is whether there is a reason, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the references, and that would also suggest a reasonable likelihood of success. *See Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664 (Fed. Cir. 2000).

During the prosecution of the '322 patent, the PTO found that the invention disclosed in the '322 patent would be "obvious" in light of the ergonomic keyboard of the '447 patent. Davis Decl., Ex. 3. Thereafter, Gambaro filed a terminal disclaimer, which forfeited the term of the '322 patent after the expiration of the '477 patent. *Id.* Exs. 3, 4. Given that Gambaro has admitted that the Cherry Model embodies the claims of the '477, the Cherry Model is prior art to the '477 patent and thereby renders the '322 patent obvious based on Gambaro's admissions.

C. Anticipation by Prior Art

Microsoft and Saitek argue that the '322 patent is invalid as anticipated by prior art. Microsoft argues that two design patents for telephone handsets contain each element of the recited in Claims 1, 2, 3, and 5 of the '322 patent claims. Saitek argues that the Tomy Car Toy contains each element of Claim 1 of the '322 patent. Both defendants emphasize that these prior art references were not disclosed to the PTO when Gambaro sought to obtain the '322 patent.

Invalidity based on anticipation entails a two-step

analysis. First, the court determines whether each the prior art was referenced or shown in a "printed publication" more than one year before the '322 patent was filed. 35 U.S.C. § 102(b). Printed publications include catalogues, brochures, or instructions that are distributed to the public. *See Mazzarie et al. v. Rogan*, 323 F.3d 1000, 1005 (Fed. Cir. 2003). Second, the court compares the properly construed claims to the prior art. *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339, 1346 (Fed. Cir. 2000). A claim is anticipated if every limitation is described in the prior art reference. *Id.*

1. The Foreman and Deighan Patents

Microsoft argues that two prior art references-the Foreman and Deighan Patents-include all limitations of Claim 1 of the '322 patent, and therefore anticipate the '322 patent, regardless of whether the '322 patent claims are construed to encompass the Microsoft joysticks.

United States Design Patent No. D258,061 to Foreman (the Foreman Patent) was issued on January 27, 1981, more than ten years before the application of either the '477 or the '322 patents. Goff. Decl., Ex. 13. United States Design Patent No. D303,250 to Deighan (the Deighan Patent) was issued on September 5, 1989, more than one year prior to the application of either the '477 or the '322 Patent. Goff Decl., Ex. 14. Thus, the remaining issue is whether the Foreman or Deighan patent include all elements of the '322 patent.

A design patent claims an overall design set forth in the accompanying drawings, as opposed to a utility patent, where the function and structure of the invention are described in words. "Unlike an

invention in a utility patent, a patented ornamental design has no use other than its visual appearance, and its scope is limited to what is shown in the application drawings." *In re Harvey*, 12 F.3d 1061, 1064 (Fed. Cir. 1993) (quotation marks and citation omitted); *see also Carmen Indus.*, 724 F.2d at 939, n.13 ("Utility patents afford protection for the mechanical structure and function of an invention whereas design patent protection concerns the ornamental or aesthetic features of a design.").

The Foreman Patent teaches a design for a telephone transmitter and receiver. The design includes a housing with a grippable portion and a keypad surrounded by a rim located on the back of the earpiece. Goff Decl., Ex. 13, Figures 1 and 5. In addition to ten numeric keys, two "switcher" keys are located at the bottom corner of the keypad. *Id.* Similarly, the Deighan patent is a design patent that teaches a telephone radio hand set with a grippable handle. The design drawings depict a sunken region on the back of the earpiece where the keypad is located. Goff Decl., Ex. 14.

Plaintiff argues that the device disclosed in the Foreman patent cannot be utilized to perform the '322 patent dialing method, because the rim surrounding the keypad obstructs the thumb movement. Plaintiff further maintains that a flat surface with a rim is not a concavity, and that the "rocker" key of the Foreman design is not a "key" within the meaning of the '322 patent (contrary to plaintiff's argument with respect to infringement of the '477 Patent by the Strategic Commander). Finally, plaintiff argues that the drawings in the Deighan patents were solely for design and

illustrative purpose rather than disclosure of the device.

To establish anticipation, Microsoft must establish that the Foreman and Deighan patents meet each limitation of Claim 1 of the '322 patent. "For a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its existence in the prior art." *Motorola Inc. v. Interdigital Tech. Corp.*, 121 F.3d 1461, 1473 (Fed. Cir. 1997). "Typically, testimony concerning anticipation must be testimony from one skilled in the art and must identify each claim element, state the witnesses' interpretation of the claim element, and explain in detail how each claim element is disclosed in the prior art reference. The testimony is insufficient if it is merely conclusory." *Koito Mfg. Co., Ltd. v. Turn Key Tech, LLC*, 381 F.3d 1142, 1152 (Fed. Cir. 2004) (quoting *Schumer v. Lab. Computer Sys. Inc.*, 308 F.3d 1304, 1315 (Fed. Cir. 2002). However, expert testimony is not necessarily required if the patent is "easily understandable." *Id.* at 1152, n.4. Because anticipation is a question of fact, "[s]ummary judgment is proper if no reasonable jury could find that the patent is not anticipated." *Telemac Cellular Corp. v. Topp Telecom, Inc.*, 247 F.3d 1316, 1327 (Fed. Cir. 2001).

Here, Microsoft provided explanatory argument and a comparative claim chart to establish that each claim limitation of the '322 patent was met by the Foreman and Deighan design patents. Although persuasive, I ultimately find that questions of fact exist as to whether the all limitations of Claim 1 are present in the Foreman or Deighan patent.

In particular, the '322 patent teaches a device with "a grippable portion which the permits the device to be held in one hand with the thumb free to move at least temporarily to a predetermine to enable the thumb to actuate keys within the concavity while the device is held" using "slight, gestural motion." In other words, the design drawings of either the Foreman or the Deighan Design Patents must disclose a device that allows for the thumb to actuate keys with only slight gestural motion. It is not clear from the design drawings whether this claim element is met, and I find that it is inappropriate for summary judgment.

Denial of Microsoft's motion, however, does not preclude judgment in its favor on it counterclaim for invalidity, given my finding that the prior public use of the Cherry Model invalidates the '477 and '322 patents.

2. Tomy Car Toy

Saitek argues that the '322 patent is invalid because the Tomy Car Toy anticipates all elements of Claim 1. The Tomy Car Toy is a child's car toy activated by a hand controller. The controller includes two keys located in an seemingly concave area in the housing, with child using the hand controller to control the steering direction of the car. The Tomy Car Toy was disclosed in a printed catalogue as of June 1991, more than one year prior to the filing of the '322 Patent. *See* Declaration of Masaru Tomiyama (Tomiyama Decl.).

Saitek relies primarily on the admission by plaintiff that the Tomy Car Toy recites all elements of Claim 1, except for the "slight endo translation of the thumb." As with the Foreman and Deighan

patents, plaintiff maintains that the Tomy Car Toy does not teach the dialing method of the '322 patent.

Saitek responds that the '322 patent is an apparatus patent and as such, the claims disclose what the device is rather than what it does. Saitek emphasizes that while plaintiff may rely on either the structural or functional features of the invention, plaintiff must "show that the prior art structure did not inherently possess the functionally defined limitations of his claimed apparatus." *In re Schreiber*, 128 F.3d 1473, 1478 (Fed. Cir. 1997). Thus, plaintiff cannot simply rely on the functional language of the claim without also relying on the structural limitations necessary to provide the desired function. Consequently, Saitek argues if plaintiff relies only on the function of the invention, Claim 1 is invalid under either of plaintiff's definitions.

Although like Microsoft's, Saitek's argument, too, is persuasive and thought-provoking, I find summary judgment inappropriate. Although plaintiff admitted that the Tomy Car Toy contained almost all of the limitations of Claim 1, plaintiff's construction of those terms varies considerably from the court's. Upon review of the Tomy Car Toy, I find that it is a question of fact whether it contains all the limitations of Claim 1. For example, I question whether the Tomy Car Toy contains a keyboard "within" a concavity as construed by the court, given that the key tops of the controller are even with or above the surface of the housing. *See* Tomiyama Decl., Ex. E. Therefore, Saitek's motion for summary judgment of invalidity is denied on this ground. However, as with Microsoft, the court may still enter judgment in favor of Saitek on its counterclaim of invalidity in light of

the court's finding of invalidity of the '322 patent based on prior public use and obviousness.

CONCLUSION

Defendants' Motions for Summary Judgment of Non-Infringement of U . S. Patent No. 5,187,477 and U.S. Patent No. 5,332,322 (docs.81, 84, 94, 100) are GRANTED. Defendants' Joint Motion for Summary Judgment of Invalidity for Public Use (doc. 87) is GRANTED.

Defendant Microsoft's Motion for Summary Judgment of Anticipation of U.S. Patent No. 5,332,322 (doc. 75) is DENIED with respect to the Foreman and Deighan patents and DENIED as MOOT in all other respects. Defendant Saitek's Motion for Invalidity of U.S. Patent No. 5,332,322 is DENIED as MOOT with respect to the Hot Gun Grip and DENIED on all other grounds. Defendant Microsoft's Motion for Summary Judgment of Anticipation of U.S. Patent No. 5,187,477, and defendant Nokia's Motion for Summary Judgment of Invalidity (docs.78, 91, 104) are DENIED as MOOT.

Plaintiff's Motion and Supplemental Motion for Partial Summary Judgment (docs. 25 and 111) are DENIED.

Judgment shall issue in favor of all defendants with respect to plaintiff's claims of Patent Infringement alleged in Counts I through III of the Amended Complaint. Judgment shall issue in favor of defendant Microsoft Corporation on its Counterclaims as alleged in Counts I and II of Microsoft's Amended Answer. Judgment shall issue in favor of defendant Saitek Industries, Ltd. on its Counterclaim for Declaratory Judgment of Invalidity and Non-Infringement as alleged in Saitek's

Amended Answer.

IT IS SO ORDERED.

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF OREGON
Eugene Division

MOTIONLESS KEYBOARD COMPANY, Plaintiff

v.

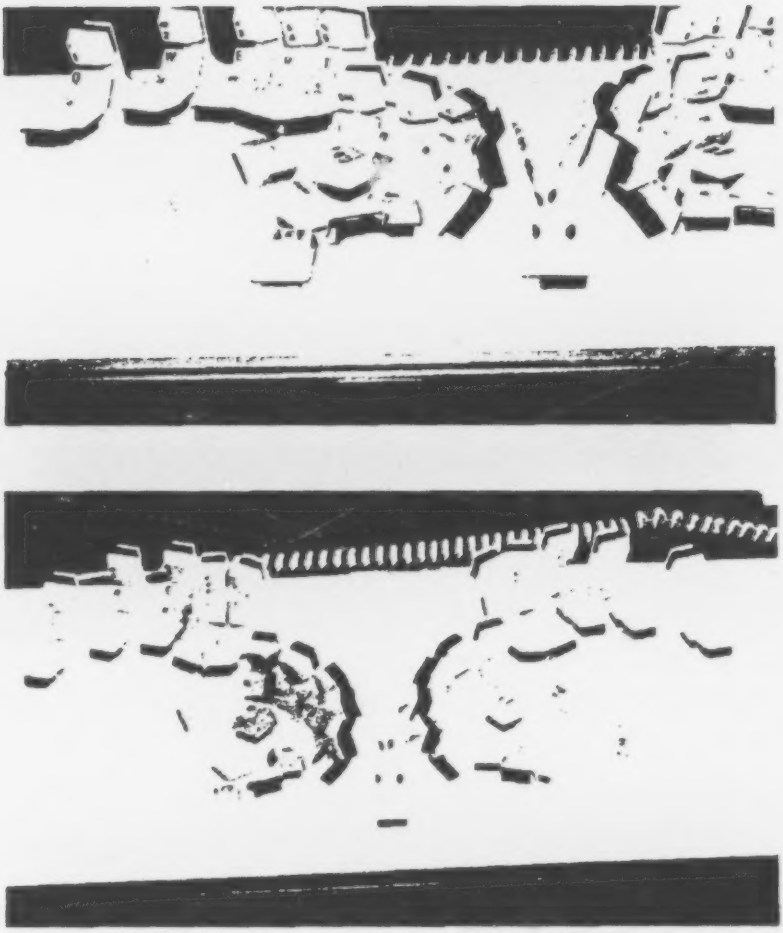
MICROSOFT CORPORATION, Nokia Inc., and Saitek Industries Ltd., Defendants.

No. 04-CV-180-AA

PLAINTIFF'S RESPONSE TO DEFENDANTS' CONCISE STATEMENT IN SUPPORT OF MOTION FOR SUMMARY JUDGMENT OF INVALIDITY FOR PUBLIC USE

For its response to Defendants' Concise Statement in Support of Motion for Summary Judgment of Invalidity For Public Use Under 35 U.S.C. § 102(B), plaintiff states as follows:

1. Admit. Although Mr. Gambaro did respond "yeah, it does" to the question whether the Cherry Model 5 "embodies your '477 patent" (Gambaro Dep. (Vol. II) 287:12-14), it is apparent from inspection of the device that it does not embody Claims 5, 6 & 8 because it does not have any clusters mounted for "selective, positional adjustment":



(Gambaro Dep. Ex. 11, at 1 (handwritten notation airbrushed out at lower right).)

2. Deny. Although Mr. Gambaro did testify that he "would say" that the Cherry Model 5 did have all the attributes of Claim 1 of the '322 patent, he stated that "it would come down to how you would define hand-held and hand-grippable". (Gambaro Dep. (Vol. II) 139:8-9.) Casual inspection of the Cherry Model 5 keyboard (photo reproduced above) confirms that it is manifestly not a "hand held" device as that term is used in the '322 patent.

3. Admit that the Cherry Model 5 keyboard was completed and reduced to practice by February 22, 1987, but deny that it generally "reduced to practice the '322 and '477 claims inventions, for the reasons explained in paragraphs 1-2 hereof.

4. Admit.

5. Admit that the '322 patent was filed on January 11, 1993, but state that pursuant to 35 U.S.C. § 120, its critical date is that same as the '477 patent, for reasons explained in the accompanying memorandum.

6. Admit that the Cherry Model 5 keyboard was disclosed to several third parties as outlined in the deposition testimony cited by Microsoft, but deny that it was actually "demonstrated to" or "used by" "numerous third parties." As Mr. Gambaro testified, Ms. Kathy Roberts "may have been the only one that saw it in operation," (Gambaro Dep. (Vol. II) 140:20-21), because Mr. Gambaro was "living in her attic at the time, and I had the little workshop going on up there" (id. 141:8-11). Most of the time, Mr. Gambaro would simply show third parties the keyboard. (*See id.* 141:3-4.)

7. Deny, except admit that Mr. Coulter was a business partner of Mr. Gambaro who attempted to find investors to develop the ideas of Mr. Gambaro. The cited deposition excerpts from Volume I of Mr. Gambaro's deposition refer to models prior to Cherry Model 5; asked directly whether Mr. Coulter had seen the Cherry Model 5, Mr. Gambaro testified: "I don't know if he saw it working or not. He probably saw the model. I don't know for sure if he saw it working." (Gambaro Dep. (Vol. II) 146:23 to 147:1.) With respect to the role played by Mr. Coulter, plaintiff is

filing herewith a Declaration of Keith Coulter, who emphasizes that: "At no time did I ever sell or market the keyboard or designs for it." (Coulter Decl. ¶ 9.)

8. Deny. Mr. Coulter understood that he had to maintain the confidentiality of the Cherry Model 5 information. (Coulter Decl. ¶¶ 3-4.)

9. Admit that the Cherry Model 5 keyboard was disclosed to third parties who were potential investors, but deny that the Cherry Model 5 was "demonstrated" or "used" (Coulter Decl. ¶ 6; Gambaro Dep. (Vol. II) 140:20-21), and deny that the potential investors were investing in Mr. Gambaro's keyboard designs (*see* Coulter Decl. ¶ 9).

10. Admit.

11. Admit.

12. Admit that the disclosure of the Cherry Model 5 keyboards was to recruit potential investors, but deny that the disclosure was "to determine the marketability of and market the keyboard." As Mr. Coulter emphasized: "The term 'commercial evaluation', as used in the nondisclosure agreements, meant that we were looking for investors who could see the commercial potential of the concept." (Coulter Decl. ¶ 9.)

13. Admit that plaintiff has received contributions, in cash or in kind, of at least twenty investors over the years, that the largest such investment was $250,000, and that these funds have been used to pay expenses associated with the keyboard development project. (Gambaro Dep. (Vol. IV) 476:6 to 477:1 (non-responsive answer to compound question containing the word "commission," and explanation of expenses covered, cut off by defendants' counsel).)

14. Admit that several hand-held devices existed prior to filing of the '322 patent, and that Mr. Gambaro accused Mr. Goddard of inequitable conduct before the Patent Office based upon nondisclosure of such devices (the motion was later denied). (Preliminary Motion No. 2 from Interference No. 104,073, at 5-11; Decision on Preliminary Motions, Dec. 1, 1999, at 2.)

15. Admit.

16. Admit.

17. Admit.

DATED: November 24, 2004

MURPHY & BUCHAL LLP

/s/ James L. Buchal

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IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF OREGON
Eugene Division

MOTIONLESS KEYBOARD COMPANY, Plaintiff

v.

MICROSOFT CORPORATION, Nokia Inc., and Saitek Industries Ltd., Defendants.

No. CV 04-180-AA

EXPERT DECLARATION IN SUPPORT OF PLAINTIFF'S PARTIAL SUMMARY JUDGMENT MOTION

1. I am a patent attorney and co-founding member of Idea Advocates Law Group, LLC, 335 NW 5th Street, Suite 310, Portland, Oregon 97209. I earned a Bachelor of Science-Electrical Engineering and Computer Science (double major) degree from the University of Colorado in 1973 and a Juris Doctorate degree from the University of Patent Sound School of Law in 1983. I have passed the so-called patent examination and am registered to practice before the United States Patent & Trademark Office since 1986. My registration number is 32,496. I have practiced patent law since 1986, having been an associate and partner at Kolisch Hartwell Dickinson McCormack & Heuser, P.C. from 1986 to 1999 and having been an associate at Marger Johnson & McCollom, P.C. from 1999 to 2003. I have practiced patent law at Idea Advocates Law Group, LLC since September 2003.

Thus I have approximately eighteen years' experience in patent law.

2. My expertise in patent law includes extensive client counseling on the patentability of inventions, domestic and abroad; patent claim construction; right-to-manufacture issues; patent infringement analysis; patent enforcement; patent infringement settlement negotiations; and patent licensing. It also includes formulating and rendering oral and written opinions on the same. My experience also includes representing clients in patent and other intellectual property litigation in the United States District Courts. I have prepared, filed and prosecuted to issuance well over a hundred patent applications covering electronics, mechanics, computer, software, network, semiconductor, printer, medical and mesostructure technologies.

3. I have represented Mr. Thom Gambaro for approximately fifteen years in intellectual property matters. I assisted Mr. Gambaro in obtaining U.S. Patent No. 5,178,477 (the '477 patent) while representing him at Kolisch Hartwell Dickinson McCormack & Heuser, P.C. Before that patent issued, I became aware of further developments Mr. Gambaro had conceived in the area of thumb-actuable hand-grippable devices. His drawings and his prototype, which was a mock-up of a portable cell phone, were unique in my opinion and patentable. This is because Mr. Gambaro's key cluster arrangement within a concavity in a hand-gripped housing rely on the discovered anatomic/ergonomic principle that use of both the thumb's distal tip and its distal joint make keyed data entry simpler and faster. I encouraged Mr. Gambaro to pursue patent

protection of his invention, which I deemed a patentable improvement over keypad devices including his own motionless keyboard covered by the '477 patent and relying in part on this same anatomical/ergonomic principle. Thus I prepared, filed and prosecuted Mr. Gambaro's thumb-actuable, hand-grippable keyboard as U.S. Patent No. 5,332,322 (the '322 patent) asserted in the present lawsuit.

4. I also represented Mr. Gambaro early on in an interference involving the '322 patent, which interference was initiated January 20, 1998 and was decided in Mr. Gambaro's favor March 6, 2001 (decision affirmed upon appeal by the Federal Circuit Court of Appeals in 2002). Junior party Stephen A.A. Goddard in Patent Interference No. 104,073 vigorously challenged Mr. Gambaro's priority and the patentability of the count in interference corresponding with claim 1 of the '322 patent. Mr. Gambaro as senior party handily won the interference contest, proving not only priority of invention over Goddard but also overcoming any validity issues raised therein. I have recently reviewed the patent prosecution file history of the '322 patent and am intimately familiar with its contents including original prosecution to issuance of the '322 patent and the procedure and favorable outcome of the interference to senior party Mr. Gambaro.

5. I have examined Nokia Models 3595, 3560 and 6200 ("Nokia Models") and how the keypad of each of the Nokia Models is operated and how its housing is gripped. I have also analyzed how their keyboards function to enter electronic data, e.g. numbers or

letters, into the cell phone itself and ultimately into the airwaves. I have also analyzed how Nokia itself advertises the Nokia Models to would-be buyers, based upon my reading of its Internet web page and advertising copy. I have concluded that each of the Nokia Models represents an infringement of Mr. Gambaro's '322 patent, since claims 1-3 read on each of the Nokia Models.

6. I have communicated these conclusions regarding Nokia Models 3560, 3595 and 6200 to Nokia's patent counsel, Steven Shaw, in writing as of November 20, 2003. We have also communicated our conclusion of putative infringement by Nokia Models 6220, 6820, 7250 and 7250i. Finally, we have communicated to Shaw our conclusion that the "Fashion Cover" product series also represent at least inducement to infringe or contributory infringements of the '322 patent. Shaw presumably has reviewed the '322 patent prosecution file history, since he copied the file history to Mr. Gambaro during previous infringement and settlement discussions. Upon information and belief, Nokia has known of Mr. Gambaro's '322 patent and of Nokia's need to take a license thereunder for more than a year and a half, since Mr. Gambaro sent a copy of his '322 patent to Arja Turunen of Nokia, Finland on August 14, 2002.

7. Based upon photographic images of the Nokia Models included in Nokia's own webpage, each of the Nokia Models is gripped by the user of the cell phones in one hand, near the base of the cell phone, between the base of the fingers and the palm of the user, while being simultaneously operated by the user for number or letter key entry by the thumb of the same hand. Each of the Nokia Models feature a

concave key arrangement in which the keys have broad surfaces the edges of which confront the edges of adjacent keys. The keys are thus arranged in a concavity within the cell phone's housing to facilitate key depression by gestural (lateral and slight endo) thumb motions. Each of the Nokia Models has a housing for the display and the key cluster that is hand grippable and is, in accordance with Nokia's advertising copy, constructed and intended for single hand gripping and same-thumb operation of the keys to facilitate telephone number dialing and other date entry, e.g. the name of the contact or message.

8. Independent claim 1 of the '322 patent recited five elements, all of which are present in the Nokia Models. Tabulated below side by side for clarity are the required claim elements and the corresponding structure and function present in the Nokia Models.

[IMAGE OMITTED]

9. Dependent claim 2 of the '322 patent (depending from independent claim 1) recites an additional element, which is also present in the Nokia Models. Tabulated below side by side for clarity is the additional required claim element and the corresponding structure and function present in the Nokia Model 3595, which, based upon my analysis of the remaining ones of the Nokia Models, is representative of the structure and function also of Nokia Models 3560, 3620 and 6200.

[IMAGE OMITTED]

10. Dependent claim 3 of the '322 patent (depending also from claim 1) recites an additional element, which is also present in the Nokia Model 3560. Tabulated below side by side for clarity is the additional required claim element and the

corresponding structure and function present in the Nokia Model 3560.

[IMAGE OMITTED]

11. Patent examination in the United States Patent & Trademark Office is performed by a skilled Examiner knowledgeable about the relevant prior art and experienced in determining whether the basic patent prerequisites of novelty, utility and non-obviousness are present in the claimed invention. Moreover, United States patents enjoy a statutory presumption of validity and the burden of proof by clear and convincing evidence is on the party who would challenge the validity of an issued United States patent.

12. The Examiner of the '322 patent examined the '322 patent and determined that the claims as presented would be patentable over Mr. Gambaro's own '477 patent and the other prior art of record if Mr. Gambaro disclaimed the terminal portion of the '322 patent. Mr. Gambaro so disclaimed the end portion of the '322 patent to avoid obviousness-type double-patenting (*i.e.* to avoid an illegal extension of the statutory patent monopoly). No amendments were made to the '322 patent as originally presented, so there is no concern in the present case that Mr. Gambaro could attempt to recapture patent ground given up during prosecution. As such, the claims of the '322 patent are entitled to the broadest possible scope of protection under the judicially created Doctrine of Equivalents.

13. Accordingly, under the so-called "all elements" rule, I conclude that – because all elements recited in the claims of the '322 patent are present in the same arrangement as each of Nokia Models 3560, 3595 and

6200 advertised and sold in the United States by Nokia Inc. – at least these listed Nokia Models infringe Mr. Gambaro's '322 patent.

14. The Nokia cell phone offerings as represented on its website change frequently, with models being archived and introduced rather fluidly. Thus, based upon my recent review of Nokia webpage color photographs, newly advertised Nokia Models 3587i, 3620, 3660, 6225 and 6820 also infringe on the claims of the '322 patent, since all elements of at least claims 1-3 of Mr. Gambaro's '322 patent are also evident therein. See images below, which are true and accurate representations of the Nokia Models 3587i (top left), 3620 (top center), 3660 (top right), 6225 (bottom left) and 6820 (bottom center), according to the Nokia webpage. I conclude that Model 6820 includes a concave keypad for use with the cell phone gripped in one hand, the concave keypad being folded out of the way to deploy an alternative, full, two-handed alphanumeric keypad for gaming and/or typing and/or messaging.

[IMAGE OMITTED]

15. I certify under penalty of perjury that the foregoing is true and correct.

Executed on April 6, 2004

/s/ James G. Stewart

James G. Stewart

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF OREGON
Eugene Division

MOTIONLESS KEYBOARD COMPANY, Plaintiff

v.

MICROSOFT CORPORATION, Nokia Inc., and Saitek Industries Ltd., Defendants.

No. 04-CV-180-AA

SECOND SUPPLEMENTAL DECLARATION OF JAMES G. STEWART

JAMES G. STEWART declares:

1. I make this declaration in further support of plaintiff's opposition to defendants' motions for summary judgment, and in further support of plaintiff's own motions for summary judgment.

2. I have, with the assistance of Mr. Thom Gambaro, prepared revised claim charts concerning the accused products that remain at issue in connection with the pending summary judgment motions, true copies of which are annexed hereto and numbered as indicated. These claim charts are, other than the revision of minor typographical errors, the same as the charts produced in discovery on October 29, 2004.

Exhibit No.	Description
1.	Claim Chart for Nokia Model 3560
2.	Claim Chart for Nokia Model 3595
3.	Claim Chart for Nokia Model 6200
4.	Claim Chart for Nokia Model 6820
5.	Claim Chart for Microsoft Strategic Commander
6.	Claim Chart for Microsoft Sidewinder Precision 2
7.	Claim Chart for Microsoft Sidewinder Force Feedback 2
8.	Claim Chart for Saitek Cyborg 3D Gold
9.	Claim Chart for Saitek Cyborg 3D Rumble Stick
10.	Claim Chart for Saitek Cyborg 3D Force Stick
11.	Claim Chart for Saitek Cyborg Evo
12.	Claim Chart for Saitek ST90
13.	Claim Chart for Saitek ST200
14.	Claim Chart for Saitek ST290

3. In the case of Microsoft and Saitek, these claim charts utilize the same "Outside Counsel Only" appendices associated with the claim charts attached to my earlier Supplemental Declaration, which were under seal on or about October 29, 2004 by counsel. For administrative convenience, plaintiff asks the Court to rely on these "Outside Counsel Only" appendices for these revised claim charts, and proposes not to file them again with this Second

Supplemental Declaration.

4. In the case of Nokia, the amended claim charts also utilize the same Exhibits A-D filed on April 8, 2004, and those Exhibits will not be re-filed at this time. In the case of Nokia, the amended claim charts also refer to four appendices (3650A-B, 3595A-B, 6200A-B, and 6820A-B), representing additional "Outside Counsel Only" CAD drawings that are being filed separately under seal with this Declaration.

5. There has been continuing controversy in this case concerning the meaning of the phrase "mixed lateral, and slight endo, translation of a thumb within said concavity." There is a unique key actuation method taught in the '322 patent, most precisely in its specifications (Col. 6:30-42), and this phrase represents my attempt to describe that method. I employed the term "endo" in an attempt to capture the difference between this key actuation method and the more conventional means that involves simply moving the tip of the finger or thumb over a key and depressing it. In my opinion, a physical demonstration of this dialing method would benefit the Court and aid in its construction of the patent.

6. I also employed the word "cluster" in the phrase "thumb-associable cluster of keys forming a keyboard" to identify the placement of keys consistent with the '322 key actuation method. Specifically, the term "cluster" connotes a group of keys extending in more than one dimension (*i.e.* not a single row or column of keys), which is required in order to employ a key actuation method with "mixed lateral, and slight endo, translation of a thumb." With only one dimension to the "cluster," either

mixed lateral alone or slight endo alone would be sufficient to actuate the keys.

I certify under penalty of perjury that the foregoing is true and correct.

Executed on November 24, 2004

/s/ James G. Stewart

James G. Stewart

No. 05-1497

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

MOTIONLESS KEYBOARD COMPANY,

Plaintiff-Appellant,

v.

MICROSOFT CORP., NOKIA, INC., & SAITEK INDUS., LTD.,

Defendants-Appellees.

NOKIA'S AND SAITEK'S MOTION FOR EXTENSION OF TIME TO SEEK PANEL REHEARING OR REHEARING EN BANC

Defendants-Appellees Nokia Inc. (Nokia), and Saitek Industries (Saitek), hereby move this Court, pursuant to Federal Circuit Rule 26(b) and Rule 26(b) of the Federal Rules of Appellate Procedure, for a thirty (30) day extension of time to seek panel rehearing or rehearing en banc of the Court's decision in *Motionless Keyboard Co. v. Microsoft Corp.*, No. 2005-1497, 2007 WL 1531401 (Fed. Cir. May 29, 2007). In support of this motion, Nokia and Saitek show the following:

1. On May 29, 2007, a panel of this Court issued its decision regarding Motionless Keyboard's claim that two of its patents for ergonomic keyboards for hand-held devices were valid, and that Defendants' gaming joysticks and cellular telephones infringed those patents. *See Motionless Keyboard Co. v. Microsoft Corp.*, No. 2005-1497, 2007 WL 1531401

(Fed. Cir. May 29, 2007) ("Op.").

2. This Court held that the district court "misapplied the concept of public use and incorrectly found obviousness due to a terminal disclaimer," thus, "this court reverse[d] its invalidity rulings." Op. at 1. However, the Court also held that "the district court properly found summary judgment of no literal infringement," *id.* at 4, and "of non-infringement under the doctrine of equivalents." *Id.* at 5.

3. Pursuant to Federal Circuit Rules 35 and 40, a petition for rehearing of the panel's decision or a petition for rehearing en banc is presently due today, June 12, 2007.

4. Since the issuance of this Court's opinion, the parties have been engaged in settlement negotiations. Thus far, these settlement negotiations have not reached fruition, but the parties remain hopeful that a settlement may be reached.

5. Today, June 12, 2007, Counsel for Motionless Keyboard, Mr. James L. Buchal, requested Defendants' consent to a 30-day extension of the time for Motionless Keyboard to file a motion for rehearing or rehearing en banc.

6. Defendants do not oppose Plaintiff's request; however, if settlement negotiations are not successful, Nokia and Saitek may also wish to seek rehearing and/or rehearing en banc of the Court's decision.

7. In order to preserve Nokia's and Saitek's ability to request rehearing and/or rehearing en banc, Defendants' respectfully request a 30-day extension of the deadline to file such a motion before this Court. The extension is requested to and including July 12,

2007.

8. No other extension has been requested.

9. Defendants-appellees have informed Counsel for Motionless Keyboard that it is seeking this extension, and he has indicated that Motionless Keyboard does not oppose this motion.

WHEREFORE, Nokia and Saitek respectfully request a 30-day extension of the deadline for a motion to seek rehearing or rehearing en banc of this Court's decision.

Dated: June 12, 2007

Respectfully submitted,

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IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF OREGON
Eugene Division

MOTIONLESS KEYBOARD COMPANY, Plaintiff

v.

MICROSOFT CORPORATION, Nokia Inc., and Saitek Industries Ltd., Defendants.

No. 04-CV-180-AA

PLAINTIFF'S REPLY TO SCHEDULING ORDER FOR CONFERENCE CALL

PLAINTIFF'S EXHIBIT B

The Oregonian

Tuesday, May 8, 2007

Pages A2, A12

INTENTIONS INVENTIVE, RESULTS RUINOUS

Lab recipe: A mixture bursts into flames, displacing tenants and raising health concerns

By Joseph Rose and Noelle Crombie

No one knew about Thom Gambaro's lab inside a dusty first-floor garage at the Ladd's Addition Apartments.

Saturday night, as a stew of chemicals in a pressure cooker boiled to 400 degrees on Gambaro's

desk, residents at the Southeast Portland complex watched TV, chatted with Internet buddies and primped to go clubbing.

Then the ingredients caught fire. White smoke filled the hallways. Residents tasted metal on their tongues. "I felt something weird settle in my throat," said Theo Burke, a musician and political worker who was getting ready at his apartment feet from the garage to go salsa dancing.

But Gambaro wasn't cooking drugs or making a bomb, as firefighters initially feared. He was trying to concoct something that's quintessentially Portland: alternative fuel.

A 59-year-old inventor who holds five patents for computer keyboards, Gambaro mixed sodium, mercury and powdered aluminum. The result, he said, should have been a new hydrogen fuel cell that could power car engines with just a little water.

"Obviously," he said, standing outside the padlocked garage door Monday, "the metals didn't completely fuse."

The doomed experiment displaced 22 people from the complex at Southeast 12th Avenue and Harrison Street, including Gambaro, who rents a third-floor apartment. It also sent 20 firefighters and five residents to OHSU Hospital to be treated for mercury exposure.

On Monday, Gambaro, his silver hair mussed, pulled up to the sealed-off apartment complex in a BMW sedan. He stepped out, wearing the same faded cabana shirt and jeans he had on during his mishap. "They've been laundered," he said.

On his left wrist, a gold Mickey Mouse watch. On

his right, a cell phone attached to what appeared to be a black sweatband. Another invention. "If you're driving," Gambaro demonstrated, opening the phone, "it allows you to grab the wheel in an emergency without dropping the phone."

Gambaro, who has an associate of arts degree in electronics from the College of San Mateo in California, said he began exploring alternative fuels after hearing about a tree from India that could be rendered into biodiesel. One of the jatropha trees had outgrown his apartment. He was scheduled to donate it to the Oregon Museum of Science and Industry this week.

"We were interested," said Elaina Medina, an OMSI spokeswoman, "but we're not so sure it will happen after this mercury contamination incident. . . . Ironically, his experiment left one of our OMSI employees who lives in that building homeless."

The recipe for the metal mixture was from an existing patent for an alloy that, with water, produces pure hydrogen, Gambaro said. "Often times, an invention is patented but isn't used," Gambaro said.

He placed the mail-order chemicals into a graphite crucible, which fit perfectly into the pressure cooker. He tested the equipment and double-checked his calculations. He let the mix cool for 30 minutes before lifting the top and peeking in.

The metal appeared solid. But when he removed the crucible and turned it upside down, it began to bleed liquid mercury, which flared into a fire. "I didn't expect it to self-ignite with just air," Gambaro said.

He said he shoved the smoking lump of metal off the desk and onto the floor. Water would have caused the sodium to flare up. He knew that much. So, he let the flames fade, tried to clear the smoke and walked away from the building, tasting metal, his head pounding.

It was after 10 p.m. when Grant Coffey's pager went off. Firefighters investigating a call about smoke had found the lab. At first, Coffey, coordinator of Portland's hazardous materials team who's taught chemistry for nearly three decades, thought the firefighters had stumbled into a clandestine explosives operation. He alerted the bomb squad and the FBI. "But it never raised to the level of a terrorism scare because (Gambaro) returned to the scene and explained what happened," Coffey said.

Firefighters placed Gambaro into a decontamination suit and told him to go to the hospital to be checked for mercury poisoning. The firefighters were tested Sunday, but those results will not be available until later this week, Coffey said. Meanwhile, they will be treated for mercury exposure as a precaution for the next couple of weeks, he said. Residents won't be allowed back into their homes until Wednesday, when a crew has finished decontaminating the building.

"I had a friendly relationship with Thom, but this is a real betrayal of trust," said Burke, who was on his way to Goodwill to buy clothes after picking up mercury treatment pills Monday afternoon. "You don't fool around with volatile chemicals like that in an apartment building."

Besides the wrath of his neighbors and the possibility of eviction, Gambaro could face criminal

charges, Coffey said.

Perhaps it was best that the experiment went haywire before Gambaro tried to make hydrogen. Coffey said, "Once you start messing with that, it could be a hellacious explosion," he said. "Think the Hindenburg."

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF OREGON
Eugene Division

MOTIONLESS KEYBOARD COMPANY, Plaintiff

v.

MICROSOFT CORPORATION, Nokia Inc., and Saitek Industries Ltd., Defendants.

No. 04-CV-180-AA

PLAINTIFF'S REPLY TO SCHEDULING ORDER FOR CONFERENCE CALL

PLAINTIFF'S EXHIBIT C

The Oregonian
Thursday, May 10, 2007
Page C1

CONTAMINATION WORSE THAN THOUGHT

Mercury: Ladd's Addition residents could remain displaced until the weekend

By Joseph Rose

Mercury contamination from a doomed alternative-fuel experiment at the Ladd's Addition Apartments in Southeast Portland was far worse than authorities initially suspected.

Hours after the Saturday night chemical fire

discharged a white, toxic smoke cloud, the officials told 24 displaced residents they probably would be able to go home by Wednesday night.

But red tape still encircled the building Wednesday afternoon as crews wearing rubber gloves lugged plastic bags filled with tainted property to the lawn.

"It looks like the building won't be inhabitable until this weekend," said Grant Coffey, coordinator of Portland's hazardous materials team.

The fire erupted in a first-floor garage, where Thom Gambaro tried to fuse mail-order mercury, sodium and powdered aluminum in a pressure cooker. The 59-year-old inventor, who holds several patents for computer hardware, wants to create a new hydrogen fuel cell that could power cars with water.

Coffey said the Multnomah County district attorney's office is reviewing the case. Meanwhile, property manager Mike Schaeffer has served Gambaro with an eviction notice.

Gambaro, who has lived in a third-floor apartment for 12 years, began paying extra rent to use the garage three years ago, Schaeffer said. "Everyone thought he was using it as his office. We knew he was a computer parts guy, but nobody knew he was into this stuff."

Just about any inventor can register with chemical companies to order small amounts of mercury through the mail, Coffey said.

In a fire, mercury doesn't vaporize well and can poison kidneys and the nervous system if inhaled. Mercury levels on firefighters' coats were so high that "We had to throw about $15,000 of gear away after

the call," Coffey said. For Ladd's Addition residents, he said, "Some of their belongings are lost."

Gambaro said the failed experiment wasn't the end of his attempt to invent a new hydrogen-producing alloy. "I just won't do the experiment in a place like that again," he said.